

Examiner's
use only**Question 1**

- A) Actions for infringement shall be brought at the national court of the contracting party in which the defendant:
- is domiciled
 - or has an establishment. $\frac{1}{2}$
- B) If the above is not true ✓, action shall be brought at the national court of the contracting party in which the plaintiff:
- is domiciled
 - or has an establishment
- C) If neither of the above are true, action shall be brought at the national court in the territory in which the office has its seat – Alicante Spain
- D) Or, The parties may agree that action may be brought elsewhere, at a national court of a different contracting party
- E) Or, in the national court of the contracting party where the infringement took place.

As A is not true – US is not in the EU – the only way in which the high court of England and Wales has jurisdiction is if condition B is met (i.e. plaintiff is domiciled/has an establishment in England/Wales) ✓, or if the parties agree to bring action ✓ here, or if the infringing act occurred here. ✓

 $4\frac{1}{2}$ **MARKS AWARDED 4.5/5****Question 2**

- a) Runs until (would expire if not paid)
31 August 2019
 Therefore 1 September 2019
 (10 years from filing date). $\frac{1}{2}$
 Will award $\frac{1}{2}$ point, even though 1 day out
- b) Helium – EU – 10 years from filing date
 TM would expire on 20 August 2019 (if not paid) Therefore 21 August 2019.

 $\frac{1}{2}$ $\frac{1}{2}$

- c) 19 April – Friday
 20 April – Saturday
 21 April – Sunday
 22 April – Monday
 20 April is a Sat, so would fall on the Mon, but The UKIPO is closed for a public holiday on Easter Monday. Therefore by 23 April 2019✓
- d) 10 July 2017 + 6 months = 10 January 2018.
- within the 6 month extended period in which a trade mark can be renewed late under the Madrid Protocol. ✓
 - Apply for renewal, pay fee, pay✓ extra late fee.

Fees consist of a Basic renewal fee (for up to 3 classes) + a supplementary fee (for each class over 3) + a complimentary fee for each territory or an individual fee in place of supplementary/complementary fees.

MARKS AWARDED 4/5

Question 3

- a) The benefit of registering an exclusive licence at the UKIPO is that, after registration, the licensee has exclusive rights in the trade mark against others, including the person granting the licence, as if the licence had been an assignment.

As the exclusive licence includes the right to bring infringement proceedings, its registration will enable the exclusive licensee to bring infringement action against a party Registration✓ of the licence will ensure that all remedies are available to the licensee – as would have been available to the proprietor – in respect of any such proceedings.

- b) A licence must be recorded within 6 months✓ from the date that it was executed. If the office is satisfied that it was not practicable to register a licence within the initial 6 month period, the licence must be registered as soon as practicable thereafter. If these time limits have not been met, the licensee will not be able to exercise his rights in respect of a party having an interest in or under any right in the trade mark or in ignorance of it*; and the licensee will not have the protection afforded by sections 30 and 31 of the UKTMA (rights and remedies of licensees in respect of infringement) available to him. ½

* point credited to part (a) as this was part of the required answer. Would have credited more had answer been more detailed.

MARKS AWARDED 3.5/5

Question 4

- a) An applicant can overcome an objection under Article 7(1)(b), (c), and (d) if he is able to prove that, prior to or at the time of filing the application the mark has acquired distinctive character. The EU citizens may not understand that the mark means “water” – which is good as it may not then be regarded as purely descriptive – so this helps my client to an extent. However the citizens recognise the mark as being something else – the name of a Roman Emperor – so it may be judged as devoid of distinctive character. Plus, other grounds remain – this does not overcome all grounds. 0
- b) The advantage of ‘conversion’ is that the consequent national trademark applications all enjoy the filing, priority and/or seniority (in applicable territories) dates of the original EU trade mark application✓. The filing of the national applications is also facilitated by the EUIPO, as the application for conversion is filed there – making this initial step administratively simpler. 1
- c) EU TM applications may only be converted into national trade mark applications in which no grounds for refusal have been raised. Therefore the application must only be converted into national applications in respect of territories for which the grounds do not apply. ✓ 1

MARKS AWARDED 2/5

Question 5

- a) – Exhaustion of rights.
The proprietor of an EU trade mark may not prohibit its use if it has been used, by or with consent of the proprietor, in relation to goods and services which have been put on sale in the Union✓. His rights to prohibit the use of the trade mark extend only to the first sale, and after which his rights are said to be exhausted✓. The proprietor can prohibit use of the trade mark if the quality of the goods have been impaired after having been put on the market. ✓
– Emeralds rights are exhausted, as it sells the whiskey throughout Europe under the mark.
– However Harry may be breaking rules in relation to fair dealings, and trade within the Union. 3
- b) No – as Germany and France are both contracting parties of the Union, Exhaustion of Rights provisions will extend to each of these territories, in relation to the sale/commercialisation of goods and services in the Union. ✓ 1

