

FC5 Trade Mark Law
FINAL Mark Scheme 2022

- Half marks are available for answers that are insufficiently complete or accurate to attract a full mark.
- Article and section numbers are not required.

PART A

Question 1 – Comparative law and procedure

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

Answer:

a)

i) USA.

- Taken from **publication of the examined US application [1 mark]**.
- **30 days [0.5 mark], extendable to 60 as of right, 120 days with cause [0.5 mark]**.

ii) EU:

- Taken from the **1 month [0.5 mark] following the EU re-publication** of the Madrid Protocol **application. [0.5 mark]**
- **Three months, no extensions [1 mark]**.

4 marks

b)

- i) USA – A **separate [0.5 mark] declaration** needs to be signed and supplied alongside the application **[0.5 mark]**.

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- ii) Ireland – The simple declaration is required [0.5 mark] included within the main Madrid Protocol application form [0.5 mark].
- iii) EU: No declaration of use is required. [1 mark].

3 marks

Total: 7 marks

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Question 2 – Madrid Protocol

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

Answer:

a) Charlie needs to file a subsequent **territorial designation** [1 mark] under MP art.3ter.

1 mark

b)

- The US application is at risk of **lapse** (as a §71 declaration will be unable to be filed) or **revocation** (for three years' non-use), unless good reason can be demonstrated. [1 mark for either].
- However, there is no wider concern: specifically, neither:
 - the existing designations are at risk (as the five year **'dependence'** under MP art.**6 has passed**) [1 mark]
 - **nor are the subsequent designations at risk** (as art.6 applies only to the international registration, not to subsequent designations of that registration). [1 mark]

3 marks

Total: 4 marks

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Question 3 – EU Laws

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

Answer:

a) Under ETMR Art. 139,

- if an EU trade mark application or registration is finally **refused, cancelled or surrendered**, it can be converted into trade mark applications in **selected EU states** [1 mark]
- in which any **grounds for refusal or cancellation do not apply** [1 mark].

2 marks

b) It preserves priority/filing date of the EU application. [1 mark]

1 mark

c) **One mark for any valid answer, such as:**

- There is a **conversion fee** to pay.
- Potentially you might have to pay **consolidated renewal fees** to the national office on top of the application fee.
- There is a **period** between the application for conversion and its transmittal to local offices by the EUIPO, which will add to the time the **trade mark will be unenforceable**. (This is on top of the time lost during national examination and publication, which will be common to both routes).

1 mark

Total: 4 marks

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Question 4 – Opposition

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

Answer:

a) Award one mark for any acceptable answer listed under s.53(3A) TMA, for example:

- A right against passing off.
- A copyright
- Another ‘industrial property right’ e.g. a design right
- A designation of origin
- A geographic indication

1 mark

b) Award one mark for any acceptable answer (of very few) available under art.8 ETMR, for example:

- A ‘sign’ (other than a trade mark) used in the course of trade of more than local significance that confers the right to prohibit use. (e.g. a company name).
- A designation of origin
- A geographic indication.
- Appropriation by an agent.

1 mark

Total: 2 marks

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Question 5 - Application Process

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

Answer:

Any acceptable answer, for example:

- The scope of **protection is unaffected** by the classification. **[1 mark]**
- An additional **class fee** is required if class 10 is not already in the specification and class 9 needs to be retained for other goods. **[1 mark]**

2 marks

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Question 6 – Priority

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

Answer:

Applying s35 TMA:

- Priority for 'gin' from **1 July 2022 [1 mark]** ('232). Note, there is no issue with a UK company claiming priority from a Canadian filing.
- Whiskey was first claimed more than six months ago and so **priority cannot be claimed** for that. **[1 mark]**.

2 marks

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Question 7 – Transactions

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

a)

S.25(3) TMA provides that:

(3) Until an application has been made for registration of the prescribed particulars of a registrable transaction—

(a) the transaction is **ineffective as against a person acquiring a conflicting interest** in or under the registered trade mark **[1 mark]**

in **ignorance** of it, **[1 mark]** and

(b) a person claiming to be a licensee by virtue of the transaction does **not have the protection of section 30 or 31** (rights and remedies of licensee in relation to infringement). **[1 mark]**

3 marks

b)

Section 25(4) TMA provides that:

(4)

- Where a person becomes the proprietor or a licensee of a registered trade mark by virtue of a registrable transaction and **the mark is infringed before the prescribed particulars of the transaction are registered** **[1 mark]**
- in proceedings for such an infringement, **the court shall not award him costs** **[1 mark]** unless—

(a) an application for registration of the prescribed particulars of the transaction is made before the end of the period of **six months** beginning with its date **[1 mark]**, or

