

Paper Ref	Sheet	Percentage Mark Awarded
FC5	1 of 23	55%

Examiner's use only

Q1

Well Known Marks.

It is not possible to register a trademark, if it is identical or similar to a well known mark, where there is a risk of confusion to the public. ✓¹ ✓^{1/2} ✓¹

A well known mark must have more than local significance.

2½

MARKS AWARDED: 2.5/5

2½

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Q2

a) Contracting Party is a national state or multinational organisation that has acceded to the Madrid Treaty. ✓¹

1

b) Office of Origin is the national office where the original mark was registered by the applicant. ✓^{1/2}

1/2

c) replacement is where an existing national mark is replaced by the Madrid registration, ✓¹ WIPO will record the date of earlier registration against the Madrid mark for that territory.

1

MARKS AWARDED: 2.5/3

2½

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Q3

Both IPOS will examine the application on absolute grounds within two months. ✓ $\frac{1}{2}$

Afyer publication, in france there is a 3 month period in which oppositions can be ✓ $\frac{1}{2}$
filed. In the US, there is up to 180 days in which an opposition can be filed, after ✓ $\frac{1}{2}$
which the national registration will be confirmed with WIPO.

1½

b)

In the US, a statement of continued use must be filed every five years. This is not ✓ $\frac{1}{2}$
required in France.

Renewal fees are due every ten years to keep the mark in force in France, and
every five years in US.

½

MARKS AWARDED: 2/4

2

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Q4

Show that the mark has acquired distinctiveness for the goods and services, e.g by long history of use showing the public associate the mark with its origin.

Narrow the list of goods and services to remove the example that it is descriptive of.

Remove the designation of any English speaking states or convert the EU application to national applications in each state where English is not an official language. ^{✓½} RoI and ^{✓½} Malta are English speaking states within EU where the objection would remain.

1

1

MARKS AWARDED: 1/4

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Q5

Goodwill is an abstract quantity that is in the minds of the customers, associated with goods or services supplied by a particular entity that they have done trade with. ✓1

Unless the assets themselves are transferred, the goodwill would have no independent meaning as it depends on the source of the goods or services. ✓1

2

MARKS AWARDED: 2/2

2

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Q6

'111 mark – There are grounds for opposition, as at the time it was filed the UK was a member state of the EU, and if the geographical origin was recognised in the UK as being of more than local significance, that would be grounds for invalidity in the EU. ✓1

1

'222 mark –By the time this application was registered the UK was no longer a member state. However the UK was still a member state at the date of filing, so there are grounds. ✓1

1

'333 mark . When the application was filed the UK had already left the EU. The EU IPO will not recognise the geographical origin as it is not recognised outside the UK. ✓1

1

3

MARKS AWARDED: 3/3

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Q7

A proper reason for non use of the mark might be – significant events have prevented temporarily the sale of the product. Or there has been no demand in the last five years from consumers for a reason.

$\frac{1}{2}$

MARKS AWARDED: 0.5/1

$\frac{1}{2}$

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Q8

Altering the list of goods and services Allow ✓½

Corrections of errors – Providing that they don't change the distinctive character of the mark. ✓½

Adding or removing a class.

Changing the details of the proprietor. Allow ✓½

2

2

MARKS AWARDED: 2/4

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Q9 Damages are calculated from the date of publication of the registration, or from the start of the infringing act, whichever is later. ✓½

½

MARKS AWARDED: 0.5/1

½

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Q10

a)

The assent gives confirmation that the mark is being held by an agent on trust for the ultimate owner of the mark.

0

b)

The recordal must be completed in six months of the assent being made. ✓^{1/2}

Late recordal would mean:

The assent may be invalidated by the recording of any later, recorded assent. ✓^{1/2}

No damage could be claimed for infringement of the mark by the assentee while it is not recorded.

1

1

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Q11

An owners right to bring infringement action is exhausted in the UK by any sale under the mark within the UK or EEA with the owner's consent.

Prior to Brexit, this would have simply said EEA.

X and Y must have had a coexistence agreement in June 2020 each consenting to allow the other to sell under the mark in the EU.

Therefore the sale of X's cutlery to Z was with the consent of Y under the coexistence agreement, therefore Y's rights are exhausted.

0

MARKS AWARDED: 0/2

0

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Q12

a) Opposition action must be started within two months of publication (3 with notice of intention), while invalidity can be started after registration. ✓1

1

b) Opposition is cheaper and quicker than invalidity actions and will be dealt with by an IPO officer rather than requiring complex proceedings. ✓½

If opposition is successful, the mark will never have been registered and the applicant will not acquire any rights. ✓½

1

c) Invalidity action can be brought on the grounds of non use after five years, which is not available in opposition.