MARKS AWARDED 4/5

Question 6

- a) – The trade mark consists exclusively of the shape, (or other characteristics) which is required to produce a technical result. ✓
 - The trade mark consists of an indication or sign which may serve in trade to designate the kind, quality, quantity, value, geographical origin, intended purpose, time taken of producing goods or of rendering services, or other characteristics of the goods or services – specifically, in this case, the kind, quality and intended purpose.
- b) As the UK public links dimples with a specific undertaking (Bluebottle), this evidence (i.e. the survey) can be used to prove acquired distinctiveness. This may assist Bluebird in overcoming the second listed objection on the previous page ✓, but not the objection i.e. the shape giving rise to the technical result (i.e. amore effervescent drink ✓)

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MARKS AWARDED 3/5

Question 7

Generic, descriptive (devoid of distinctive character)

- 1) The mark is devoid of distinctive character – known as nomenclature ✓
- 2) The mark is the generic term ✓ for the goods/services (in this case, the ingredient(s) thereof) in respect of which it relates.
- 3) The mark consists of an indication which may serve, in trade, to designate the kind, quality, quantity, value, geographical origin, value, intended purpose, time taken to produce products or to render services or other characteristics of the goods or services – in this case the kind of good, and other characteristics. ✓

MARKS AWARDED 3/5

Question 8

- a) UK)

The UKTMA provides relative grounds for refusing an application which include the use of a sign which, at the date of filing (or priority) of the trade mark has an earlier date of protection ✓ – relating to copyright, design right and UK registered designs in particular. ✓
- b) EU) Relative ground

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MARKS AWARDED 2/5

Question 11

- a) – An application for a EU trade mark can claim priority from a convention application if the EU trade mark application has been filed within 6 months of the filing of said convention application. ✓
- Priority must be claimed when an EU trade mark application is filed (or within 2 months of filing) and a certified copy of the convention application must be filed within 3 months of the priority claim. ✓
- The effect of priority is that the EU trade mark will enjoy the earlier filing date of the convention application – this means that for assessing earlier rights, the date of protection in regards to the EU trade mark shall be taken as the priority date (i.e. the date on which the convention application was filed). ✓
- To claim priority, the applicant for the EUTM and the convention application must be the same, and the marks and goods or services must also be the same.
- An application for a EU trade mark can claim seniority from an earlier national right (TM), in a contracting party of the EU. ✓ There is no deadline relating to when seniority can be claimed in respect of the earlier national application. ✓
- Seniority may be claimed when the application for a EUTM is filed, or within 2 months of filing. Alternatively, seniority can be claimed after registration of the EUTM.
- Seniority can only be claimed in respect of a national trade mark which is for the same mark, with the same applicant. In addition the national right must include all of the goods and services which are present in the EUTM.
- The effect of seniority is that if the applicant allows the national right to lapse, ✓ he shall still be regarded as having the same rights as if the national right were maintained. ✓ Therefore, there is a cost saving and it is administratively simpler (no need to renew national right).
- b) – An International trade mark (TM) application must be based on a ‘basic application’.
- The International application must be filed at the same office at which the basic application was filed (the office of origin). ✓
- If the International application is filed within 6 months of the filing of the basic application – it may also claim priority to the basic application which means that it will enjoy the filing date of the basic application as its priority date.
- Basic application – essential ✓
- Priority application – not essential. ✓

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- Basic application – The Madrid Protocol application may be filed at any time after the basic application (or registration) ✓
- Priority application – The Madrid Protocol application filed within 6 months of Priority application filing to claim priority ✓

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MARKS AWARDED 12/12

Question 12

- a) – A Japanese trade mark is not a relative right in terms of rights which may affect registration of a UK trade mark.
- The first step is to check whether Midori's mark could be regarded as a well-known mark ✓ under the Paris Convention – if it can, then this is a relative right which may be used by Midori to oppose the application on this basis.
 - Midori may try to oppose Brown mark on another, absolute basis.
 - For example, Midori could claim that the mark is devoid of distinctive character, citing that those who are aware of sake in the UK associate it with their own trade mark.
 - Also check if Midori have any other, associated rights in the UK (design right, copyright).
 - Brown recently launched the milkshake which probably means that their mark has not yet acquired a distinctive character, so they would not have this defence against an objection on absolute grounds. However, they could attempt to prove, using the noted surveys, that not many people in the UK have heard of sake and therefore the mark cannot be considered as devoid of distinctive character.
 - (ignoring passing off) Midori should not be able to stop Brown from using the mark as they do not have any UK rights (presumably) in it.
 - Brown could seek to negotiate with Midori. They could seek Midori's consent to use the mark in the UK, or form a coexistence agreement or market sharing agreement, for the sake of avoiding conflict and bad business relations.
 - If Brown wanted to be overly cautious, they could narrow down the classification of goods, to steer the mark away from alcoholic beverages. ✓
 - Alternatively they could reconsider the mark, and consider designing a different mark

Conclusion: The chances of Midori bringing a successful opposition against Brown are low as:

- they have no UK/EU/International (UK) rights
- they do not export to the UK
- in the UK, evidence shows that very few people have heard of sake (and thus KI); and
- the goods are different (alcoholic beverages vs milkshake).