(b) the court is satisfied that it was **not practicable** for such an application to be made before the end of that period and that an application was made as soon as practicable thereafter **[1 mark]**

4 marks

Total: 7 marks

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Question 8 – Defences

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

Answer:

- Section 12(1) provides that a registered trade mark is not infringed by the use of the trade mark in relation to goods which have been **put on the market** in the United Kingdom under that trade mark **by the proprietor or with his consent**. [1 mark]
- Subsection (2) provides that this does not apply where there **exist legitimate reasons** for the proprietor to oppose further dealings in the goods [1 mark].
- Here, due to the double wrapping, the condition of the underlying goods have **not been changed or impaired**. [1 mark]
- The burden is very much on Bravo to provide some other **legitimate reason**. **For example**, it might be that important product labelling information (such as a list of allergens) that only appeared on the outer label and whose omission might cause damage to Bravo's reputation, or that the outer wrapper is an important part of the overall product as marketed by Bravo [1 mark for any similar answer in which a legitimate reason is discussed].

4 marks

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Question 9 – Invalidity

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**

Answer:

a) 1 mark for any acceptable answer, for example:

- A trade mark can be revoked if it ceases to meet the **ongoing requirements** of the Trade Marks Act.
- An invalid trade mark is one that **did not ever meet** the requirements of the Trade Marks Act.

1 mark

b)

- Revocation, according to section 46(6) takes effect either the **date of the application for revocation, or** if the registrar or court is satisfied that the grounds for revocation existed at an **earlier date**, that date. **[1 mark]**
- Section 47(6) deems the application **never to have been made** (that is, invalidity has retroactive effect to the filing date) provided that this **shall not affect transactions past and closed**. **[1 mark]**

2 marks

c)

Section 46(1) provides three grounds:

- The mark has **not been used, or use has been suspended, for a period of five years** from registration, without good reason. **[1 mark]**
- That, in consequence of **acts or inactivity of the proprietor**, it has become the **common name** in the trade for a product or service for which it is registered; **[1 mark]**.
- that in **consequence of the use made of it**, it is liable to **mislead the public**. **[1 mark]**

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3 marks

d)

Award one mark (up to total of two) for any acceptable answer under section 47 in conjunction with sections 3 and 5, for example:

- At the date of registration, **it did not possess distinctiveness, and has not acquired distinctiveness** in the meantime.
- **Relative grounds, provided that the use criteria of the senior mark** are met.
- It infringed a **copyright**
- It infringed a **design right**
- Its registration was contrary to the laws of **passing off.**

2 marks

Total 8 marks

SECTION A Total: 40 marks

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Part B

Question 10 – Absolute Grounds

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.

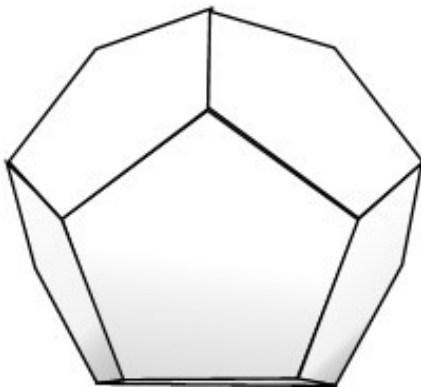
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- c) Explain whether a white- and green-coloured variation of the dodecahedral mark affects your analysis in parts a) and b) above.

5 marks

Total: 20 marks

A dodecahedron:



Answer:

Alternative well-reasoned answers, even if leading to a different conclusion, will attract equivalent marks.

a)

There are two requirements under s1 of the Trade Marks Act:

- Marks need to be capable of being represented in the register **clearly and precisely**. This criteria is met [1 mark].
- Marks also need to be capable of distinguishing goods or services of **one undertaking from those of other undertakings**. [1 mark].
 - Although the cheeses are sourced from two farms, **the applicant is the sole entity** putting them on the market and so this provision is met. [1 mark].
 - And in any case the mark is **capable** of distinguishing [alternative 1 mark].

3 marks

b) Award 1 mark, for any suitable contribution to the analysis up to the limits stated:

Section 3(1)(b) - Trade marks which are devoid of any distinctive character

- This shape is **a noticeable departure** to that of traditional cheeses.
- However, the average consumer would be used to **recognising products on the market by more traditional trade marks such as name or logos**.
- A three-dimensional shape might be perceived as being **decorative** and not afforded trade mark significance.

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- A three-dimensional product feature that serves **a function (e.g. to provide stability)** would be even less likely to be regarded as trade mark significance.

Section 3(1)(c) - indications of characteristics.

