

FC5 (P7) – Trade Mark Law  
Mark Scheme 2015

**PART A**  
**Question 1**

- a) *Article 1(2) 'Community trade mark'* CTMR provides that a CTM is unitary in character. What does that mean? **3 marks**
- b) Explain by means of an example how that unitary character works in practice. **2 marks**

**Total: 5 marks**

**Answer**

- a) **One mark for any of the following up to a maximum of three marks to be awarded overall (half marks may be awarded where candidates have not been precise):**
- i. a CTM has equal effect throughout the Community;
  - ii. a CTM will automatically extend protection to any new country which joins the EU;
  - iii. it cannot be registered, save in respect of the whole Community;
  - iv. it cannot be transferred, save in respect of the whole Community;
  - v. it cannot be surrendered, save in respect of the whole Community;
  - vi. it cannot be the subject of a decision revoking the rights of the proprietor, save in respect of the whole Community;
  - vii. it cannot be the subject of a decision declaring it invalid, save in respect of the whole Community;
  - viii. its use shall not be prohibited, save in respect of the whole Community.
- 3 marks**
- b) **One mark for any of the following up to a maximum of two marks to be awarded overall (half marks may be awarded where candidates have not been precise):**
- i. a party which owns an earlier conflicting trade mark in just one country of the EU, say Greece, can oppose the CTM and, if it is successful, the CTM is refused in its entirety;
  - ii. the CTM applicant has the option of converting the CTM into national applications in any territory of the EU where the earlier conflicting trade mark is not registered;
  - iii. *a party which sues for infringement in any one member state may be able to obtain a pan-European injunction.*
- 2 marks**

**Total 5 marks**

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**Question 2**

Describe the procedure for a United Kingdom (UK) trade mark application from the date of submission of the application to the date on which the examination report is issued noting all the steps to be taken by the applicant and UKIPO, any deadlines and whether the deadlines can be extended.

**NB there are no marks awarded for explaining how to overcome any official objections or later stages of the application procedure.**

**Total: 5 marks**

**Answer**

**Half a mark for any of the following and any other relevant points up to a maximum of five marks to be awarded overall:**

- i. the UKIPO checks to ensure that the essential requirements for a filing date are present;
- ii. essential requirements for a filing date are the trade mark, the goods/services and the owner name and address;
- iii. also, statement that that the applicant is using the mark or has a bona fide intention to use the mark.
- iv. the fees are paid;
- v. if so, a filing date is allocated;
- vi. if not, objection is raised and the filing date is the date when the last document which puts the application is received;
- vii. next, UKIPO conducts a formality examination to ensure that the other requirements for an application are present (intent to use declaration, address for service, etc);
- viii. if there are deficiencies, an Office Action is issued giving one month for the applicant to remedy any deficiency;
- ix. the term cannot be extended;
- x. the applicant has two months from the filing date to pay the official fee (plus an extra fee for each additional class);
- xi. the term cannot be extended;
- xii. provided all the requirements are met, the application proceeds to substantive examination;
- xiii. the UKIPO will review and check the specification;
- xiv. the application is subject to an official search of UK applications/registrations, CTM applications and International Registrations designating the UK or the EU;
- xv. the application is also examined on absolute grounds;
- xvi. a report on the examination is issued setting out any objections on absolute or relative grounds.

**5 marks**

**Total: 5 marks**

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**Question 3**

*Section 5 ‘Relative grounds for refusal of registration’ UKTMA provides that a trade mark shall not be registered in the UK if it conflicts with certain earlier trade marks (Section 5(1), (2) and (3)), rule of law (Section 5(4)(a)), and earlier rights (Section 5(4)(b)).*

- a) List the three relative grounds in *Section 5(1) and (2)* UKTMA in relation to which a new trade mark application is searched as part of the UKIPO official examination. **3 marks**
- b) What, according to *Section 5(4)(a)* UKTMA, is an example of a rule of law protecting unregistered trade marks that can be used to prevent registration of a trade mark? **0.5 marks**
- c) List three types of ‘earlier rights’ (**not ‘earlier trade marks’**) which, according to *Section 5(4)(b)* UKTMA, can be used to prevent use or registration of a trade mark in the UK. **1.5 marks**