I would advise Brown to proceed with their application.

MARKS AWARDED 2/12

Question 13

Yellow's mark Caledonia is identical ✓ to Green's mark.

The goods and services in respect of the respective marks are not (or are not expected to be) similar. ✓

The UK TMA provides that a trade mark shall not be registered, where there exists an earlier identical mark which has a reputation in the UK, where the goods and services of the marks are not similar and where use of the trade mark without due cause $\frac{1}{2}$ would be detrimental $\frac{1}{2}$ to or take advantage of $\frac{1}{2}$ the repute $\frac{1}{2}$ or distinctive character $\frac{1}{2}$ of the earlier mark.

Earlier mark means a mark which has an earlier filing or priority date.

- Yellow's mark is an earlier mark.
- Yellow's mark has a longstanding reputation in the UK, and is famously known – surveys evidence this fact. ✓
- Based on the above ground of opposition – I would conclude that Yellow has a good chance of succeeding in opposition proceedings.

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Not enough analysis to justify a mark for a conclusion.

MARKS AWARDED 5.5/12

Question 14

- a) Passing off. Goodwill is associated with goods and services themselves, not with a trade mark. It is described as being the "attractive force" that brings in custom. As such, goodwill cannot be assigned or transferred. $\frac{1}{2}$

$\frac{1}{2}$

- b) i) Yes, because the mark may not be widely used or ‘famous’ enough to have a reputation re section 5(3) UK TMA; however it may have goodwill in the relevant sector – i.e. it is known to the relevant portion of the public and has goodwill therein. It is likely that such a mark would have to be used in relation to goods/services which are very close to the offending mark for a successful passing off action. ✓
- ii) Yes – a trade mark may be well known and have a reputation, but it may not necessarily be a good one. It may not be regarded as providing quality goods/services, for example, and goodwill is the ‘attractive force’ that brings in custom.
- iii) Yes, again, for the reasons above (ii). A “well known mark” does not necessarily mean that the mark has good standing with the public, or that the goods and services which are sold under it are regarded well – as is required for goodwill.
- c) Secondary meaning refers to
- d) Because goodwill rests in the products and services themselves. It is not always necessary to apply a mark if it can be proven/shown that goodwill is present and that the relevant public are able to associate this goodwill with the undertaking, irrespective of whether a mark has been applied. ✓
- e) Although Charlotte can show strong goodwill, it is unlikely that misrepresentation exists as the two products – a steam iron and fruit juice – are very different. It would be unlikely that the public would associate the two products as coming from the same commercial undertaking ✓. The marks are also slightly different, with the use of CAESAR for the steam iron being preceded with THE, again this detracts from the chances of proving misrepresentation. For the reasons above, it will be very unlikely that damages (or ✓ even potential damages) can be shown. Sales in fruit juice are not likely to be linked with sales in irons.
- f) Potential or likely damage ✓ is sufficient, or may be sufficient. For example, if Goodwill and Misrepresentation are present, it is typically reasonable to assume that damage would also occur.

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MARKS AWARDED 5.5/12

Question 15

The windsurfing Chiemsee case ruled that indications of geographical origin may be registered✓, if certain conditions are met.

- The mark (i.e. the geographical indication)✓ must be assessed in terms of public perception – has the public heard of the geographic location before? What do they associate with the location?
- Edinburgh is a capital city and therefore it is likely that many (or most) people will have heard of it. ✓
- In order to register a place name such as EDINBURGH, the application for such a mark must be accompanied by strong evidence of acquired distinctiveness. ✓ – In order to obtain protection for the mark, Kate must have strong evidence that, in the UK, people associate the mark Edinburgh with her wine.
- Again, as Edinburgh is a capital city, it is likely that Kate will have a hard time proving that a significant portion of the UK population associate the mark with her product. ✓
- The location of production does not have to be the same as the mark applied for. Therefore, the fact that the wine originates from New Zealand and is imported into the UK isn't an obstacle to protection.
- In addition – Edinburgh is not immediately associated with wine production for the reasons stated, so this will not hinder her either.

To conclude, it is unlikely that Kate will be able to obtain protection unless she can show strong evidence of acquired distinctiveness – that the UK public associate the mark with her wine. Edinburgh is not an obscure or remote location – it is a prominent capital city and it will therefore be much harder for her to prove acquired distinctiveness. ✓ **As a reasonable stab at a conclusion.**

Note – as Edinburgh is a capital city she will be more vulnerable to oppositions from the proprietors of registered/unregistered trademarks which use the 'Edinburgh' name – Edinburgh Gin to name one.

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MARKS AWARDED 6/12