- There is **nothing** in the mark that indicates a **characteristic** of the cheese.

Section 3(1)(d) - customary signs

- The shape is **not customary**, being novel.

Maximum section 3(1) discussion: 4 marks

Section 3(2)(1) - Shapes which result from the nature of the goods themselves

- Cheeses can be any shape, and so the shape is **not a result of their nature**.

Section 3(2)(b) - Shape necessary to obtain a technical result.

- Stability whilst slicing is **a technical result**,
- There are a **large number**, but not infinite, number of solids (including irregular ones) that will achieve this end.
 - Nevertheless, the options are **not unlimited** and so if this is genuine advantage of the shape, an application will fail.

Section 3(2)(c) - shapes which give substantial value to the goods.

- The value of a cheese is likely to be in its taste or nutritional content: **shape is unlikely to make the cheese any more attractive to consumers**.

Maximum for section 3(2) discussion: 4 marks

Acquired Distinctiveness

- The use of the mark can **overcome problems** if there is an issue with the lack of inherent distinctiveness (but not section 3(2) grounds).
- However, the feedback is **no evidence that consumers perceive the shape as an indicator of origin**,
 - Few other criteria required by **Windsurfing** (relative size of promotional expenditure etc) are addressed.
- There is **no evidence** of consumer perception **outside the distribution trade**. A trade mark for 'cheese' will also cover the consumer market.
- The mark has only been used with a label. This tells us nothing about the distinctive character of the shape alone.
- The **distinctive effect of colour or surface decoration** also need to be eliminated.

Maximum for AD discussion: 3 marks

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Conclusion

- **Any clear, actionable conclusion** that summarises the analysis. E.g. all three marks are registrable without the need for acquired distinctiveness [1 mark].

Maximum for conclusion: 1 mark

12 marks

c) Award 1 mark, for any suitable contribution to the analysis up to the limit stated:

Section 1(1): The green cheese needs to more specifically list the **shade of 'green'** being used.

Section 3(1)(b): Colour, although unique shade on the cheese market, are not usually regarded as being distinctive per se, and so **neither add nor detract** from the inherent distinctiveness of the mark.

Section 3(1)(c): Colour is again **not a characteristic** of the product

Section 3(1)(d): Cheeses of different colours wax coatings *are* customary (regardless of whether white and green have been used on the market hitherto). However, **colour alone is not being claimed here**. The marks are therefore not customary.

Section 3(2)(a), (b) Colour has **no bearing** on the analysis.

Also, the wax coating follows the contours of the underlying cheese. However **this shape is entirely arbitrary** as the cheese could be formed into any shape. Therefore section 3(2)(a) is not an objection.

Section 3(2)(c) The colours green or white **will not add value** to the underlying product (cheese) compared with any other colour.

Acquired distinctiveness: The combination of green (or white) being unique, in combination with the shape of the mark, makes an acquired distinctiveness **easier** than relying on shape alone.

However, there is no **evidence** that the market uses colour to identify the source of origin of the cheeses.

5 marks

Total: 20 marks


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Question 11 – Relative Grounds

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:	<u>TRIATHLON 24</u>
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

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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

Answer:

Alternative well-reasoned answers, even if leading to a different conclusion, will attract equivalent marks.

a)

Yes. The date of registration of the senior mark is less than five years before the priority date of the application and so is valid for all its goods [**1 mark**].

1 mark

b)

1 mark for any substantial contribution towards the analysis of this scenario (such as those indicated below), up to the total indicated:

Similarity of Marks

Aural

The primary aural feature of '111 is that it is a musical, non-standard trade mark, very different to '222 even if the latter is spoken aloud.

The marks comprise a different number of syllables.

Three of the syllables are identical

The initial syllable, which might be afforded more weight, is different - although contains the same vowel sound.

Visual

There is no visual similarity between the marks, as '111 is not conveyed visually.

Conceptual

'111 is a musical, non-standard trade mark, and so wholly different conceptually.

Both trade marks invoke a multi-sport event and a number.

Overall

The musical nature of '111 is likely to dominate perception of the mark. Nevertheless, there is a low, but not negligible, similarity between the marks presenting a risk whereby the words to the jingle might be misremembered.

6 marks

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Similarity of Goods

Users? All goods are aimed at the **general public**.

Nature? (composition, functioning principle, appearance) – Both goods are complex items of engineering, namely **two-wheeled vehicles**.

Value? Bicycles are generally sold at a **cheaper price-point**.

Purpose? (intended use) Both items are **means of transport**

Method of use? -Bicycles are be **self-propelled**, or in the case of **electric bicycles, power assisted. Motorcycles are powered.**

Complementary? The items are **not complementary**.

