

# Foundation Certificate

## FC5 Trade Mark Law

**Wednesday 20 October 2021**

**10.00 to 13.20 UK British Summer Time (GMT + 1 hour)**

**Examination time: 3 hours 20 minutes plus 10 minutes upload time**

The 3 hours 20 minutes is allocated as follows:

**10 minutes** – Downloading and printing the question paper;

**3 hours** – Answering the questions;

**10 minutes** – Two screen breaks of 5 minutes each.

**At 13.20 you MUST immediately stop answering the questions.** You then have **10 minutes** in which to upload your Answer document to the PEBX system.

**You MUST upload your Answer document to the PEBX system by 13.30. After 13.30 you will not be able to upload it and your examination will be void.**

### INSTRUCTIONS TO CANDIDATES

1. You should attempt **ALL** questions in Section A and any **three** questions in Section B.
2. The marks for each question in Section A are shown next to the question. Each question in Section B carries **20** marks.
3. If more than the required three questions are answered in Section B, only the first three presented will be marked.
4. The total number of marks available for this paper is 100.
5. You must use the Answer document for your answers.
6. Do not attempt to change the font style, font size, font colour, line spacing or any other preset formatting in the Answer document.
7. Start each question on a new page. To begin a new page, press the control key and the enter key simultaneously.
8. When you begin a new question, type in the question number at the top of the page.
9. Do not state your name anywhere in your answers.

This question paper consists of **9 sheets** in total, including this sheet.

### AT THE END OF THE EXAMINATION

10. Upload your Answer document to the PEBX system. You should upload it as a Word document. PEBX will automatically convert it to PDF.

## SECTION A

### Question 1

Describe the protection afforded to 'Well Known Marks' by the Paris Convention.

**5 marks**

### Question 2

Define the following terms used in the Madrid Protocol:

a) Contracting Party;

**1 mark**

b) Office of Origin;

**1 mark**

c) Replacement.

**1 mark**

**Total: 3 marks**

### Question 3

A Madrid Protocol trade mark application designates the United States and France. Explain the differences between:

- a)
- i) the substantive examination; and
  - ii) the publication period

of the application by the USPTO and INPI (US and French IPOs).

**2 marks**

- b) actions necessary to keep the trade mark designations in force (assuming the marks are being used).

**2 marks**

**Total: 4 marks**

### Question 4

The EUIPO determines that an EUTM application consists of an English word that is descriptive of the goods' key characteristic, and so must be refused.

Assuming that the objection is valid, briefly outline the options available to protect the mark within EU states whilst retaining the filing date.

**4 marks**

### Question 5

Explain why goodwill cannot ordinarily be assigned, except alongside other business assets relating to the manufacture of the product (or supply of the service) concerned.

**2 marks**

### Question 6

Melton Mowbray is a town in Leicestershire. Incontrovertible evidence demonstrates that it is well known in the United Kingdom as a geographic centre for the production of pork pies. However, the name is not recognised at all by consumers outside the UK.

Three European Union trade marks/applications using the name have been filed by different applicants.

Number	Mark	Goods	Filing Date	Registration Date
'111	MELTON MOWBRAY	Pork pies	1 August 2020	30 November 2020
'222	MELTON MOWBRAY	Pork pies	1 December 2020	3 June 2021
'333	MELTON MOWBRAY	Pork pies	1 February 2021	–

Noting that the 'Brexit' transition period ended on 31 December 2020, explain to your client, a pie maker, whether it can successfully bring invalidity proceedings against these marks on absolute grounds (namely that the mark is characteristic of geographical origin).

**3 marks**

### Question 7

Give an example of a 'proper reason' by which, under Section 6A TMA, an applicant for opposition might avoid having to demonstrate the use of an earlier right.

**1 mark**

### Question 8

List the changes that can be made to a trade mark application prior to its registration.

**4 marks**

### Question 9

From what date are damages for trade mark infringement calculated?