0

2

MARKS AWARDED: 2/4

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Q13

Although Middlesex Const. have class 28 Toys and Models, this only protects the use of the mark as a designation of origin. ✓1

Minirace are using the mark simply as part of a faithful reproduction of the police car. The mark will not be understood to be a designation of origin, so there is no risk of confusion by the public. ✓1

See "Opel". ✓1

3

MARKS AWARDED: 3/3

3

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Q15

The mark has been published for opposition and opposition would need to be filed within two months of publication by 1 November 2021.

The client is entitled to oppose as the holder of an earlier mark.

Neither the marks and their goods are not identical so opposition will need to show similarity of the marks and goods and that there is a risk of confusion.

Similarity of the marks.

Visual similarity

Both marks are spherical bottles, which are identical shapes. The position of the cylindrical spout is different, but the difference is small, as either bottle can be rotated to position the spout in the position of the other. The shapes are highly similar. ✓1

Both bottles have text, the text is the same size but there are differences in font, also one is printed the other is embossed. The words only differ by one letter. ✓1

The fact that one is in capitals and the other in lower case does not distinguish significantly. ✓1

Colour – Although the clients mark specifies a colour, the mark for opposition does not disclaim that colour, and so this does not distinguish significantly. ✓1

Overall the marks are highly similar visually.

Aural similarity.

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Lemonade and Le Monde, despite their similarities in spelling, are pronounced quite differently. Lemonade has three syllables while Le Monde only has two.

The “ade” sound at the end of lemonade is quite different. ✓1

The marks have very slight aural similarity.

Conceptual similarity.

As the marks are three dimensional marks, part of the concept is an unusual container for beverages. Both marks provide this concept.

The meanings of the words however are quite different, one being descriptive of the intended contents, while the other is a meaningless word in English, though many people will recognise the French meaning. ✓1

The overall concept of the lemonade bottle taking into account the jokey font, off centre spout, is a fun way to drink lemonade, while the Le Monde bottle aims to portray a more serious celebratory function.

The marks have minor conceptual similarity.

The high degree of visual similarity is likely to override the lower aural or conceptual similarity.

Similarity of the goods and services

Both marks designate beverages. Although soft drinks and alcoholic spirits are different, both are drinks that might be bought at a bar or restaurant, so there is moderate similarity. ✓1

SOM – 6

SOG – 5

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Likelihood of confusion

Relevant consumer may overlap. Although spirit sales are limited to adults, purchasers of spirits are often the same consumer for mixers such as lemonade. Although cognacs are rarely mixed, the consumer of cognac may also be purchasing e.g vodka and lemonade in a round of drinks or stocking for a party. Where the purchasers of lemonade are minors, they will not be also purchasing cognacs, but in many venues such as bars the minor will not be the purchaser.

Venue for sales

Both soft drinks and spirits are sold at bars, restaurants, off licenses and supermarkets (often in the same aisle). In a bar or restaurant, such a decorative bottle is likely to be displayed where consumers can see and recognise it, such as on a shelf behind the bar. In these circumstances the consumer may often indicate the required product by pointing, they do not have the opportunity to inspect the bottle closely before purchasing, and are unlikely to be paying high attention. There is therefore a risk of confusion. In a supermarket too, the bottles are likely to be displayed close together in the drinks aisle, where lemonade and other mixers are displayed close to the spirits. Given the low degree of attention paid, the consumer may well judge the product on shape alone.

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Competition

Cognac and lemonade are not in direct competition. However as mentioned above the purchaser of lemonade as a mixer drink for spirits may be tempted to purchase the cognac as an alternative if they associate it with our client. ✓SOG 1

Association with the origin

Consumers who associate the lemonade bottle with goodwill may assume the cognac bottle is of the same origin.

AC – 0
LOC – 1

Conclusion.

There is a high degree of visual similarity, and some degree of similarity of goods and services. For some consumers in common purchasing venues, there is a risk of confusion as to the origin of the products, so opposition can be successful.

CONC – 1

✓CONC 1

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Q16

For passing off action to be successful, there needs to be shown:

Delilah must have good will

Samson are attempting to pass off their cakes as coming from Delilah

Delilah is suffering harm as a result.

