

P7 – Principles of Trade Mark Law  
Mark Scheme 2014

Part A

Half marks may be awarded where candidates' answers do not merit a full mark.

Question 1

a) What must Community trade marks be capable of in order to come within the definition of what is registrable under *CTMR Article 4 Signs of which a Community trade mark may consist?*

**2 marks**

b) Provide six examples of types of marks which may be registrable within the definition.

**3 marks**

**Total: 5 marks**

Answer

a)

i. capable of being represented graphically

**1 mark**

ii. capable of distinguishing the goods or services of one undertaking from those of other undertakings

**1 mark**

b) **0.5 marks up to a maximum of 3** for each of the following or other types of marks which are registrable:

- i. words (including personal names)
- ii. designs
- iii. letters
- iv. numerals
- v. the shape of goods
- vi. or of their packaging

**3 marks**

**Total: 5 marks**

## Question 2

- a) Under the provisions of *CTMR Article 10 Reproduction of Community trade marks in dictionaries*, in what circumstances can the proprietor of a Community Trade Mark object to the reproduction of a registered trade mark in a dictionary?  
**2 marks**
- b) What action must the publisher of the dictionary take if requested by the proprietor of the CTM?  
**3 marks**
- Total: 5 marks**

### Answer

a) If the reproduction of a Community trade mark in a dictionary, encyclopaedia or similar reference work

- i. gives the impression that it constitutes the generic name **1 mark**
- ii. of the goods or services for which the trade mark is registered **1 mark**

b) The publisher of the work shall

- i. at the request of the proprietor of the Community trade mark **0.5 marks**

ensure that the reproduction of the trade mark

- ii. at the latest **0.5 marks**
- iii. in the next edition of the publication **1 mark**
- iv. is accompanied by an indication that it is a registered trade mark. **1 mark**

**Total: 5 marks**

### Question 3

a) What are the only three types of corrections permitted to a UK trade mark application under *UKTMA Section 39 (2) Withdrawal restriction or amendment of application?*

**3 marks**

b) Under what conditions are these corrections permissible?

**2 marks**

**Total: 5 marks**

### Answer

a) The three types of corrections permitted are:

i. the name or address of the applicant

**1 mark**

ii. errors of wording (**0.5 marks**) or of copying (**0.5 marks**)

**1 mark**

iii. obvious mistakes

**1 mark**

b) The above corrections are permissible only where the correction does not

i. substantially (**0.5 marks**) affect the identity of the trade mark (**0.5 marks**)

**1 mark**

ii. or extend the goods or services covered by the application.

**1 mark**

**Total: 5 marks**

#### Question 4

- a) List the grounds for invalidity of a UK trade mark registration under *UKTMA Section 47 Grounds for invalidity of registration*.

**2 marks**

- b) Briefly outline three qualifications or limitations to the Grounds for Invalidity.

**3 marks**

**Total: 5 marks**

#### Answer

- a) The grounds are:

- i. The registration of a trade mark may be declared invalid on the ground that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (absolute grounds for refusal of registration).

**1 mark**

- ii. The registration of a trade mark may be declared invalid on grounds that the trade mark was registered in breach of section 3 or any of the provisions referred to in that section (relative grounds for refusal of registration).

**1 mark**

- b) **1 mark each for any three of the following:**

- i. In the case of s.3: Where the trade mark was registered in breach of subsection (1)(b), (c) or (d) of that section, it shall not be declared invalid if, in consequence of the use which has been made of it, it has after registration acquired a distinctive character in relation to the goods or services for which it is registered. (2<sup>nd</sup> para of s.47(1))
- ii. In the case of s.5: The earlier trade mark or earlier right is not a basis for invalidity if the proprietor has consented to the registration. (final words of s.47(2)).
- iii. In the case of s.5: the registration of a trade mark may not be declared invalid on the ground that there is an earlier trade mark if the earlier trade mark has been on the Register for more than five years unless the use conditions are met. (s.47(2A)).
- iv. Where the grounds of invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark shall be declared invalid as regards those goods or services only. (s.47(5)).

