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Examiner's use only

SECTION A

Question 1

Governed by Article 6bis of the Paris Convention. It provides protection to marks which are considered to be “well-known” by a competent authority (e.g., the national office) ^{✓½} within a Convention Country (i.e., a party to the Paris Convention) by allowing the proprietor of a well-known mark to prohibit registration and/or use ^{✓½} of their well-known mark in a Convention Country ^{✓½} in which their mark is not [yet] registered.

It provides the proprietor of a well-known mark with a period of up to 5 years after the commencement or use or an application for registration for the mark in which to request refusal or prohibition of the use of their mark in a Convention country. However, no such time limit applies in the case of marks registered in bad faith (that is, marks registered in bad faith contrary to Article 6bis may be invalidated/refused/prohibited at any time).

2

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Question 2

a)

A state which is a member of the Madrid Protocol and to which the Madrid Protocol applies. ✓1

1

b)

The national intellectual property office (i.e., the office responsible for trade marks) at which the base mark used for a Madrid Protocol application has been applied for and/or registered ✓½ and through which an application for a MP application is to be made. ✓½

1

c)

The process by which an applicant may allow a Madrid Protocol registration which designates a given Contracting Party to replace a national registration in that Contracting Party. It allows the owner of the MP registration to make savings on renewal fees and the like. ✓1

1

3

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Question 3

a)(i)

France

In France, applications are substantively examined on absolute grounds only.

United States

In the United States, applications are substantively examined on both relative and absolute grounds. ✓1

a)(ii)

France

In France, the opposition period lasts for 2 months from the date of publication by WIPO.

United States

In the United States, the opposition period lasts for 30 days from the date of publication by WIPO but may be extended up to 180 days under certain circumstances. ✓1

b)

France

The period of non-use after which the mark is liable to revocation is 5 years. Mark must be used within this period to keep the mark in force.

United States

2

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In the United States, the period of non-use after which the mark is liable to revocation is 3 years. Mark must be used within this period to keep the mark in force. In addition, the applicant must file an affidavit containing a declaration of intention to use the mark in order to keep the mark in force. ✓¹/₂

¹/₂

2¹/₂

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Question 4

Firstly, assuming that the EUTM application was filed no longer than 6 months ago, it would be possible for the applicant to file national trade mark applications in each of the EU states of interest within 6 months of the filing date of the EUTM application which claim priority to the EUTM application and therefore retain the priority date of the EUTM application. ✓ $\frac{1}{2}$

Secondly, the applicant may request that the EUTM application be converted into corresponding national applications under Article 139 of the EUTMR. The applicant must make such a request to the EUIPO within 3 months of the refusal being issued by the EUIPO and can only be made insofar as the mark has been refused. In this case, seeing as the refusal has been in respect of an English word, it is likely that such a request in respect of states with English as an official language will not be admissible (e.g., Ireland and Malta). After the EUIPO has examined the request for formal requirements and forwarded the request to the national offices of the EU member states of interest, each member state may require within 2 months of receipt of the request:

1. Payment of a national application fee;
2. Translation of the request and any associated documents;
3. An address for service in the member state (i.e., a local attorney); and
4. Any further representations of the mark as required by their national law.

The national applications which result from this process will retain the priority date, filing date and seniority of the EUTM application, which may be advantageous to the applicant. This is the only way to retain the filing date of the EUTM, and not only the priority date. ✓ $\frac{1}{2}$

MARKS AWARDED: 2.5/4

2 $\frac{1}{2}$

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Question 5

Goodwill is associated with the good standing and/or reputation of goods and/or services and not explicitly with any mark or sign associated with the goods and/or services or under which the goods and/or services are traded. Therefore, common law restrains traders from assigning their goodwill except along with the business assets relation to the manufacture of the product (or the supply of service) concerned because these business assets are essential for the production of the goods and/or services to which the goodwill relates. ✓¹

2

MARKS AWARDED: 2/2

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Question 6

The United Kingdom is no longer a relevant territory to be considered in any invalidity proceedings of an EUTM following the end of the Brexit transition period, irrespective of the filing or registration date of an EUTM. Therefore, the filing date/registration date of each mark is not relevant, because any action would need to be brought now (i.e., after the end of the Brexit transition period).

