

Examiner's
use only**Question 1**

High Court will have jurisdiction Not domiciled in an EU member state over a US domiciled defendant when:

He has a real and effective commercial or industrial establishment in the UK. ✓

If he has no establishment in the EU: ✓

If the claimant is domiciled in the UK. ✓

If the claimant is not domiciled in the EU:

If the claimant has a real and effective commercial or industrial ✓
establishment in the UK.

Irrespective of the above, a case may be brought in the UK:

with consent of both the parties; or

if the infringement occurred in the UK ✓

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MARKS AWARDED 5/5**Question 2**

a) Plus 10 years from relevant date (date of filing)

31 August 2019 ✓

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b) Plus 10 years from filing date, to the end of the calendar month

31 August 2019

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c) Bank holidays are closed days at the UKIPO (and banks) as are weekends so roll on to the next open day:

23 April 2019 ✓

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d) There is a 6-month grace period for renewing Madrid Protocol ✓ Trademarks.
This expires on 10 January 2018.

We should pay the renewal fee (and any incurred late fees ✓) prior to the
expiry of the grace period.

2

MARKS AWARDED 4/5

Question 3

- a) The exclusive licence must be made in writing and signed by the parties.

Either party may, by communicating the licence to the Registrar in writing, have the licence entered onto the Register.

Having done so, the exclusive licensee can now enforce the trademark (by initiating infringement proceedings) against would-be/alleged infringers without needing to get the proprietor to do so. ✓

The proprietor must still be joined to proceedings, but is only liable for costs if they choose to become involved.

Also prevents registration of any other licences that the ✓ proprietor may (in contravention of the terms of the exclusive licence ✓) sign.

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- b) 6 months from the license coming into force ✓

Cannot prove infringement or damages for activities that are done before the licence is registered if it is not registered within the prescribed period.

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MARKS AWARDED 4/5

Question 4

- a) Not useful as EUTM, are of unitary character. Therefore refusal based on grounds relating to any EU language (including Greek) will result in rejection for the entire EUTM as it cannot be separated. ✓

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- b) It will maintain the filing date of the EUTM for the national applications. ✓

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- c) It can only be converted with respect to EU member states where the objection does not arise ✓ (i.e. the EUTM application cannot be converted in any member state where Greek is spoken as a language as the objection for 'Nero' being descriptive will still stand).

Therefore it cannot be converted to national TM application in:

Greece ✓

Cyprus ✓

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Places where Greek is not spoken (barring other objections) should be possible.

MARKS AWARDED 5/5

Question 5

- a) Exhaustion ✓ of rights within the EU – relating to the idea that the EU should operate as a single market.

Once sold with the proprietor's (or a licensee's) consent within the EU ✓, the marked products can be traded freely without the proprietor being able to enforce the trademark against subsequent sales (or other acts) within the EU.

Harry is buying in one EU country (Germany) and selling in another (France) and hence cannot be pursued for infringement of the EUTM.

Proprietors can object if the product is altered before the subsequent sale, but Harry does not appear to be doing this so Emerald cannot use this exception to enforce their EUTM. ✓

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- b) Harry would be fine to purchase in Germany, but import and sale in France may be infringement of the French TM. However: there should be no qualitative or quantitative restrictions on imports and exports between EU member states – but there are provisions allowing intellectual property. In this case, it is the same right being obeyed in one state and broken in the other, on balance it would seem consistent to say that it makes no difference.

No infringement. ✓

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MARKS AWARDED 4/5

Question 6

- a) On the grounds that the shape of the product is dictated by the nature of the goods (i.e. that the dimples are necessary for the increased effervescence).