**Total: 5 marks**

### Question 5

a) Explain what is Restitutio in integrum under *CTMR Article 81 Restitutio in integrum*.

**2 marks**

b) Briefly outline the conditions for filing Restitutio in integrum (*CTMR Article 81 Restitutio in integrum*).

**3 marks**

**Total: 5 marks**

### Answer

a) Up to **2 marks** for an explanation setting out all the relevant provisions i.e.:

- i. the applicant for or proprietor of a Community trade mark or any other party to proceedings before the Office who,
- ii. in spite of all due care required by the circumstances having been taken,
- iii. was unable to comply with a time limit vis-à-vis the Office shall, upon application, have his rights re-established
- iv. if the obstacle to compliance has the direct consequence, by virtue of the provisions of this Regulation, of causing the loss of any right or means of redress.

b)

i. The application must be filed in writing within two months from the removal of the obstacle to compliance with the time limit.

**1 mark**

ii. The omitted act must be completed within this period.

**1 mark**

iii. The application shall only be admissible within the year immediately following the expiry of the unobserved time limit.

**1 mark**

**Total: 5 marks**

## Question 6

a) For what four reasons may conversion of a CTM application or registration be requested under *CTMR Article 112 Request for the application of national procedure*?

**2 marks**

b) For what two reasons, according to *CTMR Article 112 Request for the application of national procedure*, may conversion **not** take place?

**3 marks**

**Total: 5 marks**

## Answer

a) The applicant for or proprietor of a Community trade mark may request the conversion of his Community trade mark application or Community trade mark into a national trade mark application to the extent that the Community trade mark application

i. Is refused

**0.5 marks**

ii. Is withdrawn

**0.5 marks**

iii. Is deemed to be withdrawn

**0.5 marks**

iv. ceases to have effect.

**0.5 marks**

Candidates can earn **0.5 marks** for each valid reason in which registrations “cease to have effect”, such as invalidation, revocation, non renewal, up to a maximum of **2 marks**.

**b) Up to 1.5 marks each for two of the following reasons.**

Conversion shall not take place:

i. 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 for which conversion is requested the Community trade mark has been put to use which would be considered to be genuine use under the laws of that Member State;

ii. for the purpose of protection in a Member State in which, 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 to the Community trade mark application or Community trade mark.

iii. Where the applicant fails to apply for conversion within three months from the date of a communication from the Office, withdrawal, ceasing to have effect as a result of a surrender being recorded or of failure to renew the registration, refusal by decision of the Office, ceasing to have effect as a result of a decision of the Office or of a Community trade mark court which has become final. **It is not necessary to list all the circumstances set out in Art.4-6 to obtain full marks.**

**Total: 5 marks**

### Question 7

- a) Describe the terms of *Article 6bis of the Paris Convention for the Protection of Industrial Property* which provides for the protection of well-known marks. **3 marks**
- b) Describe the provisions in *Article 6bis* relating to time limits. **2 marks**
- Total: 5 marks**

### Answer

a) The countries of the Union undertake ex officio if their legislation so permits, or at the request of an interested party

- i. to refuse or to cancel the registration, and to prohibit the use, of a trademark **0.5 marks**
- ii. which constitutes a reproduction, an imitation, or a translation, liable to create confusion, **0.5 marks**
- iii. of a mark considered by the competent authority of the country of registration or use to be well known in that country **0.5 marks**
- iv. as being already the mark of a person entitled to the benefits of this Convention **0.5 marks**
- v. and used for identical or similar goods. **0.5 marks**
- vi. These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith. **0.5 marks**

- b)
- i. A period of at least five years from the date of registration shall be allowed for requesting the cancellation of such a mark. The countries of the Union may provide for a period within which the prohibition of use must be requested. **1 mark**
  - ii. No time limit shall be fixed for requesting the cancellation or the prohibition of the use of marks registered or used in bad faith. **1 mark**

**Total: 5 marks**



## Question 8

- a) *Madrid Protocol Article 6(2), (3) and (4) Dependence and Independence of International Registration* sets out the provisions relating to the concept known colloquially as 'central attack'. Briefly explain the provisions of *Article 6(2), (3) and (4)*.