**Total: 5 marks**

**Answer**

- a) **One mark for any of the following up to a maximum of three marks to be awarded overall (half marks may be awarded where candidates have not been precise):**
- i. the mark the subject of the application is identical to an earlier trade mark and is to be registered for goods or services identical to those for which the earlier trade mark is protected;
  - ii. the mark the subject of the application is identical to an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, where there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark;
  - iii. the mark the subject of the application is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, where there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.
- 3 marks**
- b) The law of passing off. **0.5 marks**
- c) **Half a mark for each of the following:**
- i. copyright;
  - ii. design right;
  - iii. registered designs.
- 1.5 marks**

**Total: 5 marks**

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**Question 4**

A UK trade mark application has been published for opposition purposes in which the mark consists of the words NOTTINGHAM LAWNMOWERS. Your client, a lawnmower manufacturer based in Nottingham, tells you that he is concerned but that he cannot justify the cost of opposition.

- a) **What is the other option for objecting to the trade mark at this stage?** **1 mark**
- b) **Provide an outline of the procedure, including any relevant time scales, for that option.** **4 marks**

**Total: 5 marks**

**Answer**

The answer is as provided in Section 38 'Publication, opposition, proceedings and observations' of UK Trade Marks Act 1994 but candidates are not required to know Section numbers.

- a) Observations as to whether the trade mark should be registered; **1 mark**
- b) Half a mark for any of the following or other relevant points, up to a maximum of four marks to be awarded overall (half marks may be awarded where candidates have not been precise):
- i. *in writing to UKIPO;*
  - ii. *stating the grounds for objection;*
  - iii. *UKIPO informs the applicant of any such observations;*
  - iv. *the applicant is given an opportunity to respond;*
  - v. *the party filing the observations is not given a chance to file further submissions*
  - vi. *a person who makes observations does not become a party to the proceedings on the application;*
  - vii. *observations may be filed at any time before registration;*
  - viii. *the result of the observations is not issued until after the end of the opposition period;*
  - ix. *by the time the UKIPO issues its decision, the opposition period is closed and so it is too late to file opposition. Invalidity must then be filed;*
  - x. *the UKIPO will issue a decision on the observations.*

**4 marks**

**Total: 5 marks**

**Question 5**

- a) After publication of a CTM application, how long is allowed for third parties to file opposition according to *Article 41 'Opposition'* CTMR and can the term be extended?  
**1 mark**
- b) Who may file opposition according to *Article 41 'Opposition'* CTMR?  
**2 marks**
- c) Name two of the three essential elements required for a valid opposition according to *Article 41 'Opposition'* CTMR?  
**2 marks**
- Total: 5 marks**

**Answer**

- a) **Half a mark for each of the following up to a maximum of one mark to be awarded overall:**
- i. three months;
  - ii. no extension of time is available.
- 1 mark**
- b) **One mark for each of the following up to a maximum of two marks to be awarded overall (half marks may be awarded where candidates have not been precise):**
- i. the owners of the earlier trade marks or unregistered rights which can form the basis of opposition;
  - ii. licensees of the earlier trade marks may also be permitted to oppose if they have been authorised by the proprietor.
- 2 marks**
- c) **One mark for any of the following up to a maximum of two marks to be awarded overall (half marks may be awarded where candidates have not been precise):**
- i. Opposition must be expressed in writing
  - ii. It must specify the grounds on which it is made
  - iii. It shall not be treated as duly entered until the opposition fee has been paid
- 2 marks**
- Total: 5 marks**

**Question 6**

On what grounds can a CTM be revoked under the provisions of Article 51 'Grounds for revocation' CTMR?

