

# Foundation Certificate

## FC5 Trade Mark Law

**Wednesday 19 October 2022**

**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 **10 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

- a) Compare and contrast the start date and length (including extensions) of the opposition period in:
- i) the USA;
  - ii) the EU,

for designations of those jurisdictions made under the Madrid Protocol.

**4 marks**

- b) Compare and contrast any declarations concerning the use of (or intention to use) a trade mark that are needed to designate:

- i) the USA;
- ii) Ireland;
- iii) the EU,

when making a Madrid Protocol application.

**3 marks**

**Total: 7 marks**

### Question 2

In 2015, Charlie used the Madrid Protocol to register an international trade mark designating the EU, Norway and Switzerland. An American trade mark, registered in 2013, served as the basic registration. Charlie now wishes to use the Madrid Protocol to obtain protection in China and Japan for the same mark and goods.

- a) **What does Charlie need to do to obtain Chinese and Japanese protection?**

**1 mark**

Charlie mentions that although his American trade mark is still registered, he has “not been trading in the USA for the last couple of years or so.”

- b) **Does this cause you any concern? Explain your answer.**

**3 marks**

**Total: 4 marks**

### Question 3

- a) In the context of EU trade mark law, explain what is meant by 'conversion'. **2 marks**
- b) Give one advantage of using the conversion procedure. **1 mark**
- c) Suggest one disadvantage of using the conversion procedure, rather than applying directly to national offices. Give a reason for your answer. **1 mark**

**Total: 4 marks**

### Question 4

List a right, OTHER than an 'earlier trade mark', on which an opposition action may be based on relative grounds:

- a) in the UK **1 mark**

and

- b) in the EU. **1 mark**

**Total: 2 marks**

### Question 5

Juliet recently filed a UK trade mark application for, among other things, 'virus-filtering face masks', listing them under 'class 9' (generally the class for protective clothing). However, the subsequent examination report says that such face masks are proper to class 10 (generally the class for medical equipment) and should be reclassified.

**Explain the consequences, if any, for Juliet if she amends the application to reclassify virus-filtering face masks as class 10 goods.**

**2 marks**

### Question 6

Foxtrot Ltd, which is domiciled and has effective commercial establishments only in the UK, owns the following trade marks:

Number	Jurisdiction	Mark	Filing date	Goods
'123	UK	YANKEE	1 March 2022	Whiskey
'234	Canada	YANKEE	1 July 2022	Whiskey, gin
'345	UK	YANKEE	1 August 2022	Gin

You have been instructed to file the following trade mark as soon as possible:

Jurisdiction	Mark	Goods
Madrid Protocol, designating: Japan, China, USA	YANKEE	Whiskey, gin.

**What priority date(s), if any, can be claimed? Give reasons for your answer.**

**2 marks**

### Question 7

a) What are the benefits of registering a trade mark licence on the UK trade mark register?

**3 marks**

b) Set out any deadlines for doing so and the consequences for missing these deadlines.

**4 marks**

**Total: 7 marks**

### Question 8

Bravo Ltd ('Bravo') sells chocolate bars in packs of four. Each chocolate bar has its own wrapper that prominently displays:

- the Bravo logo, a UK registered trade mark, together with
- the words 'NOT FOR INDIVIDUAL RESALE'.

Each pack has an outer wrapper, which also carries these same two features.

Oscar buys the packs cheaply from a wholesaler in Scotland, cuts open the outer wrapper, and sells the bars individually in his London shop, making a large profit by doing so.

**Explain, with reasons, whether Oscar is infringing Bravo's registered trade mark.**

**4 marks**

### Question 9

With respect to a UK trade mark:

- a) explain the difference between 'revocation' and 'invalidity'. **1 mark**
  
- b) set out the respective dates from which the revocation and invalidity are deemed to have effect. **2 marks**
  
- c) give three examples of grounds for the revocation of a trade mark. **3 marks**
  
- d) give two examples of grounds for invalidity of a trade mark. **2 marks**

**Total 8 marks**

**SECTION A Total: 40 marks**

## SECTION B

### Question 10

Your client, Delta Dairies Distribution Ltd ('DDD'), sells cheeses to wholesalers, cheesemongers and supermarkets. It sources the cheeses from two dairy farms, Whiteacre Farm Ltd ('Whiteacre') and Greenacre Farm Ltd ('Greenacre'). Both Whiteacre and Greenacre sell their cheeses exclusively through DDD.

Cheeses have traditionally been manufactured as cuboid blocks, cylindrical 'wheels' or as near-spherical balls. Uniquely, DDD has asked Whiteacre and Greenacre to manufacture their cheeses as dodecahedral blocks. Dodecahedrons are 12-sided solids, each side being a regular pentagon, as shown in the illustration overleaf.

DDD explains that its sales have grown steadily since the cheeses were first marketed, three years ago. Furthermore:

- its customers have fed back that this shape is 'novel', 'futuristic' and 'cool';
- a possible advantage of a cheese with multiple flat sides (over cylindrical or spherical shapes) is that the cheese can be easily sliced at a variety of angles without the risk of it rolling off the cutting-board;
- each cheese additionally carries a pentagonal label on one of the blocks' sides featuring the name of the farm who manufactured it, together with fat and salt content, weight and other statutory labelling information. There is no reference to DDD on the labels.

DDD wishes to register the shape of a dodecahedron as a UK trade mark for 'cheese'. It does not want to include any label within the scope of the protection.