**4 marks**

- b) What action, if any, can the proprietor of the Madrid Protocol registration take to maintain his rights in the event of a successful central attack?

**1 mark**

**Total: 5 marks**

## Answer

a) So long as the International Registration is dependent on the base application/registration, it is vulnerable to "central attack" i.e. a successful attack on the base registration defeats the International Registration as well whereas separate attacks in each state designated for protection are required after the International Registration becomes independent.

**1 mark**

Upon expiry of a period of five years from the date of the international registration, the international registration shall become independent of the basic application or the registration resulting therefrom, or of the basic registration, as the case may be

**1 mark**

subject to the following provisions.

- i. The protection resulting from the international registration may no longer be invoked **0.5 marks**

- ii. if, before the expiry of five years from the date of the international registration **0.5 marks**

- iii. the basic application or the registration resulting therefrom, or the basic registration, as the case may be **0.5 marks**

- iv. has been withdrawn, has lapsed, has been renounced or has been the subject of a final decision of rejection, revocation, cancellation or invalidation **0.5 marks**

and used for identical or similar goods.

These provisions shall also apply when the essential part of the mark constitutes a reproduction of any such well-known mark or an imitation liable to create confusion therewith.

b) He can request “transformation” of the international registrations into national registrations.

**1 mark**

**Total: 5 marks**

### Question 9

a) Who is entitled to own a Madrid Protocol registration under *Madrid Protocol Article 2 Securing Protection through International Registration*?

**2 marks**

b) What is a 'basic application' or 'basic registration' under *Madrid Protocol Article 2 Securing Protection through International Registration*?

**3 marks**

**Total: 5 marks**

### Answer

a) The applicant must be

i. a national

**0.5 marks**

ii. of a Contracting State which is a member of the Madrid Protocol

**0.5 marks**

iii. or be domiciled in the said Contracting State

**0.5 marks**

iv. or have a real and effective industrial or commercial establishment, in the said Contracting State

**0.5 marks**

b)

i. The applicant for registration of a Madrid Protocol mark must base his application on a "basic application" or "basic registration"

**0.5 marks**

ii. which is an application for the registration or registration of his mark filed with the Office of Origin

**1 mark**

iii. in the territory where he is a national, is domiciled or has a real and effective industrial or commercial establishment

**1.5 marks**

**Total: 5 marks**

**Part B**  
**Question 10**

a) List six of the criteria established by the Court of Justice of the European Union (CJEU) in the case of **Sabel BV v Puma AG, Rudolf Dassler Sport (C-251/95)** for determining whether there is a likelihood of confusion between two marks.

**9 marks**

b) State two of the three main criteria established by the CJEU in the case of **Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc. (C39/97)** for determining whether the similarity between goods or services covered by two marks is, or is not, sufficient to give rise to a likelihood of confusion.

**3 marks**

**Total: 12 marks**

**Answer**

a) **Up to 1.5 marks each for any of the following up to a maximum total of six criteria and a maximum 9 marks:**

- i. [I]t is clear from the tenth recital in the preamble to the Directive that the appreciation of the likelihood of confusion 'depends on numerous elements and, in particular, on the recognition of the trade mark on the market, of the association which can be made with the used or registered sign, of the degree of similarity between the trade mark and the sign and between the goods or services identified'. *Sabel v Puma para 22*
- ii. The likelihood of confusion must therefore be appreciated globally, taking into account all factors relevant to the circumstances of the case. *Sabel v Puma para 22*
- iii. That global appreciation of the visual, aural or conceptual similarity of the marks in question, must be based on the overall impression given by the marks, bearing in mind, in particular, their distinctive and dominant components. *Sabel v Puma para 23*
- iv. [T]he perception of marks in the mind of the average consumer of the type of goods or services in question plays a decisive role in the global appreciation of the likelihood of confusion. *Sabel v Puma para 23*
- v. The average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. *Sabel v Puma para 23*
- vi. [T]he more distinctive the earlier mark, the greater will be the likelihood of confusion. *Sabel v Puma para 24*
- vii. It is therefore not impossible that the conceptual similarity resulting from the fact that two marks use images with analogous semantic content may give rise to a likelihood of confusion where the earlier mark has a particularly distinctive character, either per se or because of the reputation it enjoys with the public. *Sabel v Puma para 24*