In this scenario, the client should be aware of the principles provided in the Windsurfing Chiemsee case. We know that the name is not recognized at all by consumers outside of the UK. However, from the Windsurfing Chiemsee case, we know that even where the mark is not currently associated with a geographic location in the minds of the relevant class of persons, we must consider whether the mark is *capable* of indicating the geographic origin of the goods. The relevant class of persons will not be consumers in any EU member state. ✓1

Generally, goods do not need to be known as being manufactured in a place in order for the goods to be associated with the place. In this case, it is clear that the mark is indeed at least capable of indicating the geographic origin of the goods, and so the client is likely to be able to bring successful invalidity proceedings against each of the marks on the absolute ground that it is descriptive of geographic origin, unless the proprietor of any of the marks can show evidence of acquired distinctiveness which the marks have subsequently obtained in the European Union.

Allow ✓1 for 333

MARKS AWARDED: 2/3

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2

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Question 7

Where the applicant for opposition has been prevented from using the mark by a term in a contract to which the applicant is a party.

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MARKS AWARDED: 0/1

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Question 8

1. To change the name and/or address of the applicant; ✓ $\frac{1}{2}$
2. To make changes to the mark or the representation of the mark which do not alter the distinctive character of the mark;
3. To make changes which do not extend the category of goods and/or services which the mark protects; and ✓ $\frac{1}{2}$
4. To correct obvious errors in copying and transcription. ✓ $\frac{1}{2}$

1 $\frac{1}{2}$

MARKS AWARDED: 1.5/4

1 $\frac{1}{2}$

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Question 9

From the filing date^{✓½} of the trade mark (which is called the date of registration in the Trade Marks Act).

½

MARKS AWARDED: 0.5/1

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Question 10

a)

This occurs where the proprietor of a registered trade mark has died and bequeathed the trade mark as personal property to another party. Personal representatives are therefore required to make an assent in relation to the trademark to reflect this, because the proprietor is unable to assign the trade mark themselves. ✓1

1

b)

Until the assent is recorded, the assent is ineffective against any party acquired a conflicting interest in or under the mark in ignorance of the assent (e.g., as a bona fide purchaser without notice). ✓½

Otherwise, there is a [soft] ✓½ deadline of 6 months from the date on which the ✓½ assent was made. If this deadline is not met, a Court will not award costs to any ✓½ party benefitting from the assent in infringement proceedings unless the Court is satisfied that it was not practicable to record the assent within 6 months of the date of the assent, but that the assent was recorded in the register as soon as practicable thereafter. ✓½

3

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4

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Question 11

In the UK, the proprietor of a trade mark cannot prevent the further sale of goods under their mark which have already been placed on the market in the UK or the EEA by the proprietor or with their consent unless there are legitimate reasons to oppose further sale. In other words, the proprietor's rights are exhausted after the goods have been placed on the market in the UK or the EEA.

In this case, the goods were not placed on the market in the EEA (that is, France) by or with the consent of Y. They were placed on the market in the EEA by X, who has an EUTM covering the same goods, but this is an entirely separate right. Therefore, Y is entitled to bring an infringement action against Z for using the mark in the UK in the sense that Z is importing goods under the sign into the United Kingdom.

2

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Question 12

a)

An opposition action may only occur within the specified opposition period (that is, within the period of two months after publication of the UK trade mark application, *extendible by up to a further month) and before the registration of the mark, which occurs after the opposition period has expired. On the other hand, an invalidity action may be brought at any time following registration of the mark. ✓1

1

b)

- An opposition action is considerably less expensive than an invalidity action;
and

- An opposition action usually takes less time to reach a conclusion than an invalidity action (UKIPO aims for completion of the opposition procedure within 12 months of initiation). Allow ✓½

½

c)

- The grounds available for an invalidity action are more numerous than the grounds available for an opposition.

0

MARKS AWARDED: 1.5/4

1½

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Question 13

The facts of this situation closely correspond to the facts of Opel vs. Autec case,^{✓1} which provides some relevant guidance.

It appears that the only relevant class of goods for which Middlesex's Constabulary's logo is registered to the activities of MiniRace Ltd is "Class 28 – Toys and models".