**Total: 5 marks**

**Answer**

**Half a mark for any of the following (or other relevant points) up to a maximum of five marks to be awarded overall:**

The rights of the proprietor of the Community trade mark shall be declared to be revoked:

- i. if, within a continuous period of five years*
- ii. the trade mark has not been put to genuine use*
- iii. in the Community*
- iv. [in connection with the goods or services in respect of which it is registered]*
- v. and there are no proper reasons for non-use*
- vi. the mark shall not be revoked if genuine use of the trade mark has been started or resumed within 3 months between expiry of the 5 non-use period and filing of the application for revocation;*
- vii. commencement or resumption of use within a period of three months preceding the filing of the application shall be disregarded where it occurs only after the proprietor becomes aware that the application may be filed;*
- viii. if, in consequence of acts or inactivity of the proprietor,*
- ix. the trade mark has become the common name in the trade*
- x. [for a product or service in respect of which it is registered]*
- xi. if, in consequence of the use made of it by the proprietor*
- xii. [in respect of the goods or services for which it is registered]*
- xiii. the trade mark is liable to mislead the public*
- xiv. particularly as to the nature, quality or geographical origin of those goods or services.*
- xv. the revocation may be partial if the grounds apply to only some of the goods/services.*

**5 marks**

**Total: 5 marks**

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**Question 7**

Your client's CTM has been refused on grounds that it is descriptive in the Croatian language and your client wishes to convert the CTM into national applications in all territories except Croatia.

- a) **What is the deadline for applying for conversion?** 1 mark
- b) **What actions must you take to convert the application within this deadline?** 1.5 marks
- c) **What may be required by the national offices where conversion is requested and what time limit may be imposed?** 2.5 marks

**Total: 5 marks**

**Answer**

- a) **Half a mark for each of the following up to a maximum of one mark to be awarded overall:**
- i. three months;
  - ii. from the date of the notice of refusal.
- 1 mark**
- b) **Half a mark for each of the following up to a maximum of one and a half marks to be awarded overall:**
- i. file a request for conversion at OHIM;
  - ii. specify the Member States for which conversion is requested;
  - iii. pay the official fee.
- 1.5 marks**
- c) **Half a mark for each of the following up to a maximum of two and a half marks to be awarded overall:**
- i. payment of the national application fee;
  - ii. a translation in one of the official languages of the State in question of the request and of the documents accompanying it;
  - iii. an address for service in the State in question;
  - iv. a representation of the trade mark in the number of copies specified by the State in question;
  - v. a deadline of not less than two months may be imposed.

**2.5 marks**

**Total: 5 marks**

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**Question 8**

- a) Explain the provisions relating to 'Replacement' under *Article 4bis 'Replacement of a National or Regional Registration by an International Registration'* of the Madrid Protocol.

**4 marks**

- b) Identify an advantage of 'Replacement'.

**1 mark**

**Total: 5 marks**

**Answer**

- a) One mark for any of the following up to a maximum of four marks to be awarded overall (half marks may be awarded where candidates have not been precise):**

- i. if the owner of an international registration has an earlier national registration
- ii. for the same mark, for the same goods and services, and in the same ownership, the International Registration is deemed to "replace" the national registration in that territory;
- iii. the replacement effect occurs automatically and the international registration is accorded the pre-existing national registration's protection/priority date;
- iv. thereafter, the owner need not renew the national registration because the international registration is deemed to have replaced the national registration in that territory with no loss of priority;
- v. if the national registration is allowed to expire the owner can request that replacement be noted in the records of the national trademark office and at WIPO.

**4 marks**

- b) Half a mark for any of the following up to a maximum of one mark to be awarded overall:**

- i. simplifying administration;
- ii. streamlining renewal and maintenance activities;
- iii. reducing costs.

**1 mark**

**Total: 5 marks**



**Question 9**

Outline the doctrine of free movement of goods with reference to *Articles 34, 35 and 36* of the Treaty on the Functioning of the European Union.

**Total: 5 marks**

**Answer**

**One mark for any of the following up to a maximum of five marks to be awarded overall (half marks may be awarded where candidates have not been precise):**

- i. article 34: quantitative restrictions on imports and all measures having equivalent effect, shall be prohibited between Member States;
- ii. article 35: quantitative restrictions on exports, and all measures having equivalent effect, shall be prohibited between Member States;
- iii. article 36: the provisions of Articles 34 to 35 shall not preclude ... restrictions on the protection of ... industrial and commercial property;
- iv. such prohibitions or restrictions shall not, however, constitute a means of arbitrary discrimination;
- v. or a disguised restriction on trade between Member States.