**1 mark**

### Question 10

a) In Section 25(2)(d) TMA (*Registration of transactions affecting registered trade marks*), explain what is meant by the '*making by personal representatives of an assent in relation to a registered trade mark*'.

**1 mark**

b) Explain the deadline (if any) for recording such an assent at the IPO, and the effect of late recordal.

**3 marks**

**Total: 4 marks**

### Question 11

X owns an EUTM for 'cutlery', and sells cutlery, bearing that trade mark, in France. Y owns a UK trade mark that is identical to that owned by X, and which also protects 'cutlery'.

In June 2020, Z buys X's cutlery in France, and in June 2021 imports it into the UK for further resale.

**Applying the law of exhaustion in the UK, in relation to goods already put into circulation within the EU by a rights owner, explain whether Y can bring an infringement action against Z.**

**2 marks**

### Question 12

a) With regard to UK trade mark procedure, explain the difference between an opposition action and an invalidity action.

**1 mark**

b) Give two advantages in bringing an opposition action, rather than an invalidity action.

**2 marks**

c) Give one advantage of bringing an invalidity action, rather than an opposition action.

**1 mark**

**Total: 4 marks**

### **Question 13**

You represent Middlesex Constabulary, a police force. You recently registered Middlesex Constabulary's logo as a trade mark for:

Class 12 – Vehicles, namely cars and vans;

Class 28 – Toys and models;

Class 45 – Security services.

MiniRace Ltd manufactures and sells radio-controlled model cars. It has recently advertised a model of a Middlesex Constabulary police car, complete with external markings including Middlesex Constabulary's logo.

Explain whether Middlesex Constabulary can invoke its trade mark rights against MiniRace.

**3 marks**

**SECTION A Total: 40 marks**

## SECTION B

### Question 14

Last year, Michelstone Tyres launched a new tyre, the BLING-RING. The tread of the tyre comprises an array of dollar-sign-shaped grooves. A representation of the front view of the tyre is shown below:



The sales director writes:

The BLING-RING has been a huge success, driven by our product placement strategy of paying rappers to fit BLING-RINGS to the luxury cars used in their music videos. Virtually everyone under 30 recognises BLING-RINGS by sight, and it is by far the best-selling tyre in that market segment.

However, the director of engineering wrote a resignation letter, leaked to the newspapers, which stated:

I am disgusted that we are continuing to market BLING-RINGS. Whilst the dollar array pattern provides the minimum of grip to meet UK legislative standards, it is massively inferior to any other tread pattern on the market. Given the target market of young inexperienced drivers, marketing a tyre purely for aesthetics when an almost infinite number of alternative safer patterns could have been chosen, will undoubtedly result in many unnecessary deaths.

Nevertheless, the sales director has instructed you to file a trade mark to protect the tread pattern of BLING-RING tyres.


A search of technical literature shows that an array of S-shaped studs is commonly used on tyres used by construction and military vehicles. But otherwise, no other tread pattern on the market looks remotely similar.

**Advise whether Michelstone Tyres can register the BLING-RING tread pattern as a UK trade mark.** In doing so, address any issues raised by the former director of engineering. [Do not discuss 'relative' grounds.]


**Total: 20 marks**

**Question 15**

Your client is the owner of the following United Kingdom trade mark. The trade mark has been used since registration, but only in France, Italy and Spain.

UK Mark 9000123456	Description	Goods	Relevant Dates
	<p>Three-dimensional mark. The mark is a bottle comprising a spherical body with an off-centre cylindrical spout. The word 'Lemonade' is printed on the exterior surface. All elements are in blue (Pantone 297C).</p>	<p>Class 32 – Sodas [soft drinks]</p>	<p>Application: 1 February 2010</p> <p>Seniority: 1 February 2001</p> <p>Publication: 1 March 2010</p> <p>Registration: 1 July 2010</p>

The following United Kingdom trade mark has recently been advertised for opposition purposes.

