

Introduction

The focus of the syllabus is on the basics of trade mark legislation and the focus of the exam is on testing that the candidates have a good grasp of the legislation. Of necessity, many of the questions require factual answers regarding the legislation but the paper contained two questions which gave scenarios of the type more likely to be encountered in practice.

Most candidates had clearly worked hard to learn much or all of the syllabus and deserved to pass. There was evidence of substantial revision and general good grasp of the subject. Not all candidates achieved high scores but only 50 % is required for a pass and almost all candidates achieved that.

Questions

Part A

Question number	Comments on questions
Question 1	The question was attempted by all candidates and most gained full marks. No candidate gained fewer than half marks. The easiest way to gain full marks for the question was by reciting (or paraphrasing) Article 4 CTMR. Six examples of signs which may be registrable are listed in Art.4 CTMR and most candidates used those but candidates who gave other types of marks (e.g. figurative, colour, logos, slogans) scored equally well.
Question 2	<p>This question was the first to be set on Article 10 CTMR since the P7 paper was introduced and was attempted by most candidates. Candidates could gain full marks by providing the terms of Article 10 CTMR but few scored more than three of the five available marks although only a handful obtained fewer than half marks.</p> <p>In (a) it was necessary to identify that the CTM proprietor can object if the reproduction suggests that the mark is generic in relation to the registered goods/services. In (b) marks were gained for explaining that at the request of the proprietor, the proprietor must ensure that the reproduction makes it clear that the mark is registered at the latest in the next edition. Many candidates missed one or more of these points and several lost time by dwelling on the topic of revocation. There would be a risk of revocation if the mark became generic but this question did not require candidates to elaborate on the subject.</p>
Question 3	<p>Again most candidates attempted the question. The average mark obtained by candidates was just above 3 but there was a wide range i.e. a quarter of candidates scored 4 or more and a handful scored fewer than half marks. Clearly those who had revised the topic thoroughly could score very well.</p> <p>In part (a), all candidates identified one or more of the types of corrections permitted in s.39(2) UKTMA although few correctly identified all three. In part (b) candidates were expected to know that corrections are only permissible if the identity of the mark is</p>

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	<p>not substantially affected (s.39(2)(proviso)) and that the correction must not extend the goods or services (s.39(3). Several candidates knew that the identity of the mark must not be affected but few that it must not be “substantially” affected. Very few candidates answered that the correction must not extend the goods or services. Several candidates referred to publication which was not part of the question.</p>
<p>Question 4</p>	<p>Nearly all candidates answered the question. The average mark was the worst in the paper (less than 3 marks out of a possible 5) and there was a wide range i.e. more than a quarter of candidates scored 4 or more marks and more than a quarter scored fewer than half marks.</p> <p>Part (a) was well answered and well over half the candidates gained the available 2 marks. Part (b) caused more problems and required a thorough knowledge of s.47 UKTMA. Four qualifications/limitations (candidates were required to provide only three) in the section are that invalidation will not succeed if (i) the mark being challenged has acquired distinctive character since registration; (ii) the owner of the earlier mark has given consent to registration; (iii) the earlier mark has not been used in the last five years unless it is less than five years old or use is proved; (iv) the grounds of invalidity exist in respect of only some of the goods or services in which case invalidation shall be limited to those goods or services.</p> <p>A few candidates mentioned acquiescence i.e. if a proprietor has acquiesced in the use of a later registered trade mark for a period of five years, he cannot then try to declare it invalid on relative grounds. A few also identified that an application for invalidity on relative grounds can only be made by the proprietor of the earlier trade mark or earlier right. Strictly, acquiescence (s.48 UKTMA) is not part of the syllabus and the requirement that the proprietor bring proceedings on relative grounds is not mentioned in s. 47 but both answers are correct and each earned a mark. Examples of incorrect answers are that there must be a likelihood of confusion or that an agent registered the mark. Both of the latter are aspects of s.3 UKTMA which contains grounds for invalidation but neither statement is sufficient in isolation.</p>
<p>Question 5</p>	<p>Almost all candidates answered this question and most did very well. The average score was almost 4 out of the available 5 marks and only two candidates scored fewer than half marks. The answers are all contained in Article 81 CTMR.</p> <p>In part (a), one of the aspects of restitutio in integrum for which 0.5 marks were available was that the failure must have occurred in spite of all due care being taken. Many candidates failed to mention “all due care” in their answer to part (a) but if they mentioned it in their answer to part (b), they were awarded the available half mark.</p> <p>In part (b), one of the conditions is that the application for restitutio must be filed in writing and although most candidates failed to use</p>