**5 marks**

**Total: 5 marks**

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**PART B**  
**Question 10**

Your US client wishes to register a picture of a lion as a trade mark in the UK and a search of the UK trade marks register has disclosed that an application to register the identical mark was filed three months ago for the identical products in the name of an unrelated third party. The earlier trade mark is about to be published.

- a) **Briefly explain why the earlier trade mark is a problem for your client.** **1 mark**
- b) **Discuss the possible options to overcome the problem at UKIPO. (Do not discuss possible action in the courts.)** **11 marks**

**Total: 12 marks**

**Answer**

- a) **Up to one mark to be awarded overall for an explanation along the following lines (a half mark may be awarded where candidates have not been precise):**
- i. if the prior mark proceeds to registration, the owner will have the right to prevent your client from using or registering his mark;
- 1 mark**
- b) **One mark for any of the following or other sensible suggestions up to a maximum of eleven marks to be awarded overall (half marks may be awarded where candidates have not been precise):**
- i. *your client could oppose on the basis that he owns an earlier trade mark;*
  - ii. *your client could oppose if he has a passing off right;*
  - iii. *he would need to prove earlier goodwill in the UK, misrepresentation and damage;*
  - iv. *your client could oppose if he is the owner of copyright in his picture of a lion;*
  - v. *your client could also oppose if he is the owner of a UK or Community registered design in respect of his picture of the lion;*
  - vi. *your client could also oppose if he is the owner of unregistered design right in his picture of the lion;*
  - vii. *your client could also oppose if his mark is well known within the meaning of the Paris Convention;*
  - viii. *if your client has applied to register his mark in the US more than three months ago but less than six months ago, he could file a UK trade mark application claiming convention priority from that application and his UK application would become the earlier trade mark;*
  - ix. *your client could request that the owner of the trade mark application consent to your client's mark as consent overcomes all objections on relative grounds;*
  - x. *consider whether there is any ground for opposition that the mark lacks of distinctive character;*
  - xi. *consider whether there is any ground for opposition that the mark is descriptive (depending on the goods/services);*
  - xii. *consider whether there is any ground for opposition that the mark is common to the trade;*

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- xiii. consider whether there is any ground for opposition that the third party filed in bad faith;*
- xiv. such opposition would need to be supported by evidence - allegation alone is insufficient;*
- xv. your client could approach the third party and try to negotiate terms on which the marks might co-exist [since the mark and products are identical, the likelihood of finding grounds for settlement seems small];*
- xvi. your client could consider taking a licence from the third party;*
- xvii. your client could consider amending his mark to distinguish it from the third party mark;*
- xviii. your client could change their mark to something completely different, but they would need to search first;*
- xix. is the owner of the earlier mark willing to consider selling the same to your client;*
- xx. arguments could be filed if changes to the mark/specification are made.*

**11 marks**

**Total: 12 marks**

**Question 11**

**In both parts of this question, confine your answer to the nature of the action at OHIM. There are no marks for describing the full procedure, nor for advising on possible court action or negotiation.**

- a) Your Japanese client tells you that his European distributor (who is responsible for all imports into the European Union (EU) of your client's products) has applied to register your client's trade mark as a CTM. Despite the fact that he has been selling his products through the distributor for several years, your client has never got round to registering his trade mark anywhere in the EU.

**Write notes on what ground of opposition your client can use at OHIM to oppose the distributor's trade mark application.**

**6 marks**

- b) Explain the grounds on which the owner of a non-registered trade mark can oppose a CTM where the applicant is not his distributor but an unrelated third party according to *Article 8(4) 'Relative grounds for refusal'* CTMR.

