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FC5	1 of 13	54%

Examiner's use only

Section A

Q1)

- a) i) Opposition period in USA is 30 days from publication. Can be extended to 180 days ✓½
- ii) Opposition period in EU is 30 days from publication. Cannot be extended. ½
- b) i) USA – an intention to use declaration is needed. Also need a declaration of use at 5/6 year period and at each 10 year renewal. ✓½
- ii) Ireland – none required 0
- iii) EU – none required. ✓1

2 MARKS AWARDED: 2/7

Q2)

- a) Charlie needs to complete the relevant form designating China and Japan from the basic US Madrid protocol application. 0
- b) In the USA, the period of use in respect of potential revocation is 3 years, not 5 years as is the case in the UK. The TM will be at risk of being revoked if it is not used within the 3 years following date of completion of registration (or a continuous period of 3 years). There is also a requirement to demonstrate use within the USA at the 5/6 year period and at each 10 year renewal. For Charlie, this renewal is 2023. ✓1 The 5 year dependency period has passed, so protection in EU, Norway and Switzerland should not be impacted, but the new designations in China and Japan may be. ✓1

2 MARKS AWARDED: 2/4

Q3)

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- a) Conversion is the process by which the holder of an EU trademark can convert to one or more national rights for any individual EU member states. This can be advantageous in situations where the EUTM is challenged/revoked in a single member state, and rather than the entire EUTM being lost, rights are converted in specific states. ✓1
- b) As above – can maintain rights in some member states (possibly those of commercial interest), in the event that the EUTM is liable to be revoked due to an action in one member state (which has effect on entire EUTM)
- c) Overall the cost will be higher for initially filing an EUTM then converting than just applying directly to national offices at outset. ✓1

1

0

1

2 MARKS AWARDED: 2/4

Q4)

a) in the UK, a well-known mark (art 6bis of PC) ✓1

b) In the EU, opposition can be based on an application for an earlier EU Trademark. Allow ✓1

2

2 MARKS AWARDED: 2/2

Q5)

At application stage, can only amend name and address of applicant, errors of wording or copying or obvious mistakes, and cannot make changes which would change the identity of the mark or extend the protection. However, in this case, the UKIPO has requested the change so no impact on filing date. Could alternatively argue this is an obvious mistake on part of applicant.

0

0 MARKS AWARDED: 0/2

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Q6)

Madrid Protocol applications require a 'basic application' to be in a member state where an individual is resident, or a company is domiciled or has an effective industrial or commercial enterprise in that state. As a result, only the UK applications can be used as the basic application. However in this case, the 6 month priority period under the Paris Convention is more relevant.

For GIN – priority can be claimed back to the date of '345 (1 August 2022) since we are within the 6 month priority period.

For WHISKEY – cannot claim priority back to '123 as we are outside the 6 month window for this (expired 1 September 2022). Also cannot claim priority to '234 as it is not a first filing as required by Paris Convention, so no priority can be claimed. ✓1

1

MARKS AWARDED: 1/2

1

Q7) a) A TM licence is a 'registerable transaction' and as such should be registered by a person who is entitled to an interest in or under the TM by virtue of the transaction (or another person who is affected by such a transaction. In particular, unless the licence is registered:

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- it will be ineffective as against a person who acquires a conflicting interest^{✓1} in ignorance of it (e.g. a later licensee)^{✓1}
- A licensee will not be entitled to the benefits/powers of Section 31/31 – power of a licensee in infringement proceedings^{✓1}
- c) The licence should be registered within 6 months. If the licence is not registered within this period and is later infringed, in any infringement proceedings, costs will not be rewarded for any acts that take place before the licence is registered, unless it can be shown that it was not practicable to register the licence within the 6 month window.^{✓1}

7

MARKS AWARDED: 7/7

Q8)

The principal of exhaustion states that a TM is not infringed by the further sale of any goods that have been put on the market by the proprietor or with his consent in the EEA, unless there exist legitimate reasons for opposing further dealings, in particular where the quality of the good have been compromised. In this case the goods (the chocolate bars) have not been compromised (unless an argument can be made that the goods should remain in packs of four), so there does not appear to be any infringement.^{✓1}

4

MARKS AWARDED: 4/4

Q9)

- a) Revocation is the later cancellation of a TM for example following non use for a 5 year period. Invalidity is more of a 'retrospective' action –

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i.e. the TM is deemed never to have existed and is withdrawn from the register. ✓1

1

b) Revocation has effect from the date the final judgement is made (by Registrar or other competent court).