- viii. [W]here the earlier mark is not especially well known to the public and consists of an image with little imaginative content, the mere fact that the two marks are conceptually similar is not sufficient to give rise to a likelihood of confusion. *Sabel v Puma para 25*
- ix. [T]he criterion of 'likelihood of confusion which includes the likelihood of association with the earlier mark' ... is to be interpreted as meaning that the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion within the meaning of that provision. *Sabel v Puma para 26*

**b) The three main findings in the decision are the answers of the CJEU made to the question posed by the Bundesgerichtshof (see (xiii) – (xvii) below). However, since many of the other statements made by the CJEU in the course of its decision are still cited, candidates could earn up to 1.5 marks for any two of the following statements up to a maximum total of 3 marks.**

- i) [T]he tenth recital of the preamble to the Directive states that 'the protection afforded by the registered trade mark, the function of which is in particular to guarantee the trade mark as an indication of origin, is absolute in the case of identity between the mark and the sign and goods or services; ... the protection applies also in case of similarity between the mark and the sign and the goods or services; ... it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion; ... the likelihood of confusion, the appreciation of which depends on numerous elements and, in particular, on the recognition of the trade mark on the market, [on] the association which can be made with the used or registered sign, [and on] the degree of similarity between the trade mark and the sign and between the goods or services identified, constitutes the specific condition for such protection'. *Canon v MGM para 15*
- ii) [T]he Court has held that the likelihood of confusion on the part of the public, in the absence of which Article 4(1)(b) of the Directive does not apply, must be appreciated globally, taking into account all factors relevant to the circumstances of the case *Case C-251/95 SABEL v Puma [1997] quoted in Canon v MGM para 16*
- iii) A global assessment of the likelihood of confusion implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between these goods or services. *Canon v MGM para 17*
- iv) [A] lesser degree of similarity between these goods or services may be offset by a greater degree of similarity between the marks, and vice versa. *Canon v MGM para 17*
- v) The interdependence of these factors is expressly mentioned in the tenth recital of the preamble to the Directive, which states that it is indispensable to give an interpretation of the concept of similarity in relation to the likelihood of confusion, the appreciation of which depends, in particular, on the recognition of the trade mark on the market and the degree of similarity between the mark and the sign and between the goods or services identified. *Canon v MGM para 17*

- vi) [A]ccording to the case-law of the Court, the more distinctive the earlier mark, the greater the risk of confusion *Case C-251/95 SABEL v Puma [1997] quoted in Canon v MGM para 18*
- vii) Since protection of a trade mark depends ... on there being a likelihood of confusion, marks with a highly distinctive character, either per se or because of the reputation they possess on the market, enjoy broader protection than marks with a less distinctive character. *Canon v MGM para 18*
- viii) [R]egistration of a trade mark may have to be refused, despite a lesser degree of similarity between the goods or services covered, where the marks are very similar and the earlier mark, in particular its reputation, is highly distinctive. *Canon v MGM para 19*
- ix) [E]ven where a mark is identical to another with a highly distinctive character, it is still necessary to adduce evidence of similarity between the goods or services covered. *Canon v MGM para 22*
- x) [T]he likelihood of confusion presupposes that the goods or services covered are identical or similar. *Canon v MGM para 22*
- xi) In assessing the similarity of the goods or services concerned ... all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary. *Canon v MGM para 23*
- xii) [T]he distinctive character of the earlier trade mark, and in particular its reputation, must be taken into account when determining whether the similarity between the goods or services covered by the two trade marks is sufficient to give rise to the likelihood of confusion. *Canon v MGM para 24*
- xiii) There is a likelihood of confusion ... where the public can be mistaken as to the origin of the goods or services in question. *Canon v MGM para 26*
- xiv) [T]he risk that the public might believe that the goods or services in question come from the same undertaking or, as the case may be, from economically-linked undertakings, constitutes a likelihood of confusion. *Canon v MGM para 29*
- xv) [I]n order to demonstrate that there is no likelihood of confusion, it is not sufficient to show simply that there is no likelihood of the public being confused as to the place of production of the goods or services. *Canon v MGM para 29*
- xvi) [T]here may be a likelihood of confusion ... even where the public perception is that the goods or services have different places of production. *Canon v MGM para 30*
- xvii) By contrast, there can be no such likelihood where it does not appear that the public could believe that the goods or services come from the same undertaking or, as the case may be, from economically-linked undertakings. *Canon v MGM para 30*