**6 marks**

**Total: 12 marks**

**Answer**

- a) One mark for any of the following up to a maximum of six marks overall (half marks may be awarded where candidates have not been precise):**

- i. according to *Article 8(3) 'Opposition' of Commission Regulation (EC) 207/2009* (although candidates are not required to know Article numbers) upon opposition by the proprietor of the trade mark, a trade mark shall not be registered
- ii. where an agent or representative of the proprietor of the trade mark applies for registration in his own name;
- iii. without the proprietor's consent
- iv. unless the agent or representative justifies his action.
- v. provided the distributor's application is for the identical mark and identical goods;
- vi. the client should also apply to register the trade mark in his own name, to avoid the risk that another party might attempt to do so while the conflict is resolved.

**6 marks**

**Cont...**

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- b) **One mark for any of the following (or other relevant points) up to a maximum of six marks overall (half marks may be awarded where candidates have not been precise):**
- i. upon opposition by the proprietor of a non-registered trade mark or of another sign used in the course of trade;*
  - ii. where the mark is of more than mere local significance;*
  - iii. the trade mark applied for shall not be registered where and to the extent that, pursuant to the Community legislation or the law of the Member State governing that sign:*
  - iv. rights to that sign were acquired prior to the date of application for registration of the Community trade mark;*
  - v. or the date of the priority claimed for the application for registration of the Community trade mark;*
  - vi. that sign confers on its proprietor the right to prohibit the use of a subsequent trade mark;*
  - vii. the relevant UK right which could be relied on is the law of passing off;*
  - viii. it would be necessary to show that the client has goodwill and that there is a misrepresentation likely to cause damage;*
  - ix. in opposition the third party mark may not be in use but the client can still rely on passing off;*
  - x. in real UK passing off, the relevant date is the date of commencement of the acts complained of;*
  - xi. in opposition, if the third party mark is not in use, the relevant date is the date of application of the third party mark;*
  - xii. in real UK passing off, it is not necessary to prove that the client's right is of more than mere local significance.*

**6 marks**

**Total: 12 marks**

**Question 12**

Your client's trade mark consists of the word MINSK, capital of the country of Belarus. The city has a population of more than two million.

He explains that his products (bikinis) have nothing to do with the city of Minsk, which has a rather cold climate and no beaches, but he liked the word because it sounds a bit like 'miniscule', which is a desirable quality for bikinis.

He tells you that his products have been sold throughout the UK for more than twenty years and are very popular but that he has not yet registered MINSK as a trade mark.

- a) **Advise your client on the principal objection which a UK trade mark application is likely to face on absolute grounds that it is a place name by reference to UKTMA and relevant case law.**
- 6 marks**
- b) **Your client wishes to try to overcome the objection by filing evidence of acquired distinctiveness. Explain to your client the criteria established by the Court of Justice of the European Union on evidence of acquired distinctiveness.**

**6 marks**

**Do not discuss other possible objections on absolute grounds or possible objections on relative grounds.**

**Total: 12 marks**

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Answer

- a) **One mark for any of the following (except where indicated) and other sensible points up to a maximum of six marks overall (half marks may be awarded where candidates have not been precise):**
- i. *section 3(1)(c) 'Absolute Grounds for Refusal' of the United Kingdom Trade Marks Act 1994* (although candidates are not required to know section numbers) provides that trade marks which consist exclusively of signs or indications which may serve, in trade, to designate ... geographical origin ... or other characteristics of the goods or service shall not be registered;
  - ii. however, in the decision of *Windsurfing Chiemsee Produktions- und Vertriebs GmbH (WSC) and Boots- und Segelzubehör Walter Huber (C-108/97) Franz Attenberger (C-109/97 Joined Cases [1999] ECR I-2779* (candidates are not required to know the full name of the case), the Court of Justice of the European Union provided guidelines on the registrability of place names;
  - iii. the decision has had the effect of restricting the extent to which a place name can be registered;
  - iv. the decision provides that section 3(1)(c) “does not prohibit the registration of geographical names as trade marks solely where the names designate places which are ... currently associated with the category of goods in question *Windsurfing Chiemsee para 36*;
  - v. ... it also applies to geographical names which are liable to be used in future ... as an indication of ... geographical origin” *Windsurfing Chiemsee para 36*;
  - vi. and “where there is currently no association ... between the geographical name and the ... goods ... , the competent authority must assess whether it is reasonable to assume that such a name is ... capable of designating the geographical origin of [the] goods” *Windsurfing Chiemsee para 36*;
  - vii. “in making that assessment, particular consideration should be given to the degree of familiarity ... with the geographical name in question, with the characteristics of the place designated by that name, and with the ... goods concerned” *Windsurfing Chiemsee para 36*;
  - viii. “it is not necessary for the goods to be manufactured in the geographical location in order for them to be associated with it” *Windsurfing Chiemsee para 36*;
  - ix. a cold place such as MINSK could be argued to be unlikely to be to become associated with bikinis but registration is not guaranteed and it is important that the application be supported by strong evidence of acquired distinctiveness;
  - x. It will be possible to overcome such an objection by filing evidence of acquired distinctiveness which will require evidence of use of the mark, the location, the goods/services, when used and so forth.