Invalidity is backdated to the original date of registration – i.e. the mark is deemed never to have existed. ✓½

½

c) Revocation grounds as per Section 47

- Within the period of 5 years following the date of completion of registration, the trademark has not been put to genuine use in the UK by the proprietor or with his consent in relation to the goods and services for which it is registered and there are no good/proper reasons for non use, or such use has ceased for an interrupted period of 5 years (again, no proper reasons for non use). And in both cases, use of the mark has not commenced/resumed after the period of 5 year and before the action for revocation. ✓1
- That due to acts or inactivity on the part of the proprietor it has become the common name in the trade for a product/service for which it is registered. ✓1

2

d) TM can be declared invalid on any S3 absolute grounds:

- Does not satisfy the requirements of Section 1
- Devoid of distinctive character ✓½
- Contrary to public policy or accepted principals of morality ✓1

1½

5

MARKS AWARDED: 5/8

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Section B)

Question 10)

Section 1 of the UKTMA states that a trademark is any sign:

- Which is capable of being represented on the register in a manner which enables the registrar, the public and other competent authorities to determine the clear and precise subject matter of the protection afforded to the proprietor and
- Is capable of distinguishing the goods and services of one undertaking from those of other undertakings

Trademarks can be words, designs, letters, numerals, colours or shape of goods or their packaging. Shape marks (including 3D shape marks) are permitted, and the dodecahedron is a regular, basic 3D shape that can be easily graphically represented, the first aspect is satisfied. ✓1

For the second aspect since there is evidence that customers recognise the shape as 'novel, futuristic and cool', and since sales have grown, this strongly suggests that the shape enables people to recognise the supplier. ✓1

Overall, the shape appears to satisfy S1

b) Shape marks are covered by the following absolute provisions:

Signs are not to be registered if they consist exclusively of:

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- The shape or another characteristic that results from the nature of the goods themselves – would not appear to be an issue here as the product is the cheese, so there is freedom to select the shape, i.e. the cheese does not dictate the shape. ✓1
- The shape or another characteristic that is necessary to achieve a technical result – likely to be an issue here since it has been stated that multiple flat sides is an advantage when it comes to slicing the cheese. Shape would appear to fall foul of this. ✓1
- The shape or another characteristic that gives substantial value to the goods – no obvious issue here (unless being able to slice cheese can be said to give substantial value – doubtful) ✓1

3

Other absolute requirements are:

- Devoid of distinctive character – no issue here, since we have evidence that customers have fed back that the shape is 'novel, futuristic and cool'
- Shapes which have become customary in the current language and bona fide practices of the trade – no issues here since this shape is unusual when applied to cheese ✓1
- Shapes which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value or geographic origin or time of production of goods or rendering of services or other aspects. – no apparent issue here, not descriptive of cheese. ✓1
- Shapes which are contrary to public policy or morality – no issue here

2

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So overall, the issue with the shape being necessary to achieve a technical result is the main problematic.

- c) Registering the additional colour features should help with any objection to 'the shape being necessary to achieve a technical result', since the colour, when combined with the shape is considered as an entire trademark. Should not impact on S1 provisions. ✓1

TOTAL – 5

1

8

MARKS AWARDED: 8/20

Question 12)

Passing off action requires three aspects: goodwill, misrepresentation and damages.

Goodwill – goodwill is associated with goods or services rather than a trademark. It is related to the ability to 'pull in further custom' in the form of repeat business and requires consumers to have sampled the goods and for trade/business to exist in the UK. We would need to demonstrate that Quebec's product enjoys such goodwill – do customers recognise the stripes in particular, since the distinctive cylindrical box is not being copied by ALDL (we might argue that when stacked on shelves, both cylindrical and square prism boxes appear to have a similar 'tall' aspect ratio). We might want to conduct a survey of relevant customers (shoppers at a supermarket) to demonstrate goodwill exists – is the brand well known, also market information/share. We can assume that

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business/revenue exists for Quebec to be concerned re ALDL, but overall, more info is needed to demonstrate goodwill.

Misrepresentation – we would need to demonstrate that ALDL have deliberately copied the striped design with the intention of benefitting from the goodwill associated with Quebec's product. Might be difficult in this case since not all aspect of the design have been copied.