In this case, it was reaffirmed that the purpose of a trade mark is to serve as a badge of origin.^{✓1} In general, use of a trade mark so as to ensure faithful reproduction of a model is not likely to constitute infringement^{✓1} of the trade mark, so long as there is no likelihood of confusion as to the origin of the good concerned.

The question to be considered is whether the relevant class of persons would be likely to believe that the good in question originated from Middlesex Constabulary instead of MiniRace Ltd. It is not clear whether MiniRace have applied their own mark to the model of the Middlesex Police car. In the Opel vs. Autec case, Autec did apply their own mark to the model of the Opel vehicle, and this was considered to contribute to the fact that there was not likely to be any confusion as to the origin of the model on the part of the relevant public.

If MiniRace Ltd have not applied their own mark to the model and have exclusively applied the mark of Middlesex Constabulary to the model, it is likely that they will be able to invoke their trade mark rights against MiniRace.

Otherwise, the outcome of any infringement proceedings is much less certain and much less likely to succeed.

3

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SECTION B

Question 14

Objections under various absolute grounds for refusal given by the UK Trade Marks Act 1994 are considered in turn below.

Section 3(1)(a) TMA 1994

- A mark is not to be registered which does not meet the requirements of Section 1 TMA 1994. In other words, it must be capable of representation in the register so as to enable the registrar, competent authorities and the public to determine the clear and precise subject matter of protection afforded to the proprietor. In addition, the mark must be capable of distinguishing the goods and/or services of one undertaking from those of another undertaking.

The shape of a tyre-tread is most likely considered to be a non-traditional mark (i.e., a shape mark). A question arises as to whether the mark is able to be represented in the register in a manner which satisfies the requirements of Section 1(1) TMA 1994. The criteria set out in Sieckmann may apply in particular. Representations of the tyre tread must be filed which are clear, precise, objective, self-contained, intelligible and durable. Filing graphical images of the tyre-tread would likely satisfy these requirements, so an objection on these grounds is unlikely to be raised by the UKIPO. ✓^{1/2} 1(1) ✓¹ 1(1)

1(1) –
1½

Section 3(1)(b) TMA 1994

- A mark is not to be registered if it is devoid of distinctive character.

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From various aspects of case law (such as Remington vs Philips and Nestle vs Cadbury), we know that shape marks are particularly vulnerable to being considered to lack distinctive character, since the average consumer is not used to identifying the origin on goods based on shape alone. Therefore, an objection under this subsection may be raised by the UKIPO. ✓1 3(1)

Section 3(1)(c) TMA 1994

- A sign is not to be registered if it consists exclusively of signs or indications which indicated the kind, quality, quantity, value, geographic origin or intended purpose of the goods.

There does not appear to be any grounds to raise such an objection against the registration of the BLING-BLING pattern as a UK trade mark. ✓1 3(1)

Section 3(1)(d) TMA 1994

- A sign is not to be registered if it consists exclusively of signs or indications which have become customary in the current language.

Again, there does not appear to be any grounds to raise such an objection against the registration of the BLING-BLING pattern as a UK trade mark. ✓1 3(1)

3(1) – 3

Section 3(1) TMA 1994 concluded

An objection made under any of Sections 3(1)(b)-(d) may be overcome if the applicant can show evidence of acquired distinctiveness.

Evidence of acquired distinctiveness

From the Windsurfing Chiemsee case, we know that the UKIPO will consider the following factors when considering any evidence of acquired distinctiveness:

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- how long standing and geographically widespread use of the mark has been;
- investments made in promoting the mark;
- statements from relevant chambers of commerce; and
- opinion polls from the relevant class of persons.

In particular, if the UKIPO finds that a significant proportion (no particular number is given) of the relevant class of persons identifies the goods of the undertaking (that is, Michelstone Tyres by virtue of the BLING-RING tread pattern), it must hold that the requirements for registration are fulfilled.