UK Mark 654321	Description	Goods	Relevant Dates
	<p>Three-dimensional mark. The mark is a bottle comprising a spherical body with a cylindrical-necked aperture at the top. The words 'LE MONDE' are moulded into the exterior surface. No claim is made to colour.</p>	<p>Class 33 – Alcoholic spirits, namely cognacs.</p>	<p>Application: 1 February 2021</p> <p>Publication: 1 September 2021</p>

You are told that 'le monde' means 'the world' in French, but has no English meaning.

**Advise whether your client can successfully oppose the advertised mark.**

[Do not discuss absolute grounds, passing off, or marks with a reputation.]

**20 marks**

### Question 16

Your client, Delilah, is a well-known television cook. For five decades she has hosted cookery programmes on national television, each series being accompanied by a recipe book – inevitably a bestseller. She also ‘endorses’ pans and knives made by kitchenware manufacturers.

In 2006, Delilah presented a TV cookery show called PORTRAITS OF DELICIOUSNESS. This coincided with the launch of ‘High Definition’ television broadcasting and seeing Delilah’s food at that resolution was a huge hit with viewers. The accompanying recipe book of the same name, featuring lavish photographs of Delilah’s food, was an enormous success.

A national supermarket chain, Samson plc, has recently started selling a range of cakes under the name PORTRAITS OF DELICIOUSNESS. All of these cakes are made to recipes in Delilah’s book of that name, and inevitably look near-identical to the cakes shown on the TV programme and in the book. Delilah is unhappy: she believes she is entitled to a cut of Samson’s profits. However, she has been told that there is no copyright or other IP right in a recipe, and the design rights (if there ever were any) in the shape of the cakes have expired.

**Advise whether passing off might provide a remedy.** Address both the use of the name, and more generally the ‘unauthorised’ use of Delilah’s recipes and cake designs.

**20 marks**



## Question 17

Your client, Kindred Inc of New Jersey, USA, sells a product (the 'PRIZE EGG') comprising a plastic toy packaged within an orange plastic capsule, in turn packaged within a chocolate egg. It sells the PRIZE EGG in the Nordic states, the British Isles, Germany, Switzerland and Benelux. The eggs are manufactured in Kindred's European factory in Belfast (UK) and distributed from its warehouse in Dublin (Republic of Ireland).

Kindred wishes to register a trade mark for PRIZE EGG in all the above markets. But it has qualms about whether the mark is sufficiently distinctive in English. Worse: a trade mark search has revealed that a competitor already has an EUTM quite similar to 'PRIZE EGG', for an almost-identical product.

Kindred also explains that eggs are illegal in the United States due to tough rules against choking hazards in foods.

Kindred is considering filing a Madrid Protocol application designating its jurisdictions of interest.

- a) **List (with reasons) the jurisdictions in which a trade mark application, suitable to serve as a basic application, can be filed, and explain any advantages and disadvantages of using each jurisdiction.** [Do not discuss whether you personally think the brand is distinctive.]

**12 marks**

- b) **Set out three disadvantages of filing for protection directly at the local IPOs of the jurisdictions of interest, rather than using the Madrid Protocol.**

**3 marks**

Kindred Inc decides to use the Madrid Protocol to protect the PRIZE EGG name in its markets of interest. It designates the EUIPO, Norway and Switzerland, with a UK trade mark serving as a basic registration.

Three years later, after the mark and its designations are registered, Kindred Inc's tax lawyer establishes a subsidiary company in the British Virgin Islands, Kindred (BVI) Ltd. The tax lawyer recommends that:

- i) trade mark protection effective in the UK, Germany and Switzerland remain in the name of Kindred Inc; and
- ii) all of Kindred Inc's other IP and physical assets be transferred to Kindred (BVI) Ltd.

You note that the British Virgin Islands is not a member of the Madrid Protocol.

- c) **Explain how the tax lawyer's scheme can best be achieved, and any disadvantages that arise from doing so.**

**5 marks**

**Total: 20 marks**