

Introduction

This year's paper followed the new standard format for FC papers. Part A examines recall of statutory and case law provisions, and probes whether candidates understand them and can recognise their applicability in basic scenarios. Part B is primarily scenario based, and requires multiple provisions to be identified as relevant, recalled and applied in line with case law.

In percentage terms, successes were up on last year, to 72. The median score was 56, but it is noteworthy that the results were distributed into two distinct clusters.

Only two unsuccessful candidates scored more than 40, and half picked up fewer than 36 marks. Conversely, candidates who passed did so with a median score of 61, and the prizewinning score was 86. In other words, unsuccessful candidates generally exhibited a stark difference in capability from their averagely- and higher-performing peers.

Scores between questions were very consistent. Those who did well did so across all questions, demonstrating a broad degree of knowledge of the subject and multifaceted skills. Likewise those who performed averagely did so across all questions, and those who performed poorly performed poorly across all questions. No one area of the syllabus was of concern, save for recall of European unregistered trade marks.

There was no evidence of time pressure being an issue in this examination.

Like last year, good answers to Part B compensated for below-par answers to Part A, indicating that candidates had learnt techniques to deal with the Part B question, but possibly at the expense of more basic learning or understanding of the statutory provisions.

Candidates are reminded to read the questions carefully, and in particular to follow instructions such as "Do not discuss bad faith" or "Do not discuss marks with a reputation". Ignoring these instructions wastes time that could be devoted to answering other questions more fully.

Questions

Part A

Question number	Comments on questions
Question 1	This was a straightforward question to start the examination, asking for a list of remedies. All candidates answered it well.
Question 2	This was a one-mark question designed to elicit an understanding that passing off, strictly-speaking, protects goodwill, not unregistered trade marks. The marking credited any answer that made clear that the law of passing off is a separate regime to the law of registered trade marks.
Question 3	This question asked for an explanation of the common law concept of reverse passing off and was well-answered.
Question 4	<p>This question, requiring the application of the <i>Sieckman</i> criteria to a basic scenario involving a non-conventional trade mark, was generally answered well. Candidates who had studied the <i>Sieckman</i> case (rather than learnt just a summary of its <i>ratio decidendi</i>) would have realised that this question was based on <i>Sieckman's</i> actual facts, with 'the smell of the sea' being substituted for 'the smell of cinnamon' expressed generally, as a chemical composition, and by reference to a deposit.</p> <p>Some candidates added a discussion on the topic of distinctiveness. Whilst it was excellent that candidates recalled that distinctiveness is generally an issue with any non-conventional trade mark, it was not a topic being examined in this question and so any analysis attracted no marks.</p>
Question 5	This question on the overlap between copyright and trade mark rights (a popular topic in this examination) was reasonably well answered in Parts a) and b). Part c) primarily required candidates to consider standing (<i>locus standi</i>) to bring an action in trade mark law, and was generally not well answered.

<p>Question 6</p>	<p>This straightforward question, requiring recall of the statutory definition of 'earlier rights', was surprisingly poorly answered. In short, trade mark applications are regarded as 'earlier rights', just like fully registered trade marks. They only cease to be available if and when the application is refused.</p> <p>Damages for infringement can be backdated (and candidates might wish to observe that this is one of the few areas where EUTM and UKTM rights differ slightly).</p>
<p>Question 7</p>	<p>This question asked candidates to recall the new statutory provision, section 6A TMA 1994, requiring use of an earlier right to be demonstrable as part of opposition proceedings. (Candidates will have been aware that the EUIPO introduced a similar provision a couple of years ago.) Accurate recall of all the statutory requirements was required to obtain full marks.</p> <p>Candidates should remember that whenever they specify a time period, the event from (or up to which) that time period is measured must always be stated, and accurately so. Few candidates wrote down that the five year period here is measured backwards from the filing/priority date of the junior mark.</p> <p>Many candidates did not appreciate that there are no special provisions in section 6A relating to the period of three months immediately prior to instigating the opposition proceedings, equivalent to the period described in section 46 concerning the period prior to instigating revocation proceedings.</p>
<p>Question 8</p>	<p>This question, on the basic definitions of the words used in the central legal provision of trade mark law, was poorly answered. Many candidates were unable to distinguish 'likelihood of association' from mere 'bringing to mind', or even 'tarnishment' and 'dilution'.</p> <p>(In fact most instances of confusion involving similar (rather than identical) goods and services are likely to be examples of 'association'.)</p>
<p>Question 9</p>	<p>This question was generally well answered, with almost all candidates recognising that the question was about security interests, and most candidates accurately recalling and applying the statutory criteria on registrable transactions.</p> <p>A number of candidates wrote about 'floating charges' (which involves an area outside the FC5 syllabus). Yet the security in the given scenario was clearly 'fixed' on one particular asset.</p>