Damages – a successful passing off action does not require actual damages (e.g. financial loss) to have occurred, only that such loss could/is likely to occur. ^{✓1} Since ALDL's product is not yet launched, we cannot claim any lost sales, and it is unreasonable to suggest that individuals would not purchase Quebec's cereal but instead wait for the new product to launch. Overall, if goodwill exists and misrepresentation is proved, we can infer future damages.

3½

b) In cases of passing off, the following remedies are available:

- Injunction (including interim injunction),
- account of profits
- damages.

As stated above, since the Cereal is 'Coming Soon', there is no prospect of account of profits (since no profits yet exist), similarly, no damage has yet

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✓1 occurred, so the most appropriate remedy would be an interim injunction. ✓1 This would have the benefit of stopping ALDL from launching the rival product, and maintaining the status quo.

- d) ALDL would argue that the main distinguishing feature for Quebec's product is NOT the stripes, but rather the cylindrical box – we know this is unique on the market, and ALDL's proposed product does not have this feature. ✓1 Furthermore, ALDL would also argue that additional features are incorporated into its packaging (picture of the hive), and that back and yellow strips are well known to be associated with bees/honey. ✓1

7½

MARKS AWARDED: 7.5/20

Question 11)

- a) Cannot serve as an earlier mark due to lack of use over 5 year period.
Use in a variant form is allowed, but only if the variant for does not change the distinctive character – not using biathlon four is top great a change.

Similarity of goods

Users/use

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Bicycles vs motorcycles – similar in the sense that both are methods of transport, but they are used for different purposes and users – one is more recreational, the other is for longer distance, commuting etc. ✓1

Distribution channels

Different – unlikely to be any overlap in terms of where the two classes of goods are purchased. Bicycle shops/sporting outlets vs motorcycle court. ✓1

Nature

Some similarities – both have two wheels, both methods of transport. Power assisted bikes in particular might be seen as bridging the gap between the two. ✓1

Manufacturers

As with distribution channels, manufacturers are very different, even if we allow that power assisted bikes are becoming more common, there is no common manufacturer. ✓1

Complementary/Competitive

Could be argued the goods are competitive – in particular if we include power assisted bicycles since these can/are used for longer journeys/commute so there may be individuals who choose one over the other (although in practice, journey time would have to be fairly low milage) ✓1

Overall – weak similarity of goods, and if any exists it is fairly conceptual (two wheeled vehicle for transport)

✓1

SOG – 6

Similarity of marks

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Aural

When spoken, both consist of a three syllable word followed by a number. Initial word (Triathlon/Biathlon) have identical number of syllables (3) with only the first syllable being different, but difference is obvious (hard 't' vs softer 'b'). Sound of '24' vs '4' could be similar given final syllable the same. Total syllables is 6 for '222 and 4 for '111. Overall quite similar. Since TM '111 is registered as a musical mark, the aural similarity is very important here.

Visual

For a non-standard mark such as the musical mark, visual appearance is less relevant. Question is whether on seeing the mark, it might bring to mind the jingle.

Conceptual

Both triathlon and biathlon are conceptually similar – sporting events consisting of multiple disciplines. While someone who actively competes in such events would instantly recognise the difference, the average consumer of either product (see below) might not recognise the difference conceptually (bike purchasers may be more likely to recognise the difference).

Overall, conceptual similarity dominates here. Together with a similar aural nature (which dominates for a musical mark), could argue the signs are quite similar.

SOM 4½

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Average Consumer

Average consumer is different, despite the similarities outline above.

Motorcycles in particular are a lot more expensive, and would be chosen with care/research. ^{✓1} Pedal bikes significantly less expensive (even power assisted).

Motorcycles more for longer journeys rather than sport/recreation. Overall, unlikely to be much overlap in terms of average consumer.

AC – 1

Likelihood of Confusion

As per Canon, the strong similarity in marks can counteract a weak similarity in goods. There is a reasonable level of similarity in terms of marks (in particular the conceptual and aural aspects). Overall similarity in goods is lower, although again there is a conceptual aspect to the similarity of goods. ✓1 – LOC

LOC – 1

Likelihood of confusion is however unlikely given the difference in the goods and average consumer. At best, there may be a likelihood of association/bringing to mind of the earlier mark. Overall, any opposition is likely to be unsuccessful. ✓1 – C

C – 1

13½

MARKS AWARDED: 13.5/20

TOTAL – 13½

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