6 marks

Cont...

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- b) One mark for any of the following (except where indicated) and other sensible points up to a maximum of six marks overall (half marks may be awarded where candidates have not been precise):**
- i. there is a proviso to section 3(1)(c) to the effect that objections may be overcome if the applicant can show that the mark has acquired distinctiveness;
  - ii. distinctiveness is acquired through use of the mark in the UK prior to the date of the application;
  - iii. in the *Windsurfing Chiemsee* case, the CJEU provided guidance on evidence of acquired distinctiveness;
  - iv. in assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account (half mark for each):
    - a. the market share held by the mark;
    - b. how intensive, geographically widespread and long-standing use of the mark has been;
    - c. the amount invested by the undertaking in promoting the mark;
    - d. the proportion of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking;;
  - v. in assessing the distinctive character of a mark in respect of which registration has been applied for, statements from chambers of commerce and industry or other trade and professional associations may also be taken into account;
  - vi. a trade mark acquires distinctive character following the use which has been made of it where the mark has come to identify the product in respect of which registration is applied for as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings. *Windsurfing Chiemsee para 54*;
  - vii. it precludes differentiation as regards distinctiveness by reference to the perceived importance of keeping the geographical name available for use by other undertakings. *Windsurfing Chiemsee para 54*;
  - viii. however such use must be in a purely descriptive manner;
  - ix. in determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an overall assessment of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings. *Windsurfing Chiemsee para 54*;
  - x. if the competent authority finds that a significant proportion of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied. *Windsurfing Chiemsee para 54*;
  - xi. where the competent authority has particular difficulty in assessing the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its own national law, to an opinion poll as guidance for its judgment. *Windsurfing Chiemsee para 54*.

**6 marks**

**Total: 12 marks**



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**Question 13**

- |   |                  |
|---|------------------|
| a) What is meant by 'seniority' according to <i>Article 34(1)</i> 'Claiming the seniority of a national trade mark' CTMR? | <b>2.5 marks</b> |
| b) What is the effect of seniority according to <i>Article 34(2)</i> CTMR?  | <b>2 marks</b>   |
| c) At what three points in the life of a CTM application/registration can seniority be claimed?                           | <b>1.5 marks</b> |
| d) What is the procedure for claiming seniority under the CTMR?   | <b>6 marks</b>   |
| <b>Total: 12 marks</b>  |                  |

**Answer**

- a) Half a mark for any of the following up to a maximum of two and a half marks overall (half marks may be awarded where candidates have not been precise):**
- i. the proprietor of an earlier trade mark;
  - ii. registered in a Member State;
  - iii. who applies for an identical trade mark for registration as a Community trade mark;
  - iv. for goods or services which are identical with or contained within those for which the earlier trade mark has been registered;
  - v. may claim for the Community trade mark the seniority of the earlier trade mark in respect of the Member State in or for which it is registered.
- 2.5 marks**
- b) One mark for any of the following up to a maximum of two marks overall (half marks may be awarded where candidates have not been precise):**
- i. seniority shall have the sole effect that, where the proprietor of the Community trade mark surrenders the earlier trade mark or allows it to lapse;
  - ii. he shall be deemed to continue to have the same rights as he would have had if the earlier trade mark had continued to be registered.
- 2 marks**
- c) Half a mark for any of the following up to a maximum of one and a half marks overall (half marks may be awarded where candidates have not been precise):**
- i. At the time of filing;
  - ii. Within two months of filing;
  - iii. After registration is complete
- 1.5 marks**