Question 10	This question was on overseas unregistered trade mark rights. This area is important to anyone using the EUTM system, and furthermore IPReg is keen that trainee attorneys know some basic comparative law on the differences between the laws in the UK and those of other important jurisdictions. However, Part a), asking candidates to set out when unregistered rights can be invoked against an EUTM, was not answered well this year. Very few candidates could recall the rights applicable in Germany.
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Part B

Question number	Comments on question
Question 11	<p>This question presented a novel scenario not previously examined, concerning varietal names. A couple of marks were available if candidates recalled that specific provisions dealing with varietal names had been introduced into section 3 of the UK TMA recently, echoing similar provisions in the EUTMRs. But most candidates were unflustered by the novel scenario and realised that the question required the application of the standard criteria on absolute grounds; something that is probed every year in one of the Part B questions in one guise or another.</p> <p>It was clearly signalled that the name 'Sweet and Sour' might be descriptive of the apples' taste, and candidates benefited from collecting the marks offered from this straightforward aspect of the question. Furthermore, almost all candidates knew that descriptive names were also inherently lacking in distinctive character. Still, the key to this question was realising that a varietal name is essentially the generic name of a new 'thing', and therefore fundamentally ineligible for trade mark protection as it cannot distinguish the goods of different traders supplying the same generic product.</p> <p>A number of candidates were confused about the definition of 'distinctiveness', believing that 'Sweet and Sour' could not be distinctive as it was descriptive of a Chinese meal. What really mattered is whether the name is distinctive in the market for apples and apple trees: ordinary words are entirely suitable for use as trade marks as long as they have no connection to the market concerned.</p> <p>Disappointingly, only one candidate talked about apple trees, goods which warranted just as much discussion as apples per se. Marks were readily available, in particular in Part b), for candidates who distinguished between the market for apples, and the market for apple trees. Generally in the FC5 exam, if two</p>

	<p>different goods are included in a trade mark specification, they will require separate treatment as they will have been specifically selected to probe a distinction of some kind, such as different typical consumers or different distribution channels.</p> <p>No candidate picked up the fact that the 'survey question' was wholly incompatible with the <i>Doublemint</i> requirements for words and expressions with a plurality of meanings, and therefore fatal to the client's case in Part b).</p> <p>The final part of this question, on 3D shape marks, was either answered very well, or very poorly, with little middle ground. It primarily tested whether candidates actually understood the relevant provisos. The overlap between IP rights (such as trade mark and patent law, or trade mark and design law) is an area that IPReg wants trainee patent attorneys to know, and questions on packaging are extremely apt to test this knowledge.</p> <p>Merely because apple juice comes from apples does mean that apple-shaped packaging is 'derived' from the shape of the product at issue. Likewise, the fact that the shape of the packaging was made possible by a technical advance does not exclude it from registration. Nor does it exclude any technical features (such as the sealed aperture) being included in the overall trade mark representation. The provision against giving 'substantial value' does not rule out novel (or even attractive) packaging designs.</p> <p>A number candidates added a discussion on the topic of distinctiveness. Whilst most FC5 questions about shape marks do require candidates to discuss distinctiveness in order to obtain full marks, this year this area was not being examined, and so attracted no marks.</p>
<p>Question 12</p>	<p>This year's relative grounds question was tackled by all but one candidate, and was generally well answered, with most candidates following a systematic analysis set out in the mark scheme (which reflects UK and EU IPO practice).</p> <p>The distinguishing feature of this year's question was that it involved services rather than goods: but all candidates appear to have taken this in their stride, as the standard case law still applies with just minor adaptations for relevancy and terminology.</p> <p>Some candidates may have misread the scenario, and thought that the wording in the logo and the wordmark were identical. They were by necessity very similar (just one letter difference, "horse" vs "house"), but this oversight resulted in multiple marks being missed both for the discussion on similarity of the signs, and for that on likelihood of confusion.</p>