Devoid of distinctive character ✓

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- b) This helps overcome objections relating to a lack of distinctive character, being descriptive and using terms customary in the trade concerned as it shows that distinctive character has been acquired through use before the application was filed. ✓

Does not help against any other objections (i.e. that the dimples [shape of the product] are due to the nature of the goods). ✓

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MARKS AWARDED 3/5

Question 7

It consists solely of signs and indications which are customary in the language and bona fide and established practices of trade in the sector concerned. ✓

It is standard chemical nomenclature and is therefore consists of a term which would be generic in the trade concerned (i.e. chemistry). ✓

It consists solely of signs and indications that are descriptive of the kind of product as it is simply the generic word (akin to trying to trademark 'sucrose') for the compound. ✓

It is devoid of descriptive character as it is simply saying what it is. ✓

These grounds could be circumvented in William could prove that the term had acquired distinctiveness, but as it is a new product this is doubtful.

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MARKS AWARDED 4/5

Question 9

a) The owner of a trade mark for certain goods/services is not infringing if they are using the mark for the goods/services for which it is registered (subject to any invalidity proceeding). ✓

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b) No, infringement (and defences to it) of EUTM's is governed by 'EUTM Regulation', not the UK trademark, act ✓

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c) Yes, as EUTMs are one of the rights listed in the section as providing the defence

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d) No, passing off is within Tort law, which the section does not relate to. ✓

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e) Yes, but should their trade mark be found invalid they will lose the defence (and their trademark) so it may not be a good idea to do so. ½

½

MARKS AWARDED 3.5/5

Question 10

a) Errors in Copying ✓, Typographical errors ✓
Errors which are obvious ✓

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As long as the corrections do not substantially affect the overall character of the mark they should be allowable.

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- b) It is barely legible therefore altering it will not have a substantial effect on the character of the mark and is obviously wrong as it is a reference to the alcohol content of the beer, which is different to what is currently written.

There should be able to amend.

- c) Camilla is unable to use the trademark as it would be illegal to do so. Hence she cannot fulfil the use conditions and cannot bring any claim for infringement.

- d) They may be able to counterclaim for invalidity on the basis that the application was made in bad faith as if Camilla did use the mark as shown on the representation she would be breaking the law. A similar argument applies for the grounds of public policy as accurate labelling of alcohol percentages is a public policy.

After 5 years of non-use, can apply to have the mark revoked on the grounds of non-use ✓

MARKS AWARDED 4/12

Question 11

- a) Priority is the right to claim the filing date of an earlier application ✓ within 6 months of its filing ✓, in a convention country ✓, provided that:

the applicant is the same for both applications

the representation is the same for both applications

and the goods/services are the same or narrower in the subsequent application

Priority must be claimed during application, within 2 months of filing

It has the effect of making the effective filing date of the subsequent application that of the earlier one, thereby eliminating from consideration any TMs/rights filed/arising in that period from consideration for registrability on relative grounds. ✓

Seniority is where, for an EUTM, there is an earlier national TM ✓ with:

the same applicant

the same representation

& the same goods or services (goods or services of the EUTM may be narrower)

The applicant may file for seniority on application, within 3 months of the filing date or after registration. ✓

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The EUTM will be considered to have the filing date of the earlier national TM in that member state. ✓

Additionally, on conversion the resulting national right will retain that earlier date in the member state.

b) Basic application is the application which the international registration is based on. ✓

It is the TM application (or TM) (in the state, which is contracting to the Madrid Protocol, in which the applicant is a citizen of ✓, is habitually resident in or has a real and effective industrial or commercial establishment) which the applicant forwards to the IB (via the Office of Origin) to base the international registration on. If this basic application lapses, is refused, cancelled, withdrawn or surrendered within 5 years of filing the ✓ International registration, the entire international registration fails.

Priority application is an application from which the basic application claims priority.

MARKS AWARDED 10/12

Question 12

To stop registration, Midori would have to oppose – what grounds do they have?

The mark is identical ✓

Midori's brand known to the relevant class of person.

Midori have no relevant Trademark, designs or copyright on which they can base opposition in the UK.

KI is (in the English language) a made up word so is distinctive, not descriptive or common in trade – opposition cannot therefore be based on these grounds.

As far as we know, none of the other absolute grounds (e.g. public policy, morality or bad faith application) apply. [Marketing staff shocked – clearly not bad faith]

Midori have had the Japanese trademark for over 50 years, cannot therefore claim priority to have a later filed but earlier priority application to base opposition on.