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- d) Half a mark for any of the following up to a maximum of six marks overall (half marks may be awarded where candidates have not been precise):**
- i. if seniority is claimed during the application procedure, the applicant must submit a copy of the relevant registration(s);
  - ii. within three months of claiming seniority;
  - iii. if seniority is claimed subsequent to registration, the proprietor must submit a request containing:
    - iv. the registration number of the Community trade mark;
    - v. the name of the proprietor of the Community trade mark;
    - vi. the address of the proprietor of the Community trade mark;
  - vii. an indication of the Member State or Member States in or for which the earlier mark(s) is/are registered,
  - viii. the number of the relevant registration(s);
  - ix. the filing date of the relevant registration(s);
    - x. the goods and services for which the earlier mark(s) is/are registered;
    - xi. the goods and services in respect of which seniority is claimed;
  - xii. a copy of the relevant registration(s);

**6 marks**

**Total: 12 marks**

**Question 14**

- a) When can an application be filed under the Madrid Protocol?  
**3 marks**
- b) What are the four names of the types of fees payable for an application filed under the Madrid Protocol?  
**2 marks**
- c) Write notes on the main differences between protection provided by the CTMR and the Madrid Protocol.  
**7 marks**

**Total: 12 marks**

**Answer**

- a) One mark for any of the following up to a maximum of three marks overall:**
- i. any time after a base application has been filed.
  - ii. if the base application is the first filing of the mark, convention priority can be claimed if the International Application is filed within six months.
  - iii. any time (even many years) after the base application has been registered.

**3 marks**

**Cont...**

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**b) Half a mark for any of the following up to a maximum of two marks overall:**

- i. basic fee
- ii. supplementary fee for each class above three
- iii. complementary fee for each territory designated
- iv. National Offices can elect to charge “individual fees” which are higher than the supplementary and complementary fees.

**2 marks**

**c) Half a mark for each main difference, of which the following are examples, up to a maximum of seven marks overall:**

- i. *the CTMR is a law;*
- ii. *whereas the MP is a system of administration of national laws;*
- iii. *the CTM is a unitary right which means that the registration must always cover the entire EU;*
- iv. *i.e. a successful opposition based on a single national right causes the entire application to be refused;*
- v. *the MP is a bundle of national registrations;*
- vi. *so refusal in one territory does not affect protection in the others;*
- vii. *a CTM can only ever cover the EU;*
- viii. *whereas an MP can cover dozens of territories;*
- ix. *anyone can own a CTM;*
- x. *to own a MP, you have to have a real/effective place of business, be a national or domiciled in the country where the base mark is filed;*
- xi. *you do not require a base mark to file a CTM;*
- xii. *you do need a base mark to file a MP;*
- xiii. *the CTM Office will substantively examine the application;*
- xiv. *WIPO will only review the application for formalities – the national offices of the countries designated will then conduct a substantive review;*
- xv. *also under the MP one or more territories can be surrendered at any time without prejudicing the international registration;*
- xvi. *an MP can designate the EU (ie with the protection of a CTM) or individual territories in the EU;*
- xvii. *a CTM automatically expands to cover new members of EU;*
- xviii. *whereas when new countries join the MP, it is necessary to file a subsequent designation to obtain protection;*
- xix. *CTM official languages are English, French, German, Italian Spanish.*
- xx. *MP languages are English, French, Spanish.*
- xxi. *under the CTM, one attorney can represent the applicant for the complete procedure;*
- xxii. *under the MP, local attorneys must be appointed in the event of objection by national office;*
- xxiii. *an international registration is dependent on a basic registration for the first five years of its life;*
- xxiv. *during those five years a successful central attack on the basic registration means that the rights under the international registration can no longer be invoked;*
- xxv. *under the CTM, use in one part of the EU is sufficient to support the registration in the event of an attack on grounds of non-use;*
- xxvi. *under the MP, each national designation must be used to avoid vulnerability on grounds of non-use;*
- xxvii. *if the MP is cancelled through central attack it is possible to "transform" the right into national applications;*