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	<p>the words “in writing”, they were given credit if they mentioned “filed” or “requested”. The latter was probably over generous because the provisions relating to restitution require meticulous attention to detail and candidates should aim for greater precision.</p>
<p>Question 6</p>	<p>One of the less popular questions but it was well answered by most candidates. Only four candidates scored fewer than half marks and the average mark was comfortably over 3. The question requires knowledge of Article 112 CTMR.</p> <p>Article 112(1) provides that the owner of a CTM may request conversion to the extent that his CTM has been refused, withdrawn, deemed to be withdrawn or ceases to have effect. These were the four reasons that the examiners were looking for as the answer to part (a) but candidates were given credit for any of the specific circumstances in which a registration “ceases to have effect” such as invalidation, revocation or non-renewal. Few candidates knew more than one of the reasons why conversion may not take place which was the subject of part (b) of the question. The first (and better known) is where the mark has been revoked by the CTMO on grounds of non-use EXCEPT in EU territories where the non-use criteria applied by the relevant National Office are more lenient and evidence of use presented by the proprietor would have been accepted. To gain the full 1.5 marks, candidates were expected to include the exception in their answer.</p> <p>The second reason is where the National Office or court in the EU territory in which conversion is sought would uphold the grounds for revocation or invalidity. The latter was unknown to the majority of candidates although the candidate who gave the best answer provided a good analogy in the following terms: if "Alpen" is refused for being devoid of distinctive character, the reason for refusal will be maintained in Austria where they speak German and Alpen means "alps". NB Alpen does not lack distinctiveness in relation to muesli but it could in relation to e.g. mountain equipment.</p> <p>The third reason identified by a few candidates was that the conversion may not take place if the applicant applies later than three months from the date of loss of rights.</p>
<p>Question 7</p>	<p>The least popular question in Part A of the paper, attempted by a little over half the candidates. Among those, most gave good answers and the average mark was above 3. Five candidates obtained fewer than half marks.</p> <p>Article 6bis of the Paris Convention is very short and candidates were expected to know it in full to obtain all the available marks. No candidates obtained full marks on part (a) although a few identified almost all the relevant points. In general candidates did well on part (b) of the question, correctly identifying the two time limits described in Article 6bis.</p>

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	<p>There appeared to be confusion among some candidates about the meaning of “well known” and the best answers avoided synonyms for the term. The French word "notoire" is used in the French (original) version of the Convention and "notoire" is translated as "well-known" or “famous” in English. “Notorious” is not a synonym for “well known”, nor is “of repute”.</p>
<p>Question 8</p>	<p>A popular question, answered by almost all candidates. Most did very well and the average mark was almost 4. Only two candidates scored fewer than half marks.</p> <p>The first part of the question required a general explanation of the meaning of the term “central attack” plus a specific explanation as to how it works. All candidates understood the principles but some failed fully to identify the specifics. In particular, there were woolly explanations or omissions in relation to the basic application/registration. It was necessary to spell out that there must be a basic application/registration and that if it is successfully attacked, then the international registration can no longer be invoked.</p> <p>Almost all candidates correctly identified (for part (b) of the question) that the proprietor can transform his international registration into national registrations in the event of a successful central attack.</p>
<p>Question 9</p>	<p>All but one of the candidates attempted this question. There were four perfect answers and the average mark was above 3. Only a handful of candidates scored fewer than half marks.</p> <p>Part (a) was well answered by most. A few candidates used the term “citizen” which is not an acceptable synonym for “national” or “domiciled in” in this context. A number struggled with the phrase “real and effective industrial or commercial establishment” and “real industry”, “real factory”, “actual commerce”, “establishment” were not accepted. Slight compressions such as “real industrial establishment”, “effective commercial establishment” were accepted.</p> <p>Part (b) was more problematic. As with Question 8, it was evident that candidates were familiar with the term “basic registration” but some had difficulty in fully expressing its meaning i.e. in order to own an International mark, the applicant must first file a basic application/registration on which the International is based; it must be filed at his Office of Origin; which is the territory where he is a national, is domiciled or has a real and effective industrial or commercial establishment.</p>

Part B

Question number	Comments on question
<p>Question 10</p>	<p>One of the least popular questions in Part B of the paper. The average mark was almost 8 and six candidates scored fewer than half marks.</p> <p>Part (a) was the harder part of the question with candidates expected to remember six of the nine main findings in the <i>Sabel v Puma</i> decision. Most did well and some very well. The most popular were (i) the appreciation of the likelihood of confusion depends on numerous elements and, in particular, on the recognition on the market, association with the used or registered sign, the degree of similarity between the marks and between the goods or services. <i>para 22</i>; (ii) the likelihood of confusion must be appreciated globally, taking into account all relevant factors <i>para 22</i>; (iii) the global appreciation of the visual, aural or conceptual similarity must be based on the overall impression bearing in mind the marks' distinctive and dominant components <i>para 23</i>; (iv) the average consumer normally perceives a mark as a whole and does not analyse its various details <i>para 23</i>; (v) the more distinctive the earlier mark, the greater will be the likelihood of confusion <i>para 24</i>; (vi) likelihood of confusion which includes likelihood of association is to be interpreted as meaning that mere association is not in itself a sufficient ground for concluding that there is a likelihood of confusion <i>para 26</i>.</p> <p>Part (b) provided much greater choice because there are a greater number of findings in the <i>Canon v MGM</i> decision of which candidates were expected to choose only two. Consequently most candidates did very well. A few findings from <i>Sabel v Puma</i> are quoted in <i>Canon v MGM</i> and were accepted as answers for (a) or (b). The most popular selections were: (i) global assessment implies some interdependence between the relevant factors, and in particular a similarity between the trade marks and between goods or services <i>para 17</i>; (ii) a lesser degree of similarity between goods or services may be offset by a greater degree of similarity between the marks, and vice versa <i>para 17</i>; (iii) 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 <i>para 18</i>; (iv) in assessing similarity of goods or services all relevant factors must be taken into account, inter alia, their nature, their end users and their method of use and whether they are in competition with each other or are complementary <i>para 23</i>; (v) the 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 is sufficient to give rise to the likelihood of confusion <i>para 24</i>; (vi) the risk that the public might believe that the goods or services in question come from the same undertaking or from economically-linked undertakings, constitutes a likelihood of confusion <i>para 29</i>; (vii) there may be a likelihood of confusion even</p>