Known to the relevant class of person, but no exporting to, or economic activity within, the UK. Therefore no goodwill so no opposition based on those grounds (i.e. passing off).

No UK rights or marks that can be enforced to prevent Brown using KI

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Midori may be able to invoke Art 6Bis Paris Convention for well-known mark, ✓
in order to prevent registration

But this seems unlikely as Sake is not common outside Asia (KI only protected in Japan, probably only a significant market there) so probably would not qualify as a well-known mark.

Brown probably did not have to take any action to register and use KI for their product successfully.

However, to avoid friction it would probably be sensible to explain that product and intended market (a milkshake in the UK) does not conflict with their operation (sake in Japan) so taking action is unnecessary.

If truly worried by Midori's stance, could amend the registered goods to be more specific (e.g. milkshake) ✓, which would avoid any clash of goods ✓

MARKS AWARDED 4/12

Question 13

The marks are identical – both CALEDONIA ✓

Yellow's was registered for over 40 years and so qualifies as an earlier trade mark.

The goods and services are dissimilar (garden sprinklers vs carbonated beverages)

UKIPO has already considered, & rejected, objection on the grounds of being descriptive of geographical origin – therefore this ground is unlikely to work in opposition proceedings. But the ground is available as the UK allows opposition on absolute grounds. Could also apply to Yellow's trademark, but we can demonstrate acquired distinctiveness – using the surveys as evidence so no harm in trying.

CALEDONIA is not a term customary in the garden sprinkler trade so cannot use this ground

It is not devoid of distinctive character.

Clearly capable of being represented graphically + distinguishing goods/services of one undertaking from those of others

Yellow Ltd has in CALEDONIA, a mark with reputation (as evidenced by the surveys and market share) in the UK. ✓

Opposition can be brought on the grounds that there exists an earlier mark with reputation in the UK and the use of similar or identical marks without due cause $\frac{1}{2}$ would take undue advantage $\frac{1}{2}$ of the reputation of $\frac{1}{2}$ the earlier mark or cause damage $\frac{1}{2}$ to the reputation of $\frac{1}{2}$ the earlier mark.

It is therefore unlikely that Yellow Ltd will be able to bring a successful opposition against the application.

Green's use does not take advantage or unduly harm the reputation of Yellow's mark. ✓

More detail needed.

Yellow's acquired distinctiveness (Windsurfing Chiemsee):

Market share – second most popular for over a decade
intensity, geographical spread & longevity – all over the UK for over 40 years
relevant class of person recognising it as a badge of origin – survey

So likely has it.

As the goods and services are dissimilar cannot rely on:

identical mark for identical goods/services
identical mark for similar goods/services with the likelihood of confusion
including likelihood of association ✓

MARKS AWARDED 6.5/12

Question 14

- | | |
|---|---------------|
| a) They cannot assign it as it is not theirs to assign – it is present in the public and their perception of the undertaking. $\frac{1}{2}$ | $\frac{1}{2}$ |
| b) i) Goodwill is not mere reputation, but is “attractive force” that encourages people to seek out a particular undertaking, goods or services.

Therefore it seems likely that a mark that has goodwill will also be a mark with reputation in the UK . | 0 |
| ii) A mark with reputation does not necessarily have goodwill. | 0 |
| iii) A well-known trade mark does not necessarily have goodwill. Why? | 0 |
| c) If there are two (or more) meanings to a word, meanings other than the obvious are secondary meanings. If a secondary meaning is non-infringing then it should be used in preference to the primary meaning. | 0 |

d) The goodwill could have accrued in the business itself, therefore meaning that the products do not need to be marked. ✓ For example, an art dealership may have acquired goodwill, but would not be marking its products. ✓

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e) They are very different products, so confusion and misrepresentation ✓ resulting in damage to her goodwill would be hard to prove.

The names are also different (CAESAR vs THE CAESAR), further reducing the likelihood of misrepresentation and damage. ✓

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f) They can.

Likelihood of damage is sufficient ✓

or possible future damage, such as restricting the possibility of expanding a business. ✓

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