In this case we know that Michelstone have invested heavily in promoting the mark, which counts in their favour. In addition, they claim that virtually everyone under 30 recognises their tyres bases on the tread pattern. However, it is not clear that the UKIPO will consider “everyone under 30” to be representative of the relevant class of persons. The relevant class of persons is more likely to be considered to be all UK road motorists. Michelstone therefore probably require more evidence of acquired distinctiveness in order to overcome an objection made under Section 3(1)(b).

Further, from case law (in particular, Nestle vs Cadbury) we know that is particularly difficult for a proprietor to show that the relevant class of persons not only identify a shape mark, but rely on it as well (which is the requirement). For example, do all under 30s recognise their tyres as being from Michelstone purely on the basis on the tread pattern and not on the basis of any of signs or marks placed on the tyres? It is not clear that this is the case, and so more information/evidence is required.

AD – 5

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Sections 3(2)(a)-(c) TMA 1994

A mark will not be registered if it consists exclusively of the shape or another characteristic which:

- (a) is a result of the nature of the goods themselves;
- (b) is necessary to achieve a technical result; and/or
- (c) gives substantial value to the goods.

None of these exclusions appear relevant in this case. In particular, we know that that there are many other tread patterns and/or shapes which could have been chosen for the tyres, and so Section 3(2)(a) is not relevant. Further, we are told that the shape of the tyre tread is in fact detrimental to the technical function of the tyre, so Section 3(2)(b) is not applicable. It also does not appear that the shape of the tyre tread in and of itself gives substantial value to the tyres (although the marketing thereof may have done), so Section 3(2)(c) does not apply.

✓1 3(2)

3(2) – 1

Section 3(3)(a) TMA 1994

- A mark is not to be registered if it is contrary to public policy or accepted principles of morality.

Here we should consider the relevance of the Director of Engineering's comments in their resignation letter. Despite the tyre tread apparently meeting the minimum grip requirements in the UK (i.e., it is "road legal"), there is a question as to whether it nonetheless is contrary to accepted principles of morality. The director of engineering argues that its use will lead to make unnecessary deaths, particularly as a result of its marketing to young people. However, the use of the

✓1 3(3)

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mark and the marketing of the mark are not the same thing, and any objection raised under this section must directly relate to the mark itself and not to any marketing of it. ✓1 3(3)

Further, we are told that a search of the technical literature finds that an array of S-shaped studs is commonly used by construction and military vehicles.

However, no other tread pattern on the market looks remotely similar. At first sight, this information appears useful to arguing against any objection raised under this section, seeing as a similar shape is currently used in the industry and is therefore already “accepted”, and so cannot be contrary to any accepted principles of morality. However, military and construction vehicles are used in dissimilar environments to road vehicles (i.e., commonly used on soft terrain as opposed to macadamised surfaces). However, these are also used on roads, and so their use may be helpful in showing that use of such a type of tyre is not contrary to accepted principles of morality of public policy.

3(3) – 2

Section 3(3)(b) TMA 1994

- A mark is not to be registered if it is of such a nature as to deceive the public.

The director of engineering’s comments seems to be only of periphery relevance here and it does not appear that the mark itself is in any way deceptive to the public. Accordingly, an objection is unlikely to be raised on these grounds.

Conclusion

In light of the above discussion, it appears that Michelstone Tyres can register the BLING-BLING tread pattern as a UK trade mark so long as they are able to

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convince the UKIPO that the acquired distinctiveness of the tread pattern is sufficient to overcome any objections made under Sections 3(1)(b)-(d), notwithstanding any relative grounds for refusal which may or may not be raised.

✓1-C

MARKS AWARDED: 13.5/20

13½

C-1

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Question 15

Firstly, let us consider the likelihood of confusion arising from the use of the later mark. At the outset, we observe that the marks are not identical and are not registered or applied for in respect of identical goods and/or services. The marks are at best similar and are registered or applied for in respect of similar goods and/or services. The similarity of the marks and the similar of goods are considered in turn below.