A number of candidates made the mistake of looking at how the trade marks were used in practice rather than comparing only the entries as written on the Register. It did not matter: (1) where the businesses are located; (2) if catering services in general are protected, what particular cuisine they serve in practice; or (3) whether, when providing catering services, they happen to be providing other services such as operating a casino. The facts about location and cuisine in the scenario were only relevant to a couple of more advanced marks, namely whether a neighbourhood restaurant would attract enhanced distinctiveness, and whether the specification of both parties could or should be narrowed in scope.

Candidates are reminded that a sub-conclusion on similarity of marks, or the similarity of services, is best expressed as, for example: “the marks/services are strongly/moderately/mildly similar”. This helps later in the “likelihood of confusion” analysis.

Candidates are again reminded to pay particularly attention to the average consumer. This will help them:

- achieve marks for identifying the general nature of the average consumer for both the senior and junior marks.
- achieve more marks in their ‘similarly of goods/services’ discussion by considering whether the average consumers (users) are common or not in the markets for the goods/services at issue.
- achieve even more marks under the “likelihood of confusion” discussion by considering how alert and careful the average consumers are when making their purchasing decision.

A mark is available for a firm conclusion. The examiner is looking for candidates to reach a definite decision (i.e. coming down on one side or the other as the most likely outcome of proceedings), presented in a way that the client would be able to act upon. The words “*On balance, I recommend...*” are usually a good way to start a conclusion, and if two or more marks/goods/services are at issue in an examination scenario, it is possible that each requires a separate recommendation, as a different outcome might be foreseen for each. It does not matter at this level whether the examiner disagrees with the conclusion, as long as it is consistent with the rest of the candidate’s analysis.

<p>Question 13</p>	<p>Few candidates opted to take this question, but there were lots of relatively straightforward marks on offer, and those who did take this question scored very highly both in this question and the examination as a whole. It required candidates to recall and apply the basics of the Madrid Protocol and EUTM systems (in particular who is a member of which scheme, the rules on Offices of Origin, and the concepts of replacement and seniority), plus a discussion on the vulnerabilities of marks registered using these systems. These are all regular topics for the FC5 examination.</p> <p>There was no one way to present an answer, but a table or even a bullet pointed list works well.</p> <p>Few candidates scored the very top marks – which required a discussion not only of the EUTM and MP <i>per se</i>, but also designating EUTM protection using the MP, and using an EUTM as a basic mark when applying for MP protection. An ‘Italian’ client was specifically chosen to ensure this latter route remained available regardless of the UK’s Brexit status on the examination date, which at the time of writing the examination was uncertain.</p> <p>However, it was disappointing to see that some candidates believed that any existing trade mark in the portfolio (regardless of jurisdiction) could serve as a basic registration for the Madrid Protocol. This did result in marks not being awarded, not only for failing to discuss the two <i>correct</i> potential basic marks, but also because the incorrectly-cited jurisdiction would have been missing from the list of designations. Furthermore, a surprising number of candidates believed priority could be claimed from the most recent trade mark filing, rather than being tied to the first filing (just like priority in patent and design applications).</p>
<p>Question 14</p>	<p>This was a set of questions focussing on a range of statutory provisions all on a common theme, namely correcting or otherwise mitigating the effects of missed deadlines and similar oversights. Almost every candidate attempted this question, and generally candidates, including those who did not otherwise perform well in other questions, had few problems in answering it.</p>