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- xxviii. *if a CTM is cancelled it is possible to "convert" it into national applications;*
- xxix. *an international registration is deemed to "replace" earlier national registrations in designated territories which have the same mark, owner and goods/services so that the earlier national registrations can be allowed to lapse without loss of rights;*
- xxx. *"seniority" can be claimed by the owner of a CTM who has earlier national registrations in the EU which have the same mark, owner and goods/services so that the earlier national registrations can be allowed to lapse without loss of rights.*
- xxxi. *if a CTM is successfully challenged, whether on the basis of a CTM or an earlier national trade mark in an EU member state, you will lose protection for the whole of the mark;*
- xxxii. *if a designation is challenged on the basis of an earlier mark, you will only lose protection for that designation;*
- xxxiii. *a CTM can only be assigned for the whole of the mark;*
- xxxiv. *a designation of a MP can be assigned independently of the other designations;*
- xxxv. *a CTM can only be renewed for the mark as a whole;*
- xxxvi. *you can pick and select which designations of a MP you want to renew.*

**7 marks**

**Total: 12 marks**

**Question 15**

- a) Discuss the provisions relating to ‘transformation’ under the Madrid Protocol. **6 marks**
- b) Discuss the provisions relating to ‘conversion’ under the CTMR. **6 marks**

**Total: 12 marks**

**Answer**

- a) One mark for any point of which the following are examples, up to a maximum of six marks (half marks may be awarded where candidates have not been precise):**

- i. for the first five years, a MP mark is dependent on the survival of the base mark. If the base is lost, the MP is lost;*
- ii. if a Madrid Protocol registration is subject to successful central attack,*
- iii. it can be “transformed” to national trade mark applications in any country designated in the IR;*
- iv. the application will be deemed to have the same filing date as the original IR;*
- v. the applicant must pay national filing fees;*
- vi. the applicant must employ local representatives;*
- vii. the applicant must apply for registration in the Contracting Parties for which protection is required;*
- viii. within three months of the date on which the IR is cancelled;*
- ix. the application(s) must comply with all the requirements of the applicable national law (ie each state may have its own examination requirements);*
- x. including the requirements concerning fees;*
- xi. the transformed national applications must be in the same ownership, for the identical mark and for identical or narrower goods/services;*
- xii. the transformed national applications will have the same filing date, including priority claim as the MP had.*

**6 marks**

- b) One mark for any point of which the following are examples, up to a maximum of six marks (half marks may be awarded where candidates have not been precise):**

- i. the applicant for or proprietor of a Community trade mark may apply in writing to “convert” his Community trade mark into a national trade mark application*
- ii. can only apply insofar as the countries where the Community trade mark application was not refused;*
- iii. the application will keep the same filing date as the original CTM;*
- iv. the application for conversion must be filed within three months of the notice of refusal;*
- v. it is necessary to specify the Member States in which application of the procedure for registration of a national trade mark is desired;*

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- vi. a conversion fee must be paid;*
- vii. conversion may not take place where the rights of the proprietor of the Community trade mark have been revoked on the grounds of non-use, unless in the member state where conversion is requested the CTM has been put to use which would be considered to be genuine use;*
- viii. conversion may not take place in a Member State where, in accordance with the decision of the Office or of the national court, grounds for refusal of registration or grounds for revocation or invalidity apply;*
- ix. conversion is for the goods/services covered by the CTM or narrower;*
- x. OHIM forwards the conversion request to the relevant National Offices;*
- xi. the National Offices may require payment of the national application fee; and*
- xii. a translation in one of the official languages of the State in question of the request and of the documents accompanying it; and*
- xiii. an address for service in the State in question; and*
- xiv. a representation of the trade mark in the number of copies specified by the State in question;*
- xv. they may impose a deadline of not less than two months;*
- xvi. each State will examine the mark under their own trade mark laws.*

**6 marks**

**Total: 12 marks**