**Total: 12 marks**

## Question 11

- a) What is the initial registration term of the following trade mark registrations and from what date does the registration term start to run?
- i. UK (*UKTMA Section 42 Duration of registration*). **1 mark**
  - ii. CTM (*CTMR Article 46 Duration of registration*). **1 mark**
  - iii. Madrid Protocol (*Madrid Protocol Article 6 Period of Validity of International Registration*). **1 mark**
- b) For the following registrations, during what time period can renewal fees be paid and, if they are not timely paid, what grace period is permitted for late renewal?
- i. UK (*UKTMA Section 43 Renewal of registration*). **1 mark**
  - ii. CTM (*CTMR Article 47 Renewal*). **1 mark**
  - iii. Madrid Protocol (*Madrid Protocol Article 7 Renewal of International Registration*). **1 mark**
- c) UK, CTM and Madrid Protocol registrations for a mark in use have been allowed to expire through non-renewal and the grace period has also expired last month.

List any options available to a proprietor who wishes to continue protection for his mark and describe any potential difficulties with those options.

**6 marks**

**Total: 12 marks**

## Answer

- a)
- i. UK 10 years **(0.5 marks)** from the date of registration which is deemed to be the date of filing **(0.5 marks)** **1 mark**
  - ii. CTM 10 years **(0.5 marks)** from the date of filing **(0.5 marks)** **1 mark**
  - iii. Madrid Protocol 10 years **(0.5 marks)** from the date of filing **(0.5 marks)** **1 mark**
- b)
- i. UK renewal fees are payable up to six months before expiry of the registration **(0.5 marks)** and late renewal is permissible during the six months after the expiry date. **(0.5 marks)** **1 mark**

- ii. CTM renewal fees are payable within a period of six months ending on the last day of the month in which protection ends **(0.5 marks)** and late renewal is permissible during the following six months. **(0.5 marks)**
- 1 mark**
- iii. Madrid Protocol renewal fees are payable up to three months before expiry of the registration **(0.5 marks)** and late renewal is permissible during the six months after the expiry date. **(0.5 marks)**
- 1 mark**
- c)
- i. Restoration may be available for a UK registration.
- 1 mark**
- ii. UKIPO is not required to restore the registration. Per s.36(1) the registration may only be restored “if, having regard to the circumstances of the failure to renew, the registrar is satisfied that it is just to do so”. In addition to filing the renewal request form + fee and the restoration request + fee, the proprietor must provide a full explanation of why the mark was not renewed within time. There should have been a continuing underlying intention to maintain the registration and if that is not proved, UKIPO may refuse to restore the registration.
- 1 mark**
- iii. Restitutio in integrum may be an option for a CTM registration
- 1 mark**
- iv. An application for restitutio must be filed in writing within two months from the removal of the obstacle to compliance with the time limit. The omitted act must be completed within this period. The application shall only be admissible within the year immediately following expiry of the unobserved time limit
- 1 mark**
- v. It may be possible to reregister the mark in all jurisdictions where protection is required.
- 1 mark**
- vi. Although it is possible to file a new application to register the mark, the application may be refused or opposed if another party has registered a similar mark prior to the refiling. The proprietor should therefore conduct searches in all territories where protection is required. In the event that a problem mark is located, it may be possible in some territories to overcome an objection based on the client’s continuous use of his mark.
- 1 mark**

**Total: 12 marks**



## Question 12

- a) List the four types of legal proceedings over which the EU Community trade mark courts have exclusive jurisdiction under *CTMR Article 96 Jurisdiction over infringement and validity*.