Delilah has accumulated good will in trade, both through selling cookery books, endorsements of kitchenware, and making television shows. ✓1 – G

The goodwill is associated with Delilah personally, as well as with the specific mark "PORTRAITS..." used for books and television broadcasts. ✓1 – M

The "PORTRAITS.." TV series and book launch was some time ago, and Delilah's goodwill in that specific mark might have been abandoned if she is no longer using it. ✓1 – G

However even if it has, the mark and the cakes and recipes associated with it are still associated with Delilah personally as she continues to be a well known cook with best selling books. ✓½ – M

Samson are clearly copying the mark and the recipes, and are taking advantage of the goodwill accumulated by Delilah. ✓½ – D

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Consumers will associate the shape of the cakes, the use of the mark, with the successful TV series and will therefore be confused into thinking that Delilah has authorised the use of the mark and endorsed the products. ✓1 – M

Delila is damaged by this use, as her reputation will be tarnished if the cakes are not to the same quality consumers associate with her. ✓1 – D

She may lose endorsement opportunities if kitchenware manufacturers lose faith in her brand. ✓ – D

She can ask for an account of profits that Samson have made by taking advantage of her goodwill. ✓ – R

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Q17

a)

The basic mark must be filed in a jurisdiction where the applicant has a domicile ^{✓½} or place of business, i.e USA, Rol, UK, EU(due to Rol). If the mark is invalidate ^{✓½} in the country where the basic mark is filed, within the first five years of registration, the WIPO registration would also be lost. ^{✓½ ✓½ ✓½ ✓½ ✓½}

3

USA-

Kindred have a base in the US.

They do not make or sell the eggs in the US, so the mark could be invalid for lack of use. ^{✓½} To use US as a basic mark they would need to file a statement of intent to use, and use the mark in the US to keep it valid. ^{✓½} Export would count as a use if they switched manufacturing to US, but this would be costly as there is no market there. Lack of distinctiveness in English could also be a ground for invalidity. ^{Allow ✓½ ✓½}

2

Rol

Kindred have a manufacturing facility the Rol and export from there, so they do have use. ^{✓½} English is the language in Rol so lack of distinctiveness could be an objection. ^{✓½} As eggs are sold in Rol (British Isles), they may be able to show acquired distinctiveness to overcome the absolute objection. The competitors similar EUTM could be a grounds for opposition in Rol as Rol is in the EU.

1

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EU

Kindred can file an EU application as a basic application, but this would face all the disadvantages of a Rol application, as English is still an official language of some member states. ^{✓½} The advantage of an EU application would be immediate coverage of all the EU states where Kindred have the majority of sales. ✓½

1

UK-

A direct UK application as a basic mark would have an advantage over the Rol or EU application as the competitor EUTM could not be used to invalidate or oppose the mark since UK left the EU. ✓½

It would also be cheaper than an EU mark initially. Allow ✓½

1

Other countries –

If Kindred do have an effective presence in one of the other EU countries, that could make a good place to file the basic mark, if English is not an official language of that country. CH for example has French and German as official languages, so there would be less risk of lack of distinctiveness objection, and CH is also not in the EU so would not be at risk from the competitor trademark.

SUBTOTAL
– 8

b) Disadvantages of filing at local IPOs:

Need to appoint a local representative in most of the states to file there. ✓1

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Need to comply with multiple requirements for first filings in different formats. ✓½

Complex administration keeping up with renewals in multiple countries. ✓1

2½

c) Tax Lawyer scheme

A Madrid registration cannot be transferred to a person who is not resident in a member state of the Treaty. Therefore the Madrid registration cannot be transferred to Kindred BVI (KBVI).

i) The UK TM needs no change as it is already filed in UK under Kindred Inc. ✓1

The German TM rights arise from a Madrid EUTM designation, the rest of the rights in the EUTM are to be transferred to KBVI so the EUTM needs to be converted from the Madrid version to a direct EUTM in order to permit assignments. ✓1

The Swiss TM is still valid under Madrid and in the right name, but as it is the only remaining country under the Madrid system the advantages of simpler renewals and administration are lost. ✓1

ii) The remaining EUIPO and Norway designations under WIPO need to be converted to direct registrations.

The EUIPO allows different owners in different designated states, and does not bar BVI registered companies from ownership.

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Therefore assignment of the rights in the remaining EU countries of interest apart from DE can be made to KBVI by a signed assignment form Kindred Inc, and payment of the necessary fees at EUIPO, once conversion has taken place.

This will necessarily complicate renewal payments in the future.

13½

MARKS AWARDED: 13.5/20

3

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