

Introduction

There was nothing particularly unusual in this year's FC5 question paper, and the pass rate and candidate marks are consistent with those of recent years. However, compared with other Foundation examinations, there were again many candidates scoring in the 30 – 40% range who were evidently insufficiently prepared to take the exam. Common weaknesses included not knowing the general approach needed to tackle the absolute and relative grounds scenario questions, which are at the core of trade mark practice.

Questions

Part A

Question number	Comments on questions
Question 1	<p>This was a question on comparative law, but which required accuracy from candidates to be awarded the marks.</p> <p>Candidates did need to distinguish the publication (by WIPO) and the republication (by Contracting Parties) of applications, by clearly referencing the latter as the start point for the opposition “clock”.</p> <p>Note that for Madrid Protocol designations of the EU, the “clock” starts <u>1 month</u> after republication.</p>
Question 2	<p>This was a short scenario question that most candidates realised was about “central attack”.</p> <p>The vulnerability of the subsequent designations to central attack needed to be addressed in order to obtain full marks.</p>
Question 3	<p>This question tested candidates’ practical understanding of “conversion”, which few candidates had difficulty with.</p>
Question 4	<p>Most candidates correctly recalled that the grounds on which opposition can be based at the EUIPO are fewer than those available at the UKIPO. This distinction is quite frequently tested in the FC5 examination.</p>
Question 5	<p>This was a question about classification (specifically re-classification). Many candidates gave an intelligent, but ultimately incorrect, answer, based on the fact that such an amendment to an application is not listed within s39 TMA, whereas, reclassification is in fact permitted, but under s34(2).</p>

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	The last time a similar question was asked in the FC5 examination, it caused little difficulty.
Question 6	This was a very basic scenario about priority, but it turned out to be the second most poorly-answered question on the paper, with many candidates unable to give the basic rules that apply.
Question 7	This was a straightforward question about registering a transaction and it caused little difficulty.
Question 8	<p>This was a short, rather challenging, scenario about exhaustion, that most candidates spotted. Not all candidates appreciated that simply printing that a product is “not for resale” does not overcome the exhaustion defence.</p> <p>In practice, “(re)packaging” is a complex area of law, and at Foundation level a wide tolerance was afforded to candidates, regardless of the eventual answer they arrived at, as long as their analysis based on the Trade Marks Act criteria was sound.</p>
Question 9	<p>This was a very basic question about invalidity and revocation, which few candidates had difficulty in recalling. However, full marks were available only to candidates who, with regard to invalidity, clearly mentioned:</p> <ul style="list-style-type: none"> • the possible availability of acquired distinctiveness gained post-registration, and • the “use” requirements of the earlier mark.

Part B

Question number	Comments on question
Question 10	<p>The answer to this year’s “absolute grounds” question followed the usual pattern of running through sections 1 and 3 of the Trade Marks Act, including the Sieckmann test, and considering the availability of acquired distinctiveness. However, although almost all candidates tackled this question, it was not answered as well as similar questions in previous years.</p> <p>As always, to obtain high marks it was necessary to consider distinctive character separately from the other more specific provisions of section 3.</p> <p>Particular points to highlight in this year’s answer scheme are that:</p>

	<ol style="list-style-type: none"> 1 Sourcing products from two or more suppliers does not itself mean an undertaking's trade mark offends against section 1. 2 Customers regarding a shape as unusual or "cool" does not mean it has acquired distinctiveness. 3 The shape of a product's "get up", even if attractive, does not ordinarily give substantial value to the underlying goods if not usually purchased for their aesthetics. This applies primarily to product packaging, but also to scenarios such as this.
<p>Question 11</p>	<p>This "relative grounds" question was tackled by every candidate, and answered very well by most. As usual, it required candidates to apply the standard systematic analysis used by attorneys, examiners and the courts.</p> <p>However almost all candidates dropped a mark by not realising that the earlier mark was still within its initial 5 year grace period, and so there was no need to prove use.</p> <p>The one element that continues to need improvement is that candidates are not always attributing "low/medium/high" similarity to the mark and "low/medium/high" similarity to the goods, before engaging in an exercise to offset one against the other. Rather, they are blandly stating that similarities can offset differences before moving on to talk about other things. In future such analysis will be needed to obtain full marks.</p>
<p>Question 12</p>	<p>This was a passing off scenario, and was attempted by half of the candidates. This was probably the most challenging question, requiring a high degree of imagination and thought by candidates, rather than the recall of legal provisions. Marks were awarded for good points clearly made.</p> <p>As always with passing off questions, it is important to stress that "goodwill" relates to the existence of customer loyalty to a product (e.g. repeat sales); whilst proof of a "misrepresentation" starts by establishing that there is a sign that hitherto has been recognised to refer only to the product of the claimant. Hence it is wrong to speak about goodwill in a sign as this mixes up the first two limbs of the Jif Lemon test. Rather it is necessary to assess:</p> <ul style="list-style-type: none"> • the level of loyalty to a product, as part of the goodwill analysis, and

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	<ul style="list-style-type: none">• the level of recognition of a sign, as part of the misrepresentation analysis.
Question 13	This was an in-depth recall question, attempted by about half the candidates. Most candidates obtained good marks, particularly from part (d) about the Chiemsee case.