**4 marks**

- b) Set out the provisions of *CTMR Article 97 International jurisdiction* that govern where in the EU actions and claims referred to in Article 96 above must be brought.

**8 marks**

**Total: 12 marks**

### Answer

**Candidates are not expected to recite Article numbers or the names of Regulations**

- a) The Community trade mark courts shall have exclusive jurisdiction:

- i. for all infringement actions and — if they are permitted under national law — actions in respect of threatened infringement relating to Community trade marks;

**1 mark**

- ii. for actions for declaration of non-infringement, if they are permitted under national law;

**1 mark**

- iii. for all actions brought as a result of acts referred to in Article 9(3), second sentence;

**1 mark**

- iv. for counterclaims for revocation or for a declaration of invalidity of the Community trade mark pursuant to Article 100.

**1 mark**

- b) Subject to the provisions of this Regulation as well as to any provisions of Regulation (EC) No 44/2001 applicable by virtue of Article 94:

- i. proceedings shall be brought in the courts of the Member State in which the defendant is domiciled

**1 mark**

- ii. or if he is not domiciled in any of the Member States, in which he has an establishment.

**1 mark**

- iii. If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled

**1 mark**

- iv. or, if he is not domiciled in any of the Member States, in which he has an establishment.

**1 mark**

- v. If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the Office has its seat.

**1 mark**

Notwithstanding the above

- i. Article 23 of Regulation (EC) No 44/2001 shall apply if the parties agree that a different Community trade mark court shall have jurisdiction;  
**1 mark**
- ii. Article 24 of Regulation (EC) No 44/2001 shall apply if the defendant enters an appearance before a different Community trade mark court.  
**1 mark**
- iii. Proceedings in respect of the actions and claims referred to in Article 96, with the exception of actions for a declaration of non-infringement of a Community trade mark, may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened, or in which an act within the meaning of Article 9(3), second sentence, has been committed.  
**1 mark**

**Total: 12 marks**

### Question 13

Your UK client consults you about a new trade mark which he wishes to register immediately in UK, Denmark, Sweden, and Norway.

He has heard that there are different trade mark registration systems (national registrations, Community trade mark registrations and Madrid Protocol registrations) and wants your help in deciding which is/are appropriate for his situation.

Draft notes to answer the following questions that the client has raised. Confine your notes to the options for registration and do not advise about other aspects of protection such as searching or distinctiveness.

- a) Which of the systems of registration, or combinations of systems, can the client use to obtain protection in the above territories of interest? **3 marks**
- b) How can the client obtain additional future protection in:
- i. Territories which may join the Madrid Protocol at a future date? **1 mark**
  - ii. Territories which may join the European Union at a future date? **1 mark**
- c) Can you represent your client in relation to all national, CTM or Madrid Protocol registrations or, if not, when must your client retain a foreign attorney? **3 marks**
- d) Outline a total of four advantages or disadvantages to one or more of the systems of registration. **4 marks**

**Total: 12 marks**

### Answer

Client could register:

- i. separate national registrations in each territory **0.5 marks**
- ii. CTM (covering all member states of the EU including UK, Sweden and Denmark) plus national registration in Norway **0.5 marks**
- iii. The latter is the most cost effective option but the choice may depend on other factors such as whether there are potential conflicts in other member states of the EU **0.5 marks**
- iv. UK (basic) registration with Madrid Protocol designating Denmark Sweden and Norway **0.5 marks**

v. UK (basic) registration with Madrid Protocol designating CTM and Norway **0.5 marks**

vi. CTM (basic) registration with Madrid protocol designating Norway **0.5 marks**

b)

i. To obtain protection in additional territories which join MP, it will be necessary to file a subsequent designation **(0.5 marks)** which is similar to the initial registration procedure but is still part of a single registration **(0.5 marks)**  
**1 mark**

ii. CTM can only ever cover EU but as EU expands a CTM automatically expands to cover new members with no action required by proprietor