Similarity of the marks

Aural

Both marks therefore comprise the English word “Le-mon” at the beginning of the printed lettering. However, the earlier mark is comprised of three syllables while the second mark only has two syllables. In addition, the earlier mark is presented as a single word, whereas the later mark is presented as to separate words. How clear and obvious this would be is not certain, as the spacing between the words “Le” and “Monde” is not particularly large. Accordingly, aural similarity is present

Visual

Both marks are three-dimensional marks for a bottle comprising a spherical body with a cylindrical-necked aperture/spout. In the earlier mark, the cylindrical spout is off centre, whereas in the later mark, the cylindrical aperture is at the top. This difference does not really amount to a significant difference, as this merely depends on how the bottle is oriented or where the viewer is looking from to have an effect. In addition, in the later mark, the lettering is presenting in an all-upercase manner. In the earlier mark, the lettering is presented in all-sentence

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case. However, it is not clear how much significance would really be placed on these differences or the distinguishing power thereof. ✓1

In the earlier mark, all elements are resented in blue with a Pantone colour given. In the later mark, no claim is made to the colour. Accordingly, the later mark covers an arrangement in which all of its elements are presented in the same Blue as the earlier mark. This gives rise the further visual similarity of marks, in the absence of any colour claim in the later mark. ✓1

The visual similarity between the marks is therefore relatively strong.

Conceptual

The earlier mark contains the word “lemonade” printed on its surface. This has a clear and ordinary meaning in the English language. We are told that “Le Monde” has no English meaning. Therefore, the relevant class of persons (i.e. UK consumers) is likely to see the word “Le Mon” in the later mark and draw a reference to the fruit. ✓1

In the absence of any other meaning to which the relevant class of persons can give to “le monde”, we must conclude that there is conceptual similarity between the marks at least insofar as both refer to the lemon as a fruit (but not necessarily a drink comprising lemon).

Similarity of the goods

The categories of goods are somewhat related to one another. The classification of the goods may be considered to be in some kind of competition with one another, since both related to the broader category of drinks. However, it is probably more important to discuss the fact that the classifications of goods are

SOM – 6

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complementary to one another, because soft drinks are often used to complement and/or mix with alcoholic spirits. From case law given in Canon vs. MGM, we know that a likelihood of association (i.e., that the goods may come from the same undertaking) may arise as a result of the complementary nature of the goods for which the respective marks are registered. It appears that this principle applies in this case.

SOG – 1

Therefore, it appears that there is a strong case that there may be a likelihood of confusion because of the similarity between the marks and the similarity between the category of goods for which they are [to be] registered. Therefore, the UK mark most likely provides strong grounds for opposition to the later mark on relative grounds (that is, under Section 5(2) TMA 1994) so long as the use requirements are met.

AC – 0

LOC – 1

Use requirements

Finally, we must consider whether the earlier UK mark meets the use requirements if it is to be used for opposition purposes with respect to the later mark. The UK mark appears to be a former EUTM which has been cloned into a UK right, as indicated by the prefix digit -9 in its UK mark number. However, to all intents and purposes it is otherwise to be considered as if it were a UK mark from the outset. The use requirements are met if:

- the registration process of the earlier mark was completed more than 5 years before the filing date or the later mark (which is true in this case); and
- the earlier mark has been put into genuine use in the United Kingdom by the proprietor or with his consent within a period of 5 years preceding the

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filing date of the later mark (which is not true in this case, because it has only been used in France, Italy and Spain); or

- the earlier mark has not been so used but there are no proper reasons for non-use (which does not appear to be true in this case).

Therefore, the UK mark does not meet the use requirements for it to be used as a basis to oppose the advertised mark.

Conclusion

Accordingly, the client cannot successfully oppose the advertised mark in spite of the apparently strong case for opposition on relative grounds. ✓1

Euf – ½

C – 1

MARKS AWARDED: 9.5/20

9½

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Question 16

There are three essential elements for a tort of passing off to be successful.

These are:

- goodwill;
- misrepresentation;
- damage.

Each must be present in order for passing-off to provide a remedy for Delilah, and each is considered in turn below.

Goodwill

Goodwill is related to the good reputation/standing of the goods and/or services provided by a person. Goodwill requires there to be trade in the United Kingdom associated with those goods and requires there to be customers in the UK. In this case, Delilah may have goodwill associated with two things: her TV cookery show and the accompanying recipe book, both of which were an enormous success at the time. It would seem that goodwill is associated with both things, since the cookery show presumably generated revenue for Delilah at the time, and she presumably also took revenue from sales of the recipe book.