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	<p>where the public perception is that the goods or services have different places of production <i>para 30</i>.</p>
<p>Question 11</p>	<p>A reasonably popular question. The average score was almost 8 and only one candidate obtained fewer than half marks.</p> <p>Parts (a) and (b) were straightforward, requiring candidates to identify renewal dates and grace periods for UK, CTM and International registrations. Most candidates were well prepared for the questions on UK and CTM but knowledge of the Madrid Protocol provisions was less good and very few candidates correctly identified that a Madrid Protocol renewal can be paid up to three (not six) months before renewal.</p> <p>Part (c) tested knowledge of options available after the six month grace period has expired. Knowledge of CTM provisions was good in relation to restitutio in integrum but a number of candidates incorrectly suggested that conversion to national registrations is an option after expiry of the grace period. Knowledge of UK restoration was good only in outline but few candidates identified potential difficulties i.e. UKIPO is not required to restore; 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”; 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.</p> <p>A number of candidates correctly suggested refiling as an option but few explained that a new application may be refused or opposed if another party has registered a similar mark prior to the refiling and that it is advisable to conduct searches in all territories where protection is required.</p>
<p>Question 12</p>	<p>The least popular question in Part B of the paper but the average mark was more than 8 and only two candidates scored fewer than half marks.</p> <p>The first part of the question tested knowledge of Article 96 CTMR and most candidates knew at least two of the four types of legal proceedings over which the EU Community trade mark courts have exclusive jurisdiction.</p> <p>The second part of the question required knowledge of the “cascade” principle (Article 97 CTMR) governing where parties can litigate CTM’s. Again, knowledge was good and most candidates knew at least the first five criteria of the cascade.</p>
<p>Question 13</p>	<p>All but one candidate answered this question and most did very well. The average score was over 9 marks and only one candidate gained fewer than half marks.</p> <p>The countries involved in the question were UK, Denmark, Sweden, and Norway and to gain good marks in part (a) of the question it was necessary to identify whether they are members of</p>

	<p>the EU or the Madrid Protocol. Most candidates appeared to know that all are members of the Protocol but it was disappointing that several candidates were uncertain about membership of the EU (all of the above are members except Norway). Separate national registrations; CTM plus national registration for Norway; and UK basic registration plus Madrid Protocol designating CTM plus Norway or the other three territories were all identified as options for protection but few candidates suggested CTM basic plus Madrid Protocol.</p> <p>In part (b), not all candidates were aware that when new members join the Madrid Protocol, it is necessary to obtain a new registration or a subsequent designation to cover them. However, almost all candidates knew that the CTM expands automatically to cover new members of the EU.</p> <p>Parts (c) and (d) were well answered showing good knowledge about representation and advantages or disadvantages to the various systems of registration. One candidate listed twenty-five advantages or disadvantages which was impressive but must have been time consuming and only four marks were available.</p>
Question 14	<p>The question dealt with passing off which seems to be a popular topic. Almost all candidates attempted the question and none gained fewer than half marks. The average mark was more than 9.</p> <p>Almost all candidates knew that in the problem scenario provided, the client's only option for legal action was passing off (part (a)) and the three ingredients of a successful passing off action (first part of part (b)).</p> <p>The second section of part (b) was more challenging requiring candidates to apply the facts in the question which would enable them to conclude whether legal action was likely to be successful. Candidates showed less certainty here – understandable if they have had no practical experience – but nonetheless there were some very good answers.</p> <p>Part (c) was well answered. Most candidates knew that the client could oppose the other party's trade mark application on grounds of his passing off right and the deadlines for doing so.</p> <p>Part (d) was a mixed bag. There were good suggestions, such as that the client should file his own trade mark application, mark his packaging TM, set up a watching service. However, there were a few impractical suggestions, such as that the client should do more advertising, put up a sign to warn customers, conduct a survey.</p> <p>Question 15: A relatively unpopular question with the lowest average mark in Part B of the paper (just over 7 marks) and a third of the candidates who attempted this question gained fewer than half marks. This is the first time that opposition procedure has been tested since P7 was introduced.</p>

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	<p>There are dozens of steps in the procedure and mention of any step attracted a half mark. Candidates accumulated good marks for their accounts of the start of the procedure up to the provisions relating to the cooling off period but most answers then tailed off. In particular, few candidates were able properly to explain the procedures in the evidence rounds.</p>
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