**1 mark**

c) **0.5 marks for each of the following**

- i. For UK, you can deal with complete procedure
- ii. For CTM, you can deal with complete procedure
- iii. For Madrid Protocol, you can deal with complete procedure
- iv. Unless official objections are raised by national offices
- v. In which event local attorneys must be appointed in each territory where you are not authorised to act
- vi. For national registrations other than UK, it is necessary to retain an attorney authorised to act in each territory of interest

d) **One mark for each of the following or other reasonable suggestions**

- i. Separate national registrations generally cost more because it is necessary to retain a local attorney in each case
- ii. Successful opposition to a CTM based on 1 national registration causes the entire application to be refused
- iii. In general, a period of non use leads to vulnerability to revocation on grounds of non use but a CTM remains valid even if the mark is only used in one part of the EU.
- iv. In the first five years of registration, a successful attack on the basic registration results in refusal of the entire MP

**Total: 12 marks**

## Question 14

Your client has sold walking shoes continuously since the 1960s throughout the UK under the invented name RAMBLEEZ. He has never registered his trade mark.

Your client reports that a customer has just brought in a complaint about a walking shoe under the name RAMBLEASY. Research has disclosed that the shoe was not made by the client but by a company called Shoos Limited which started selling shoes under the trade mark RAMBLEASY in 2013 and filed a UK trade mark application for the mark RAMBLEASY on 10<sup>th</sup> April 2014. The application was published for opposition on 24<sup>th</sup> August 2014.

- a) Name the legal action available to your client to prevent continued sales of the RAMBLEASY product. Do **not** consider interim injunctions. **1 mark**
- b) Explain what your client must prove and, using the facts in the question, explain whether the client is likely to succeed or fail. **6 marks**
- c) Can your client prevent registration of the trade mark application? If so, on what grounds and is there any deadline? **2 marks**
- d) Apart from the actions described above, what else might your client do to improve his position generally? **3 marks**

**Total: 12 marks**

## Answer

- a)
- i. He can consider bringing an action to restrain passing off.
- b) **1 mark each for a brief explanation of goodwill, misrepresentation and damage**
- i. The client must show that he has built up a protectable goodwill through sales of his products under the name X in the UK
  - ii. The client must show that the defendant's sales of his shoes constitute a misrepresentation to the public which will lead the public to believe that the shoes of the defendant are the shoes of (or endorsed by) the client. Confusion is not essential but can be good evidence of a misrepresentation.
  - iii. Damage or the likelihood of damage can be in the form of loss of sales or damage to goodwill. Damage may be inferred if goodwill and misrepresentation are present.

### **1 mark each for a brief explanation of the factors which indicate that in this case goodwill, misrepresentation and damage are present**

- iv. Goodwill: the client has been carrying on business in the UK under the mark continuously for many decades and an invented word should indicate that the mark is

strong (ie it is easier to educate the public that the mark denotes the client's products than it would be with a descriptive mark).

- v. Misrepresentation: the client's mark is distinctive, the products are identical, the two marks are close and a customer has apparently been confused. If the complaint is because the defendant's shoe is faulty, there may also be a misrepresentation as to quality.
  - vi. Damage: the apparent confusion by a customer may indicate that the customer bought the shoe in the mistaken belief that it was the client's (ie loss of a sale). Additionally, the complaint suggests that the defendant's shoe may be substandard which could damage the client's reputation. The client appears to have a strong case on goodwill and misrepresentation such that damage may be inevitable.
- c)
- i. The client can oppose the trade mark application **(0.5 marks)** under s.5(4)(a) based on his passing off rights **(0.5 marks)** and must file opposition by 24<sup>th</sup> October 2014 **(0.5 marks)** or seek a 1 month extension of time and file opposition by 24<sup>th</sup> November 2014 **(0.5 marks)**