Competitive? It is possible that an electric bicycle might compete against a low powered motorcycle. Otherwise the goods are **not competitive**.

Distribution channels? Usually **different** distribution channels.

Manufacturing origin? Usually **different** manufacturers.

Overall – Electric bicycles shares a **high similarity with motorcycles**. For all other goods, there is **low similarity**.

8 marks

Average Consumer

In both cases, the goods are aimed at the **general population**.

The purchasers of the goods are almost certainly likely to be **adults**, even if buying a bicycle for a child.

The purchasers of both products, due to their high values, are likely to **exercise significant care**.

2 marks

Likelihood of confusion

No enhanced distinctiveness - '111 has not been used.

With regard to **electric bicycles, the low similarity of the marks offsets but does not eliminate** the risk of confusion arising from the high similarity of the goods.

With other bicycles, the **low similarity of the marks coupled with the low similarity of the goods** makes the risk of confusion unlikely.

2 marks

Conclusion

Mike is recommended to limit the specification to **'pedal cycles'** which is line with its plans anyway. After doing so, it can safely withstand any opposition proceedings.

1 mark

Total: 20 marks

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Question 12 – Passing off

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

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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

Answer

Alternative well-reasoned answers, even if leading to a different conclusion, will attract equivalent marks.

a)

1 mark for any substantial contribution towards the analysis of this scenario (such as those indicated below), up to the total indicated:

Goodwill

- Quebec has been **trading** in its Queen Bee cereal and so undoubtably **enjoys goodwill**.
- The extent of that goodwill needs to be **evidenced** in:
 - **Sales returns** and history.
 - Evidence that put the sales into **context** (e.g. national cereal sales)
 - Evidence from the **trade as** to the pulling power of the cereal in terms of **repeat sales**.
 - Evidence from the **consumers** as to their attraction to the cereal.
 - Confirmation that the goods are being sold in the UK.

Misrepresentation

- The shape and stripes (separately or in combination) uniquely identify Quebec's product, as the sign has **hitherto not be used** by any other participant in the market.
- It is **radically different** from any product already on the market.
- The coloured stripes are **arbitrary**. There is no need for a package to have such a decoration merely because it contains honey.
- The **elongated shape** of the box uniquely identifies Quebec's product.
 - **Evidence of designs** to date.
 - Evidence that **consumers perceive the stripes and shape** of the box
- By adopting the sign, consumers are likely to believe that the product is either:
 - **Queen Bee**
 - **Made by the same manufacturer** as Queen Bee and being resold as Hive.

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- That ALDL have taken the **design decisions knowing** (which is not necessary in passing off actions, but does carry weight).
 - **Evidence of ALDL's brand creation process** in this case.
- The product is a cheap consumer item, likely to be **picked off the shelf with little care**, and so consumers are more apt to be misled.
- Is there any **evidence of actual confusion?** Although the product is not yet being sold, is there a **response to the forthcoming product launch?**

Damage

- It is necessary merely that damage be **likely** to occur (to the level of proof necessary to satisfy the requirements of a quia timet action)
- The misrepresentation is likely to result in **direct diversion of sales**
- The misrepresentation is likely to result into damage to the goodwill, as the packaging is **no longer unique** on the market place.
- Evidence might be available demonstrating that the ALDL product is **inferior** and **likely to damage sales** of the Quebec product.

12 marks

b)

As the product is **not yet on the shelves** [1 mark], the most apt remedies are:

- **Interim injunction to** cease and desist from the use of the stripes and/or elongated shape.
- **Permanent injunction** for the same.
- **Surrender of packaging** (or product in warehouses, if any) for destruction.
- **Declaratory relief**. [1 mark each, up to 2 marks]

Only if the injunction application fails:

- Common law damages.
- Equitable account of profits. [1 mark for either]

4 marks

c)

1 mark for any substantial contribution towards the analysis of this scenario (such as those indicated below), up to the total indicated:

- **Consumers, overwhelmingly rely on the labels** to indicate source.
- **Source of manufacturer (Quebec /ALDL) is clearly indicated** in both instances.
- **Consumers do not make purchasing decisions on shape/surface decoration** alone or otherwise afford such things trade mark significance.
- The **only shared feature are the coloured stripes**, the elongate shape being to abstract a concept to lead to consumers being misled.