- a) **Explain whether a trade mark application by DDD for a dodecahedron shape satisfies the fundamental requirements of a registered trade mark set out in Section 1(1) of the *Trade Marks Act*.**

**3 marks**

- b) **Explain whether, on the evidence above, the applications would meet the other 'absolute' requirements of registration, including those applicable to shape marks, set out in Section 3(1) and (2) of the Act.**

**12 marks**

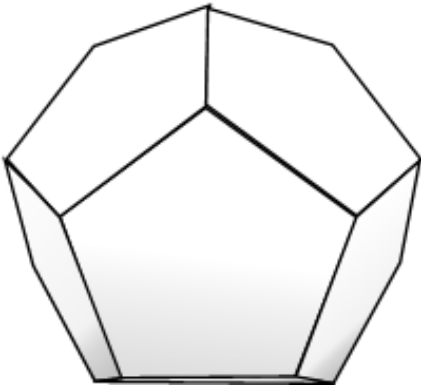
Like many cheeses, the cheeses sold through DDD are protected by a coating of a non-toxic paraffin wax. This preserves the cheese but does no harm if accidentally eaten. It is common for the wax to be black, yellow or red, but uniquely the cheeses made by Whiteacre are coated in white wax, and the cheeses made by Greenacre are coated in green wax. DDD is seeking your advice on the registrability of two additional trade marks, in which the colours white and green are claimed as an important feature of the respective marks.

- c) **Explain whether a white- and green-coloured variation of the dodecahedral mark affects your analysis in parts a) and b) above.**

**5 marks**

**Total: 20 marks**

**A dodecahedron:**




### Question 11

Your client, Mike Bike ('Mike'), has applied to register the following UK trade mark. He plans to use it on a pedal bicycle designed for 5- to 7-year-old children.

Application Number	'222
Priority Date	1 December 2021
Filing Date	1 March 2022
Publication Date	1 September 2022
Sign:	<b><u>TRIATHLON 24</u></b>
Goods:	Class 14: Bicycles.

Mike has recently received a letter from Viktor Motorradwerke AG ('VMW'), threatening opposition based on their following UK trade mark:

Trade mark number:	'111
Priority Date	1 August 2016
Filing Date	1 October 2016
Publication Date	1 January 2017
Registration Date	1 April 2017
Mark:	
Description:	A non-standard mark, namely a musical mark in which the words 'Biathlon Four' are sung to the notes indicated.
Goods:	Class 14: Motorcycles.

Further investigations reveal that mark '111 was written as a 'jingle' for a TV advertisement for a new off-road motorcycle model. However, late into development, the model was given a different name and so, while the tune has been reused with the new name, the words 'Biathlon Four' have never been used publicly.

- a) **Advise Mike whether mark '111 can validly serve as an earlier mark for the purpose of opposition proceedings. Give reasons for your answer.**

**1 mark**

Assume that '111 **can** validly serve as an earlier mark for the purpose of opposition proceedings. You remember that a 'biathlon' is a sports event comprising skiing and rifle shooting, and that a 'triathlon' is a sports event comprising swimming, cycling and running. You are also aware that there is an increasingly large market for power-assisted electric bicycles.

- b) **Advise Mike whether VMW would be able to successfully oppose application '222. Do not discuss absolute grounds, marks with a reputation or passing off.**

**19 marks**

**Total: 20 marks**



## Question 12

Your client, Aliments Quebec LLC ('Quebec'), is the manufacturer of a breakfast cereal, QUEEN BEE HONEY FLAKES. The cereal is sold in a particularly elongate cylindrical box, comprising a surface decoration of black and yellow horizontal stripes (see below left). Quebec's marketing director explains that:

- the name 'honey flakes' is generic and in widespread use for honey flavour cereal flakes, but
- the cylindrical box is unique on the market, cereals to date being sold in cuboid boxes or in bags, and
- the stripes are also unique, inspired by the patination of honey bees (honey being a major flavouring ingredient of the product).

ALDL plc is a national supermarket chain. It is well-known for selling own-brand products that take their branding cues from well-known competitor products. ALDL has recently issued an advert for a new breakfast cereal that reads: 'COMING SOON: HIVE HONEY FLAKES'. The advert shows a particularly elongate square-prism-shaped box with black and yellow horizontal stripes (see below right).



- a) Set out a case on behalf of Quebec arguing that ALDL is engaged in passing off. Suggest any additional information or evidence that would be needed for a case to succeed.

12 marks

- b) Explain the remedies that would be most appropriate for Quebec to request from a court. Give reasons for your answer.

4 marks

- c) Suggest any arguments that ALDL would make in its defence.

4 marks

Total: 20 marks

### Question 13

State the legal principles (*rationes decidendi* and *obiter dicta*) established by the following four cases on distinctiveness:

- 1) *Nichols plc v Registrar of Trade Marks* (C-404/02) ('NICHOLS') **3 marks**
  
  - 2) *Procter & Gamble Company v OHIM* (C-383/99) ('BABY DRY') **3 marks**
  
  - 3) *OHIM v Wm. Wrigley Jr. Company* (C-191/01) ('DOUBLEMINT') **3 marks**
  
  - 4) *Windsurfing Chiemsee Produktions- und Vertriebs GmbH and Boots- und Segelzubehör Walter Huber* (C-108/97) ('CHIEMSEE') **11 marks**
- Total: 20 marks**