The time at which the potential goodwill which resides in her cookery show and the accompanying recipe book was a relatively long time ago (2006), which raises the question of whether the goodwill has been abandoned or extinguished. However, goodwill is not necessarily immediately extinguished or abandoned after cessation of trading. In addition, it is not clear whether Delilah is continuing to sell the accompanying recipe book to the public to this day. If she is, then

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there is likely goodwill still associated with the recipe book (and therefore the name of the book) and associated with the TV cookery show. ^{✓1 G} Given the enormous success of each product, it would appear that Delilah has a significant amount of goodwill associated with her goods and services.

Goodwill is not explicitly related to the sign under which the goods and/or services are provided, but the goods and/or services themselves. In this case, both the recipe book and the TV cookery show were provided under the name "PORTRAITS OF DELICIOUSNESS". This sign is therefore associated with the goods and services of Delilah. There is a question as to whether this sign is purely descriptive in relation to a TV show and a recipe book containing pictures of food (or of food/cakes), but it likely has acquired a secondary meaning which is associated with the goods and services of Delilah owing to her success. ^{✓ M}

Further, we know that the cake designs themselves have become extremely familiar to the public through the high-definition TV show which showcases her cakes and recipe book which contained lavish photographs of the cakes. Therefore, the actual appearance of the cakes themselves is likely to be considered to be a sign under which goods and/or services of Delilah has goodwill. ^{✓½ M}

Misrepresentation

Misrepresentation merely requires that a less than honest representation has been made with respect to goods and/or services in which the claimant has goodwill. Misrepresentation need not be intentional on the part of Samson. However, Delilah must show that a substantial proportion of the public misunderstood the origin of the range of cakes sold by Samson as a result of the

G – 5

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use of the sign (that is, the name "PORTRAITS OF DELICIOUSNESS"). While the cakes are made according to Delilah's recipe, they are not in fact made by her and so there is likely misrepresentation on the part of Samson in this regard. ✓1 M

The production of cakes which are look near-identical to the cakes shown on the TV programme and in the book also amounts to misrepresentation on the part of Samson. As discussed above, the appearance of her cakes is likely a sign under which her goods and/or services have goodwill, and the use of this sign in the course of trade by Samson likely has taken undue advantage of her goodwill in this respect. The appearance of the cakes (i.e., the design of the cakes) has probably causes a substantial proportion of the public to be confused as to the origin of the cakes, and therefore misrepresentation has occurred. ✓1 M

However, it does not appear that Delilah produces and sells any cakes to the public under her signs. Therefore, there is a dissimilarity between the goods and services which Samson is providing (that is, cakes) and the goods and services in which Delilah has goodwill (that is, a TV show and the accompanying recipe book). However, because Delilah seemingly has a lot of goodwill in her goods and services, the dissimilarity between the goods provided by Samson and the goods and services provided by Delilah may be offset by the wide-ranging goodwill of Delilah. Allow ✓1 M

The "unauthorised" use of Delilah's recipes does not amount to misrepresentation on the part of Samson. Using the recipes and cake designs is not likely, in and of itself, to mislead the public with respect to the origin of the goods. This is particularly true since the public are able to make cakes to her recipes and to her cake designs according to the recipe book she is selling, and

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they would be under no illusion as to the ability of another party to make cakes to her recipes. ✓1 M

M – 5½

Damage

Seeing as Delilah is apparently not in the business of making and selling cakes commercially, it is difficult to see what loss of earnings or other damage Delilah has suffered as a result of Samson's actions. However, she may be able to argue that she has suffered a loss of future commercial opportunities and/or a loss of an opportunity to expand into a new market (that is, the making and selling of case). This is often a sufficient kind of damage for a successful passing off action. ✓1 D ✓1 D

D – 2

Remedies

In conclusion, the law of passing off may be able to provide a remedy for Delilah in this for scenario. As for specific remedies, if Delilah were successful in a passing-off action she could seek damages or an account of profits from the Court. In this case, it appears that Delilah wishes to obtain an account of profits (i.e., a cut of their profits). ✓1 R

R – 1

C – 0

13½

MARKS AWARDED: 13.5/20

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