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- Conversely the **square design indicates that the product is not Quebec.**
- The idea that consumers might assume a product is made by Queen Bee but being resold as Hive is **too speculative.**
- There is no competition if the products are **not sold side-by-side.**

4 marks

Total: 20 marks

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Question 13 – Case Law

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

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

Total: 20 marks

Answer:

For context, the following quotations are taken directly from the judgments. The elements attracting points are underlined. One mark is available for each element up to the maximum stated.

a)

- The assessment of the existence or otherwise of the **distinctive character of a** trade mark constituted by a **surname** [1 mark],
- **even a common one** [1 mark],
- must be carried out specifically, in accordance with the criteria applicable to any sign covered by Article 2 of the directive [s3 TMA], in relation, first, to **the products or services** in respect of which registration is applied for and, second, to **the perception of the relevant consumers**. [1 mark]

The fact that the effects of registration of the trade mark are **limited** by virtue of Article 6(1)(a) of that directive [s.11(2)(a) TMA] **has no impact on that assessment**. [1 mark].

3 marks

b)

- In order to assess whether a **word combination** is capable of **distinctiveness** [1 mark] the determination to be made depends on whether the word combination in question may be viewed as a normal way of referring to the goods or of representing their **essential characteristics in common parlance**. [1 mark]
- A word combination that unquestionably **alludes** to the function which the goods are supposed to fulfil, still does not satisfy the disqualifying criteria [1 mark]
- Whilst each of the two words in the combination may form part of expressions used in everyday speech to designate a function, their **syntactically unusual juxtaposition** is not a familiar expression [1 mark],

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- either for designating goods or describing their essential characteristics. [1 mark].
- They are lexical inventions bestowing distinctive power on the mark so formed and may not be refused registration under Article 7(1)(c) of Regulation No 40/94 [s3 TMA].

3 marks

c)

- The Court of First Instance had concluded that the word DOUBLEMINT had an ambiguous and suggestive meaning which was open to various interpretations and did not enable the public concerned immediately and without further reflection to detect the description of a characteristic of the goods in question. [1 mark]
- Since it was not exclusively descriptive, the term could not, according to the Court of First Instance, be refused registration. [1 mark]
- It is not necessary that the signs and indications composing the mark that are referred to in that article actually be in use at the time of the application for registration in a way that is descriptive of goods or services such as those in relation to which the application is filed, or of characteristics of those goods or services. It is sufficient, as the wording of that provision itself indicates, that such signs and indications could be used for such purposes. [1 mark].
- A sign must therefore be refused registration under that provision if at least one of its possible meanings designates a characteristic of the goods or services concerned. [1 mark].

3 marks

d)

- Article 3(1)(c) of the Directive [s3(1)(c) TMA] is to be interpreted as meaning that:
- It does not prohibit the registration of geographical names as trade marks solely where the names designate places which are, in the mind of the relevant class of persons, currently associated with the category of goods in question; [1 mark]
- it also applies to geographical names which are liable to be used in future by the undertakings concerned as an indication of the geographical origin of that category of goods; [1 mark]
- In making that assessment, particular consideration should be given to the:
 - degree of familiarity amongst the relevant class of persons with the geographical name in question [1 mark],
 - with the characteristics of the place designated by that name [1 mark],
 - and with the category of goods concerned; [1 mark]
- It is not necessary for the goods to be manufactured in the geographical location in order for them to be associated with it. [1 mark]
- Article 3(3) of the Directive [s3(1) TMA] is to be interpreted as meaning that:

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- It precludes differentiation as regards distinctiveness by reference to the perceived importance of **keeping the geographical name available** for use by other undertakings; [1 mark]
- In determining whether a trade mark has acquired distinctive character following the use which has been made of it, the competent authority must make an **overall assessment** of the evidence that the mark has come to identify the product concerned as originating from a particular undertaking and thus to distinguish that product from goods of other undertakings; [1 mark]
- In assessing the distinctive character of a mark in respect of which registration has been applied for, the following may also be taken into account:
 - the **market share** held by the mark [1 mark];
 - how **intensive**, [1 mark]
 - **geographically widespread** [1 mark] and
 - **long-standing** [1 mark] **use** of the mark has been [~~1~~ mark];
 - the amount **invested** by the undertaking in promoting the mark [1 mark];
 - the **proportion** of the relevant class of persons who, because of the mark, identify goods as originating from a particular undertaking [1 mark];
 - and **statements** from chambers of commerce and industry or other trade and professional associations. [1 mark]
- If the competent authority finds that a **significant proportion** of the relevant class of persons identify goods as originating from a particular undertaking because of the trade mark, it must hold the requirement for registering the mark to be satisfied; [1 mark]
- Where the competent authority has particular difficulty in assessing the distinctive character of a mark in respect of which registration is applied for, Community law does not preclude it from having recourse, under the conditions laid down by its own national law, to an **opinion poll** as guidance for its judgment. [1 mark]

11 marks

Total: 20 marks