**2 marks**

d) **1 mark for each of the following or other reasonable suggestions up to a maximum of 3 marks:**

- i. Write a cease and desist letter which may avoid the expense of legal action
- ii. Register his mark in UK and any other territories where the client trades/intends to trade in the foreseeable future
- iii. Mark products with <sup>TM</sup> for the time being and with ® when the mark is registered, to indicate that the mark is a trade mark
- iv. Use a watching service to obtain notice of future competing trade mark applications

**Total: 12 marks**

## Question 15

Describe the standard UK opposition procedure (not the fast track opposition procedure).

**Total: 12 marks**

### Answer

**0.5 marks for each of the following up to a maximum of 12 marks.**

- i. Trade Mark Application advertised
- ii. in Trade Mark Journal
- iii. 2 months to file Opposition
- iv. 1 month Extension of Time possible
- v. Advisable as it serves as notice of intention to file opposition, without which a successful opponent may be penalised on costs
- vi. Opponent files Notice of Opposition
- vii. Plus Statement of Grounds
- viii. Plus fee
- ix. Opposition can be on absolute grounds filed by anyone
- x. Opposition can be on relative grounds by the owner of the earlier trade mark/earlier right
- xi. UKIPO serves Notice of Opposition on Applicant
- xii. The date of service is called the "Notification Date"
- xiii. The Applicant must file a Counter-Statement
- xiv. Within 2 months of the Notification Date..
- xv. Otherwise the Trade Mark Application is deemed abandoned
- xvi. Unless either party applies to enter into the "Cooling Off period"
- xvii. Which lasts for up to 9 months
- xviii. The Cooling Off period is extendible for a further 9 months
- xix. if UKIPO is satisfied that negotiations are ongoing
- xx. If the Opponent terminates the Cooling Off period, the Applicant has 1 month to file his counterstatement (or 2 months from the Notification Date, whichever is later)
- xxi. The Applicant can terminate the Cooling Off period by filing his counterstatement
- xxii. If the Opposition is based on s.5(1) or (2), UKIPO may issue a Preliminary Indication stating whether TM should be refused
- xxiii. The date of issue of the Preliminary Indication is the Indication Date
- xxiv. If the Preliminary Indication is that the Trade Mark Application should not be refused, the Opposition is treated as withdrawn
- xxv. unless, within 1 month of the Indication Date, the Opponent requests that the Opposition proceed
- xxvi. If the Preliminary Indication is that the Trade Mark Application should be refused, the Trade Mark Application is treated as withdrawn
- xxvii. unless, within 1 month of the Indication Date, the Applicant requests that the Opposition proceed
- xxviii. Where the Opposition proceeds It is optional for the Opponent to file evidence if it is based on s.5(1) or (2)
- xxix. If the Opposition is on any other grounds, the Opponent has 2 months to file evidence
- xxx. If the Opposition is based on a trade mark which has been registered for more than 5 years, the Opponent must file proof of use Unless he has stated in the Notice of

Opposition that the mark has been used in the relevant period and the Applicant does not contest that statement

- xxxi. The Applicant then has 2 months to file evidence
- xxxii. The Opponent then has 1 month to state whether he has the intention to file evidence of fact in reply
- xxxiii. in which case the has a further 1 month to file evidence of fact in reply
- xxxiv. Evidence terms may be extended subject to the filing of a request for an extension of time with full and detailed reasons why additional time required
- xxxv. It is possible to request a stay or suspension provided UK IPO satisfied why a stay is required
- xxxvi. After the filing of evidence is complete, a Hearing appointed
- xxxvii. if either party requests it
- xxxviii. UKIPO issues its decision
- xxxix. which can be appealed to an "appointed person"
- xl. or to the Court
- xli. within 1 month
- xlii. There is no further appeal from the decision of the Appointed Person
- xliii. There is a further appeal from the decision of the Court
- xliv. UKIPO aims to complete Oppositions within 12 months of the filing of the Applicant's defence.

**Total: 12 marks**